

## **ADMINISTRATIVE PANEL DECISION**

Valeo v. saman ebrahimi, Valeo-se  
Case No. D2022-2765

### **1. The Parties**

The Complainant is Valeo, France, represented by Tmark Conseils, France.

The Respondent is saman ebrahimi, Valeo-se, Iran (Islamic Republic of).

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

The disputed domain name <valeo-se.com> is registered with Hosting Concepts B.V. d/b/a Registrar.eu. (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 27, 2022. On July 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 29, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on August 1, 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 August 3, 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 August 5, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 25, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 28, 2022.

The Center appointed Rodrigo Azevedo as the sole panelist in this matter on October 6, 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 global automotive supplier, which offers a wide range of products and services to automakers and the aftermarket under the brand VALEO.

In order to safeguard its products and activities, the Complainant has registered the VALEO trademark in numerous countries, including in France (registration no. 10701, obtained on April 14, 1966).

The Respondent registered the disputed domain name <valeo-se.com> on May 2, 2022.

The Panel accessed the disputed domain name on October 18, 2022, which was linked to a website reproducing the Complainant's trademark and logo, as well as parts of the Complainant's official website.

#### 5. Parties' Contentions

##### A. Complainant

The Complainant makes the following contentions:

- The disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The Complainant is the registered proprietor of the VALEO and VALEO SERVICE trademarks in numerous countries in the world. The trademark VALEO is well-known. The term "Valeo" is also protected in France as a company name and used accordingly worldwide, as well as is the distinctive portion of numerous domain names registered and used by the Complainant. The disputed domain name wholly incorporates the Complainant's famous trademark VALEO, used in connection with cars and parts thereof since 1980. The element ".com" is irrelevant in determining the similarity of the disputed domain name with the Complainant's prior rights. The fact that the letters "-SE" are added to Complainant's trademark does not eliminate the similarity between the Complainant's prior rights and the disputed domain name, as "SE" is a descriptive element, which is the acronym for "société européenne" (*i.e.*, the type of company adopted for the incorporation of the Complainant "VALEO" in the House of Companies). Consumers looking for VALEO products or services who find the Respondent's website will indubitably believe that the contested domain name belongs to the Complainant or its affiliates, while there is no such connection, nor any business run by the Complainant.

- The Respondent has no rights or legitimate interests in respect of the disputed domain name. Prior UDRP panels have established that it is sufficient for a complainant to show a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name in order to shift the evidentiary burden to the respondent. "Valeo" or "Valeo Service" are not generic terms but registered distinctive trademarks owned by the Complainant. The Complainant has long standing rights in these trademarks, which predate the registration of the disputed domain name. The Respondent is taking undue advantage of the reputation of the Complainant and of its trademarks, corporate name, tradename, domain names. The Complainant has not authorized any third-party to identify itself to the public as VALEO, VALEO SERVICE or VALEO-SE, nor to use the VALEO trademark in the domain name <valeo-se.com>.

- The disputed domain name was registered and is being used in bad faith. Taking into consideration the protection and constant use by the Complainant of the terms "Valeo" and "Valeo Service" as company names, trademarks and domain names worldwide. The Respondent was inevitably aware of the existence of the Complainant's prior rights when he registered the disputed domain name. The lack of any legitimate rights and interests in the disputed domain names leads the Complainant to conclude that the registration must have been made for the purpose of diverting Internet traffic from the Complainant's website to that of

the Respondent, thus disrupting the business of the Complainant. The fact that the disputed domain name is routed to an active website reproducing the Complainant's logos, trademarks and corporate name / tradename without any authorization, and offering automotive products / services pretending to be the VALEO Group, is further evidence of bad faith use. In addition, the Respondent falsely states on the website linked to the disputed domain name that it is part of the "Valeo Group". This shall be misleading the public and consequently discrediting the VALEO services.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy provides that in order to be entitled to a transfer of the disputed domain name, a complainant shall prove the following three elements:

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

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

The Panel has no doubt that "VALEO" is a term directly connected with the Complainant's trademarks.

