

ADMINISTRATIVE PANEL DECISION

Somfy Activites SA v. Host Master, Transure Enterprise Ltd
Case No. DCO2022-0028

1. The Parties

The Complainant is Somfy Activites SA, France, represented by Cabinet Lavoix, France.

The Respondent is Host Master, Transure Enterprise Ltd, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <somfypro.co> is registered with Above.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 11, 2022. On April 11, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 22, 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 the same day 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 April 25, 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 4, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 24, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 25, 2022.

The Center appointed Reyes Campello Estebaranz as the sole panelist in this matter on June 3, 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

Founded in 1969, the Complainant is the head of the Somfy Group, which is one of the world's leading manufacturers of automatic controls and motors for homes and buildings (motorization of blinds and shutters, solution for automation of openings and closures of houses and building, etc.). The Complainant's group operates in 58 countries around the world through 117 subsidiaries, commercializing its products under the SOMFY trademark. Its products are aimed to the general public as well as to professionals, producing over 20 million motors per year, with global sales of EUR 1,200 billion in 2019.

The Complainant owns trademark registrations for its SOMFY trademark in many jurisdictions around the world, including:

- International Trademark Registration No. 448984, SOMFY, registered on November 8, 1979, in Classes 7, and 9;
- Colombian Trademark Registration No. 3082414, SOMFY, registered on September 18, 2003, in Class 9; and
- European Union Trade Mark No. 012191367, SOMFY, registered on February 27, 2014, in Classes 6, 7, 9, 16, 19, 35, 36, 37, 38, 41, 42, and 45, (collectively the "SOMFY mark").

Prior UDRP decisions under the Policy have recognized the well-known character of the SOMFY mark.¹

The Complainant further owns various domain names comprising its SOMFY mark, under various generic Top-Level Domains ("gTLDs") and country code Top-Level Domains ("ccTLDs"), which are linked to its corporate websites in connection with its products and services. Among others, <somfy.fr> (registered on January 14, 1997) associated to an active website; <somfypro.fr> (registered on November 19, 2007) associated to an active website aimed to professionals; and <somfysystems> (registered on September 28, 1997), associated to an active website in relation with motorized blinds and shades.²

The disputed domain name was registered on January 18, 2022, and resolves to a parked page displaying promotional links to third parties' websites in the field of blinds, windows, and doors. This page further indicates that the disputed domain name may be for sale, including a link under the text "buy this domain name".

According to the evidence provided by the Complainant, on March 7, 2022, it sent a cease and desist letter to the Respondent, but the Respondent did not reply to this letter.

5. Parties' Contentions

A. Complainant

Key contentions of the Complaint may be summarized as follows:

The disputed domain name is confusingly similar to the Complainant's trademarks. The disputed domain name incorporates the term "somfy" (an invented word and a well-known trademark), adding the term "pro" (abbreviation of the word "professional" that refers to a characteristic of the Complainant's products), and the ccTLD ".co", which is a technical element necessary for the registration. The SOMFY mark is used on the websites "www.somfy.fr", "www.somfypro.fr" and "www.somfysystems.com", in relation with motorization of

¹ See, e.g., *Somfy SAS v. Zhao Jiafei*, WIPO Case No. [D2013-1741](#).

² Other domain names owned by the Complainant are: <somfy.com> (registered on May 12, 1998); <somfy-group.com> (registered on May 27, 2002); and <somfy-connect.com> (registered on October 3, 2014).

blind, shutter, solution for automation of openings and closures of houses and building; and some of the Complainant's products are intended for professionals only, or must be installed by professionals.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not commonly known by the disputed domain name, and has no trademark rights in connection to the terms "somfy" or "somfypro". The Respondent is not a licensee of the Complainant, nor is it authorized to use the SOMFY mark, and it is making an unfair commercial use of the disputed domain name. The disputed domain name is available for sale and it resolves to a parked page displaying promotional links to third parties' websites in the same sector of the Complainant's products.

The disputed domain name was registered and is being used in bad faith. In view of the well-known character and long use of the SOMFY mark, it is virtually impossible that the Respondent was not aware of this mark at the time it registered the disputed domain name. The Complainant owns various domain names, including <somfypro.fr> (almost identical to the disputed domain name). The disputed domain name therefore generates a likelihood of confusion. The disputed domain name resolves to a site where it is offered for sale, and various commercial links with respect to the Complainant's sector are displayed, damaging the Complainant's business. The Respondent has been the subject of other UDRP proceedings, appearing in nearly 1,000 prior disputes under the Policy. By registering and using the disputed domain name, the Respondent intentionally attempted to attract for commercial gain, Internet users to its site, by creating a likelihood of confusion with the Complainant and its trademarks, for commercial gain.

The Complainant has cited previous decisions under the Policy that it considers supportive of its position, and requests the transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

The Complainant has made the relevant assertions as required by the Policy and the dispute is properly within the scope of the Policy. The Panel has authority to decide the dispute examining the three elements in paragraph 4(a) of the Policy, taking into consideration all of the relevant evidence, annexed material and allegations, and performing some limited independent research under the general powers of the Panel articulated, *inter alia*, in paragraph 10 of the Rules.

A. Identical or Confusingly Similar

The Complainant indisputably has rights in the SOMFY mark, both by virtue of its trademark registrations and as a result of its continuous use of this mark over more than 50 years.

The disputed domain name incorporates the SOMFY mark in its entirety, adding the term "pro" which does not avoid the perception of the mark. The Complainant's trademark is recognizable in the disputed domain name and the ccTLD ".co" is a technical requirement, generally disregarded for the purpose of the analysis of the confusing similarity. See sections 1.7, 1.8, and 1.11 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Accordingly, this Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark, and the first element of the Policy under paragraph 4(a)(i) has been satisfied.

