

## ADMINISTRATIVE PANEL DECISION

Sonen (Société de Negoce de Normandie) v. Name Redacted  
Case No. D2022-3461

### 1. The Parties

The Complainant is Sonen (Société de Negoce de Normandie), France, represented by Mathias Avocats, France.

The Respondent is Name Redacted.<sup>1</sup>

### 2. The Domain Name and Registrar

The disputed domain name <sonen-france.com> is registered with Wild West Domains, LLC (the “Registrar”).

### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 19, 2022. On September 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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 September 20, 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 September 23, 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 September 27, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 17, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 18, 2022.

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<sup>1</sup> The Respondent appears to have used the name of a third party when registering the disputed domain name. In light of the potential identity theft, the Panel has redacted the Respondent’s name from this decision.

The Center appointed Louis-Bernard Buchman as the sole panelist in this matter on October 19, 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.

On November 10, 2022, the Panel issued a procedural order (the “Procedural Order No. 1”), *inter alia*, in the following terms:

“Having reviewed the file in the above-referenced case, the Panel notes that the Complainant in its Complaint relies on unregistered trademark rights for SONEN for the purposes of the UDRP, *i.e.*, that SONEN has become a distinctive identifier that consumers associate with the goods and/or services offered by the Complainant (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([‘WIPO Overview 3.0.’](#)), section 1.3).

Pursuant to paragraphs 10 and 12 of the Rules for Uniform Domain Name Dispute Resolution Policy (the ‘Rules’), the Panel invites the Complainant to provide evidence that the sign SONEN (i) has been used by the Complainant to designate its goods and/or services; or (ii) has become a distinctive identifier that consumers (including the Complainant’s customers) associate with the Complainant’s goods and/or services.

The Complainant’s submission in response to this Procedural Order should be sent to the Center on or before November 15, 2022, by email, copying the Respondent.

The Respondent may, then, submit comments on or before November 18, 2022, on any submission provided by the Complainant in response to this Procedural Order.

The Parties’ further submissions should be limited only to the above requests.”

On November 21, 2022, the Complainant transmitted by email to the Center three previously filed annexes to the Complaint and a Google search result on SONEN. The Panel decided to accept this response despite its post-deadline filing and issued on November 21, 2022 a second procedural order (the “Procedural Order No. 2”), *inter alia*, in the following terms:

“[t]he Complainant submitted further evidence on November 21, 2022.

The Respondent may, now, submit comments on or before November 24, 2022, on any submission provided by the Complainant in response to the Procedural Order No. 1.”

The Respondent did not file anything.

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

The Complainant is a French company based in the Normandy region, operating since 1977 as a wholesaler of bulk building materials, which is part of the Saint-Gobain group, a company listed on the main index of the Paris stock exchange.

The Complainant does not own a registered trademark containing the term SONEN.

Its online sales of construction products to its customers are operated through a website under the domain name <pointp.fr>.

The Complainant provided evidence that one of its current managers and one of its former directors were victims of identity theft, that phishing e-mails were sent, using e-mail addresses configured under the disputed domain name, and that fraudulent activities were carried out under the disputed domain name.

The disputed domain name was registered on June 8, 2021.

The disputed domain name, <sonen-france.com>, resolves to a parking page with sponsored links at the time of this decision.

## **5. Parties' Contentions**

### **A. Complainant**

(i) The Complainant submits that the disputed domain name reproduces an unregistered mark, in which it has rights, and is confusingly similar to the unregistered mark insofar as the disputed domain name contains the unregistered mark in its entirety and that the addition of the "france" term after the unregistered mark is not capable of dispelling the confusing similarity.

(ii) The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. Furthermore, the Complainant contends that it never authorized the Respondent to use the mark in any manner and that the Respondent has never had any affiliation with the Complainant.

(iii) The Complainant submits that the Respondent has registered the disputed domain name in bad faith. The Complainant alleges that the Respondent had knowledge of the unregistered mark when registering the disputed domain name.

(iv) The Complainant submits that the Respondent is using the disputed domain name in bad faith.

(v) The Complainant requests that the disputed domain name be transferred to the Complainant.

### **B. Respondent**

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

## **6. Discussion and Findings**

### **6.1. Procedural Aspects**

#### **A. Failure to respond**

As aforementioned, no Response was received from the Respondent.

Under the Rules, paragraphs 5(f) and 14(a), the effect of a default by the Respondent is that, in the absence of exceptional circumstances, the Panel shall proceed to a decision on the basis of the Complaint.

Under paragraph 4(a) of the Policy, it is the Complainant's burden to establish that all three of the required criteria for a transfer of the disputed domain name have been met, even in the event of a default.

Under paragraph 14(b) of the Rules, the Panel is empowered to draw such inferences from the Respondent's default as it considers appropriate under the circumstances, even though a respondent's failure to file a Response does not automatically result in a decision in favor of the Complainant.

#### **B. UDRP Standing - Assertion of unregistered trademark rights**

The Complainant, based in a civil law jurisdiction, has submitted limited evidence in support of its contention that although unregistered as a trademark, its SONEN mark has acquired distinctiveness. The Complainant essentially relies on SONEN being its registered corporate name since 1978 and its trade name since the

beginning of its commercial activity in 1977 (see excerpt of its registration at the Trade and Industrial Registry). The Complainant thus contends that such mark has become a distinctive identifier for its goods and services.