Annexes 4.1.1 to 4.1.10 to the Complaint shows trademark registrations for VALEO that date as early as in 1966.

The trademark VALEO is wholly encompassed within the disputed domain name. The disputed domain name differs from the Complainant's trademark VALEO merely by the inclusion of the suffix "-se" and of the generic Top-Level Domain ("gTLD") extension ".com".

Previous UDRP decisions have found that the mere addition of symbols such as a hyphen or other terms (such as "SE", a common acronym for "société européenne" in French) to a trademark in a domain name do not avoid a finding of confusing similarity. This has been held in many UDRP cases (see, e.g., *Inter-IKEA Systems B.V. v. Evezon Co. Ltd.*, WIPO Case No. [D2000-0437](#); *The British Broadcasting Corporation v. Jaime Renteria*, WIPO Case No. [D2000-0050](#); *Volvo Trademark Holding AB v. SC-RAD Inc.*, WIPO Case No. [D2003-0601](#); *Wal-Mart Stores, Inc. v. Lars Stork*, WIPO Case No. [D2000-0628](#); *America Online, Inc. v. Dolphin@Heart*, WIPO Case No. [D2000-0713](#)).

It is also already well established that the addition of a gTLD such as ".com" is typically irrelevant when determining whether a domain name is confusingly similar to a complainant's trademark.

As a result, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks, and that the Complainant has satisfied the first element of the Policy.

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

Paragraph 4(c) of the Policy provides some examples without limitation of how a respondent can demonstrate rights or legitimate interests in a domain name:

(i) before receiving any notice of the dispute, the respondent used or made demonstrable preparations to use the domain name in connection with a *bona fide* offering of goods or services; or

(ii) the respondent has been commonly known by the domain name; 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 trademark at issue.

Based on the Respondent's default and on the *prima facie* evidence in the Complaint, the Panel finds that the above circumstances are not present in this particular case and that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has not licensed or authorized the usage of its trademarks to the Respondent, and it does not appear from the present record that the Respondent is commonly known by the disputed domain name.

Indeed, the Complainant showed that the disputed domain name is linked to a website unauthorizedly reproducing the Complainant's trademark and logo, as well as parts of its official website. The website at the disputed domain name states that it is provided by an enterprise that is part of the Complainant's group of companies, which is denied by the Complainant.

Consequently, the Panel is satisfied that the Respondent has no rights or legitimate interests in the disputed domain name, and the Complainant has proven the second element of the Policy.

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

Paragraph 4(b) of the Policy states that the following circumstances in particular, but without limitation, shall be evidence of registration and use of a domain name in bad faith:

(i) circumstances indicating that the respondent has registered or acquired the 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 trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent 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 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 its 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 its website or location or of a product or service on its website or location.

When the disputed domain name was registered by the Respondent (in 2022) the trademark VALEO was already directly connected to the Complainant's products for decades.

Also, as already referred above, the disputed domain name points to a commercial website that unauthorizedly reproduces the VALEO trademark and logo.

Therefore, the Panel concludes that it would not be feasible to consider that the Respondent – at the time of the registration of the disputed domain name – could not have been aware of the Complainant's trademark, as well as that the adoption of the expression "valeo-se" together with the gTLD extension ".com" could be a mere coincidence.

In fact, the inclusion of the suffixes “SE” even enhances the likelihood of confusion concerning the source of the products or services offered on the website at the disputed domain name.

Furthermore, by associating the disputed domain name with a website targeting the VALEO brand, the Respondent potentially obtains revenue and deprives the Complainant from selling its products to prospective clients who are clearly looking for the Complainant.

In the Panel's view, the circumstances of this case, including the Respondent not providing justifications for the registration of a domain name containing a third-party famous trademark, as well as the lack of any plausible good faith reason for the adoption of the term “valeo-se” by the Respondent, are enough to characterize bad faith registration and use of the disputed domain name in the present case.

Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith, and the Complainant has also satisfied 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 <valeo-se.com> be transferred to the Complainant.

*/Rodrigo Azevedo/*

**Rodrigo Azevedo**

Sole Panelist

Date: October 20, 2022