

ADMINISTRATIVE PANEL DECISION

Sycomore Vox France Société à responsabilité limitée (S.à.r.l.) v. admin web
Case No. D2023-0552

1. The Parties

The Complainant is Sycomore Vox France Société à responsabilité limitée (S.à.r.l.), France, represented by ORSINGHER - Avocati Associati, Italy.

The Respondent is admin web, France, represented by Le 16 Law, France.

2. The Domain Name and Registrar

The disputed domain name <sycomore.com> is registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 7, 2023. On February 7, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 8, 2023, 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 (Redacted for privacy, Dynadot Privacy service) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 8, 2023 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 February 13, 2023.

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 February 16, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 8, 2023.

On February 17, 2023, the Respondent sent an informal communication.

On March 3, 2023, the Respondent requested an extension of the Response deadline. The Respondent was granted the automatic four calendar day extension for response under paragraph 5(b) of the Rules.

Further to the Complainant's objections to the Respondent's request for the extension to file a Response dated March 6, 2023, the Center declines to extend the period for Response under paragraph 5(e) of the Rules. However, in accordance with paragraph 5(b) of the Rules, the due date for submitting a Response was extended to March 12, 2023.

The Response was filed with the Center on March 12, 2023.

The Center appointed Elise Dufour as the sole panelist in this matter on March 20, 2023. 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 Sycomore Vox France, a company part of the VOX group offering digital guiding solutions in the touristic and cultural sector. The Complainant developed digital tour guide systems, smartphone applications, content creation and venue management services.

On April 8, 2021, the Complainant, known under the company name SIREDO SARL, acquired the French company SYCOMORE SA, created in July 1986, together with SYCOMORE SA's industrial and intellectual property rights and changed its name to SYCOMORE VOXFRANCE SARL on March 15, 2022.

The Complainant owns various trademark registrations and notably the following ones:

- SYCOMORE, French semi-figurative trademark n° 4553381, with a registration date of May 21, 2019 covering products and services in classes 9, 35, 39 and 41;
- SYCOMORE, European Union semi-figurative trademark n° 018462833, with a registration date of August 14, 2021 covering products and services in classes 9, 41 and 42;
- SYCOMORE, European Union word trademark n° 018462831, with a registration date of August 14, 2021 covering products and services in classes 9, 41 and 42;

The disputed domain name was registered on June 20, 2004 and resolves to a parking page of Sedo, where the disputed domain name is for sale.

On December 12, 2021, the Complainant offered through the Sedo website to purchase the disputed domain name for EUR 200. The Respondent made a counteroffer of EUR 190,000, which was refused by the Complainant.

Then, on January 3, 2023, the Complainant offered through the Sedo website to purchase the disputed domain name for EUR 1,500.

The Respondent made a counteroffer of EUR 9,990, which was refused by the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant contends that (i) the disputed domain name is identical to the Complainant's trademarks; (ii) the Respondent has no rights or legitimate interests in the disputed domain name; and (iii) the Respondent registered and is using the disputed domain name in bad faith.

(i) The Complainant claims that the disputed domain name is identical to its registered and unregistered trademarks. Indeed, the disputed domain name reproduces entirely the Complainant's trademark SYCOMORE with the addition of the generic Top-Level Domain ("gTLD") ".com", which should be disregarded when assessing identity or confusing similarity. The Complainant contends that the fact that disputed domain name has first been registered before the Complainant acquired its rights in the SYCOMORE trademarks does not by itself preclude a panel's finding of identity or confusing similarity between the Complainant's trademarks and the disputed domain name considering the consistent use of the SYCOMORE unregistered trademarks by the Complainant for more than 30 years, the registered SYCOMORE trademarks, and the fact that the disputed domain name has been purchased, according to the Complainant, recently.

(ii) The Complainant claims that the Respondent has no rights or legitimate interests in respect of the disputed domain name: (a) the Respondent has not used the disputed domain name with any offering of any goods and services and there is no evidence of *a bona fide use* of the disputed domain name (b) the Respondent is not commonly known by the disputed domain name, as its name is "admin web" and the Complainant has never authorized the Respondent to register and/or use any domain name incorporating the Complainant's trademarks, nor granted any license or any authorization to use its trademarks (c) the Respondent is not making a legitimate noncommercial or faire use of the disputed domain name as it is currently offered for sale (d) the lack of legitimate interest also results for the Complainant from the former use of the disputed domain name which used to redirect the Internet users to the domain name "www.chambresdhotels.com" between March 6, 2008 and December 29, 2022.