This contention is un rebutted by the Respondent.

There is no question that under French company and commercial laws, a corporate name and a trade name are registered rights which their holder may assert. The answer to the question of whether these rights are also identifiers for the Complainant's goods or services depends however on appropriate circumstances of the case at hand.

Section 1.3 of the [WIPO Overview 3.0](#) addresses this issue as follows:

“1.3 What does a complainant need to show to successfully assert unregistered or common law trademark rights?

To establish unregistered or common law trademark rights for purposes of the UDRP, the complainant must show that its mark has become a distinctive identifier which consumers associate with the complainant's goods and/or services.

Relevant evidence demonstrating such acquired distinctiveness (also referred to as secondary meaning) includes a range of factors such as (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys.

(Particularly with regard to brands acquiring relatively rapid recognition due to a significant Internet presence, panels have also been considering factors such as the type and scope of market activities and the nature of the complainant's goods and/or services.)

Specific evidence supporting assertions of acquired distinctiveness should be included in the complaint; conclusory allegations of unregistered or common law rights, even if undisputed in the particular UDRP case, would not normally suffice to show secondary meaning. In cases involving unregistered or common law marks that are comprised solely of descriptive terms which are not inherently distinctive, there is a greater onus on the complainant to present evidence of acquired distinctiveness/secondary meaning.”

The difficulty here is that, as appears below, the Complainant has produced insufficient evidence addressing these areas.

In assessing the totality of the evidence provided by the Complainant, the Panel takes into account the following:

The Complainant on its website highlights prominently its POINT P brand for its goods and services.

There is no evidence regarding the duration and use of SONEN as a trademark, a source identifier for the Complainant's goods or services.

There is no evidence from any third parties of sufficient public recognition of the name SONEN at any date. In particular, the Google search result on SONEN merely describes it as a shop for construction materials.

There is no evidence of substantive public advertising of the name SONEN by the Complainant.

There is no financial evidence of any kind.

There is no evidence of SONEN's notoriety in any consumer survey.

In short, there is no evidence of enough public or trade recognition of that name, or any substantive use of it in advertising, and there is not sufficient evidence of its current use as a source identifier of the Complainant's goods or services.

The Complainant however also relies on the fact of the Respondent's use of the disputed domain name is itself evidence that relevant unregistered trademark rights exist.

[WIPO Overview 3.0](#), section 1.3, addresses this issue as follows: "The fact that a respondent is shown to have been targeting the complainant's mark (e.g., based on the manner in which the related website is used) may support the complainant's assertion that its mark has achieved significance as a source identifier."

The Panel takes the view that this approach may support a case where there is other evidence which is of a doubtful or marginal nature, but normally it should not constitute the sole evidence of unregistered rights, or at least such evidence should show clearly that the Respondent itself is using the corresponding terms of the disputed domain name as a source identifier of the Complainant's products or services.

If that was not the case, then the test would be entirely circular, and any term used in a domain name could be said to support a finding of unregistered trademark rights – which is not the Policy's intention.

This approach should be considered in light of the particular circumstances of a proceeding, and in this case the Panel does not think, for the above reasons, that there is sufficient evidence of unregistered trademark rights existing at the date of the Complaint. Therefore, the Panel does not deem the use of the disputed domain name as being *per se* enough to support a finding that such rights exist.

Accordingly, the Panel finds that the Complainant has failed to establish unregistered trademark rights for the purposes of the UDRP.

## **6.2. Requirements of paragraph 4(a) of the Policy**

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

To succeed, in accordance with paragraph 4(a)(i) of the Policy, the Complainant must satisfy the Panel that the disputed domain name is identical with or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Panel having concluded above that the Complainant failed to establish that it has any relevant trademark rights, the Complainant has not satisfied the requirement of paragraph 4(a)(i) of the Policy in the absence of such rights.

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

Given the findings above, the Panel does not need to determine this issue. Had it been necessary to do so, the Panel would have found that the Respondent has no rights or legitimate interests in the disputed domain name.

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

Given the findings above the Panel does not need to determine this issue. Had it been necessary to do so, the Panel would have found that the Respondent has registered and used the disputed domain name in bad faith as it is manifestly engaged in dishonest and fraudulent activity.

## 7. Further complaint

The Panel recognizes that its decision means the Complainant is unable to succeed against the Respondent notwithstanding the latter's clearly fraudulent activity.

If the Complainant is able to overcome its lack of trademark rights, for example by obtaining a relevant registered trademark, the Panel concludes that, if the Respondent's activity in question is continuing, then the Complainant should not be barred by this decision from filing a new UDRP complaint.

In this context, the Panel notes that the requirement for a relevant trademark right is satisfied by a registered trademark which post-dates the activity complained of – see [WIPO Overview 3.0](#), section 1.1.2. See also [WIPO Overview 3.0](#), section 4.18, as to a refiling complaint.

## 8. Decision

For the foregoing reasons, the Complaint is denied.

*/Louis-Bernard Buchman/*

**Louis-Bernard Buchman**

Sole Panelist

Date: November 28, 2022