B. Rights or Legitimate Interests

Although the Complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, UDRP panels have recognized that proving a respondent lacks rights or legitimate interests in a

domain name may result in the often impossible task of proving a negative, requiring information that is primarily if not exclusively within the respondent's knowledge. Thus, the consensus view is that paragraph 4(c) of the Policy shifts to the respondent the burden of production to come forward with relevant evidence of rights or legitimate interests in the disputed domain name, once the complainant has made a *prima facie* case that the respondent lacks rights or legitimate interests.

The applicable standard of proof in UDRP cases is the "balance of probabilities" or "preponderance of the evidence", being the Panel prepared to draw certain inferences in light of the particular facts and circumstances of the case. See section 4.2, [WIPO Overview 3.0](#).

The Complainant's above-noted assertions and evidence in this case effectively shift the burden to the Respondent of producing evidence of rights or legitimate interests in the disputed domain name, providing the circumstances of paragraph 4(c) of the Policy, without limitation, in order to rebut the Complainant's *prima facie* case.

The Respondent has not replied to the Complainant's contentions, not providing any explanation or evidence of rights or legitimate interests in the disputed domain name.

A core factor in assessing fair use of a domain name is that it does not falsely suggest affiliation with the Complainant's trademark. See section 2.5, [WIPO Overview 3.0](#). The disputed domain name incorporates the SOMFY mark in its entirety, adding a term ("pro") that may refer to a characteristic of the Complainant's products, which are aimed to professionals or need installation by professionals, denoting a risk of implied affiliation and confusion.

The Panel further notes that the disputed domain name is almost identical to the Complainant's domain name used for its official website addressed to professionals ("www.somfypro.fr"). This circumstance without doubt aggravates the risk of confusion and implied affiliation for Internet users.

The Panel further considers that the Complainant has made out a *prima facie* case that the Respondent could not have rights or legitimate interests in respect of the disputed domain name, not being authorized to use the SOMFY mark and no evidence existing that suggests that the Respondent may be commonly known by the disputed domain name. In this respect, the Panel notes that the Respondent's name provided in the registration of the disputed domain name was originally concealed under a privacy service, and has no resemblance with the disputed domain name or the term "somfy".

The Panel further notes that the term "somfy" is a coined term, without dictionary meaning.

The Panel has corroborated that, according to the evidence provided by the Complainant, the disputed domain name resolves to a parked page displaying pay-per-click ("PPC") links to third parties' websites associated with the Complainant's business (automation and motorization of blinds, shutters, solution for automation of openings and closures of houses' doors and windows, etc.). Such use cannot be considered as a *bona fide* use under the Policy.

The Panel has further corroborated that, according to the evidence provided by the Complainant, the disputed domain name is offered for sale.

Therefore, no evidence in this case indicates that the disputed domain name has been used or that the Respondent has made any preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services or to a legitimate noncommercial or fair use.

It is further remarkable that the Respondent has chosen not to reply to the Complaint, not providing any information or evidence in connection to any rights or legitimate interests in the disputed domain name.

All the above-mentioned circumstances lead the Panel to conclude that nothing in the case file gives any reason to believe that the Respondent has any rights or legitimate interests in respect of the disputed domain name. Therefore, the second element of the Policy under paragraph 4(a)(ii) has been established.

C. Registered and Used in Bad Faith

The Policy, paragraph 4(a)(iii), requires that the Complainant establish that the disputed domain name has been registered and is being used in bad faith.

The applicable standard of proof is, likewise, the “balance of probabilities” or “preponderance of the evidence”. See section 4.2, [WIPO Overview 3.0](#).

The Panel notes the continuous and extensive use of the SOMFY mark for over 50 years (since 1969), and its extensive presence over the Internet, as well as the well-known character of this trademark recognized by previous decisions under the Policy.³

The Panel considers that all cumulative circumstances of this case point to bad faith registration and use of the disputed domain name:

(i) the disputed domain name incorporates the Complainant’s trademark in its entirety adding a term (“pro”) that may refer to the Complainant’s products, generally aimed to professionals or needing the installation by professionals, which enhances the intrinsic likelihood of confusion and affiliation;

(ii) the term “somfy” is a coined term;

(iii) the SOMFY mark is well-known and the Complainant operates internationally, including in the United States, where the Respondent is located according to the Registrar verification;⁴

(iv) the disputed domain name is almost identical to the Complainant’s domain name <somfypro.fr>, which resolves to a website specifically addressed to professionals;

(v) according to the evidence provided by the Complainant, the disputed domain name resolves to a parked page, which offers for sale the disputed domain name and displays PPC links to third parties’ websites in the Complainant’s business sector,

(vi) the Respondent used a privacy service to register the disputed domain name; and

(vii) the Respondent has not offered any explanation of any rights or legitimate interests in the disputed domain name and has not come forward to deny the Complainant’s assertions of bad faith, choosing not to reply to the Complaint.

In light of the above, taking into consideration all cumulative circumstances of this case, on the balance of probabilities, the Panel considers that the disputed domain name was registered and is being used to target the SOMFY mark, in bad faith, with the intention of obtaining a free ride on the established reputation of the Complainant and its trademark, in an attempted to increase the Internet traffic to the parked page associated to the disputed domain name for a commercial gain.

Accordingly, the Panel concludes that the Complainant has met its burden of establishing that the disputed domain name has been registered and is being used in bad faith.

³ See footnote No. 1, *supra*.

⁴ The Panel, under its general powers, has consulted the Complainant’s website.

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 <somfypro.co> be transferred to the Complainant.

/Reyes Campello Estebarez/

Reyes Campello Estebarez

Sole Panelist

Date: June 17, 2022