(iii) The Complainant claims that the Respondent acquired the disputed domain name on December 29, 2022 and that this date should be considered as the relevant date to assess bad faith. Hence, for the Complainant, the Respondent acquired the disputed domain name after the registration of the Complainant's trademarks. For the Complainant, the Respondent registered the disputed domain name in bad faith for the sole purpose of selling, renting or otherwise transferring the disputed domain name to the Complainant or to one of its competitors. In addition, the fact the Respondent masked its identity during the registration procedure further suggests the existence of bad faith at the moment of registration. The Complainant further contends that in the event the Respondent could demonstrate to be the first registrant of the disputed domain name, registration would nonetheless be in bad faith inasmuch (a) the SYCOMORE unregistered trademark had been used on the market for about 18 years, (b) there is no evidence of legitimated use of the disputed domain name since its registration, (c) the Respondent only acquire the disputed domain name only for the purpose of selling it to the Complainant.

As for the Respondent's bad faith use of the disputed domain name, the Complainant stated that the Respondent is merely offering the disputed domain name for sale, an indication of the Respondent's bad faith can be drawn from the amount of money demanded for the sale of the disputed domain name and the fact that the disputed domain name used to redirect Internet users to another website, from March 6, 2008 to August 7, 2018 does not amount to good faith use.

B. Respondent

Key contentions of the Response may be summarized as follows:

(i) The Respondent states that he is the legitimate holder of the disputed domain name since June 20, 2004.

As per the rights of the Complainant on the SYCOMORE trademark, the Respondent contends that (a) at the time of initial registration of the disputed domain name, neither the Complainant, nor the Sycomore SA company owned any SYCOMORE trademark registration, and the term "sycomore" never was, nor is constitutive of a famous or well-known trademark (b) the Complainant never used the SYCOMORE trademark before April 8, 2021 (c) the Complainant acquired the SYCOMORE trademark and domain names in the context of insolvency proceeding, (d) the Complainant subsequently acquired two additional European Union trademarks on April 27, 2021, (e) the Complainant did not acquire the shares of the Sycomore SA company so that the Complainant does not own any rights in the company name Sycomore.

The Respondent further contends that the name “sycamore” is not spontaneously associated with the Complainant’s products or services in the public’s mind and that a search in a browser shows that the Complainant’s website only appears on 5th page. The Respondent further states that the term “sycamore” is a common and generic dictionary term used by many companies across the world in relation to various categories of products or services.

The Respondent further explains that if his identity has been redacted, it is because, since the General Data Protection Regulation came into force on May 25, 2018, registrar offers an option to redact registrants’ personal information.

(ii) The Respondent further contends that it has legitimate interest in the disputed domain name since 2004 and has been using it in good faith ever since. For the Respondent, common words and descriptive terms are legitimately subject to registration as domain names on a first-come, first-served basis. The Respondent stresses that the use made of the disputed domain name is in relation to its generic meaning. The Respondent stressed that the disputed domain name was first used in connection with the “www.chambresdnotes.com” website to be more present on the “gite rural segment”. For the Respondent, the fact that he decided to put the disputed domain name for sale on “sedo.com” does not in itself prove a lack of legitimate interest as long as a trademark owner is not targeted. In addition, for the Respondent, there is nothing wrong with offering to sell a domain name at a high price.

(iii) As per the registration of the disputed domain name in bad faith, the Respondent states that he had no intent to target a trademark owner and did not registered the disputed domain name in the knowledge of any third-party trademark. The Respondent reminds that the Respondent never made any attempt to contact the Complainant to sell the disputed domain name.

As per the use of the disputed domain name in bad faith, the Respondent highlights the fact that if a disputed domain name is registered in good faith, it cannot be used in bad faith. Nevertheless, the Respondent claims that since its registration, the disputed domain name has always been used in good faith: the Respondent never used the disputed domain name in relation with the Complainant’s products or services, nor attempted to trade on the Complainant’s reputation or to pass off the Complainant or to divert consumes.

(iv) The Respondent finally claims that the Complaint was brought in bad faith and therefore constitutes an abuse of the administrative proceeding, amounting to reverse domain name hijacking, inasmuch the Complainant engaged in a negotiation with the Respondent but failed and commenced the administrative proceeding in the hope of obtaining the disputed domain name.

6. Discussion and Findings

Under the Policy, paragraph 4(a), in order to prevail, a complainant must prove the following three elements of a claim for transfer or cancellation of a respondent’s domain name:

- (i) that the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) that the respondent has no rights or legitimate interests in the domain name; and
- (iii) that the domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered identical or confusingly similar to that trademark for purposes of the Policy.

The Complainant has rights in the registered trademarks SYCOMORE, by virtue of its trademark registrations.

The disputed domain name incorporates the Complainant's trademarks in their entirety.

The Complainant's trademarks are recognizable in the disputed domain name, and the gTLD ".com" is a technical requirement, generally disregarded for the purpose of the analysis of the confusing similarity.

The Panel notes that the disputed domain name was registered before the Complainant's registered trademarks. This circumstance does not by itself preclude the Complainant's standing to file this case, nor a Panel's finding of identity or confusing similarity under the first element, albeit this circumstance may be taken into account in the analysis of the second and third elements of the Policy. See section 1.1.3, [WIPO Overview 3.0](#).

This Panel finds that the disputed domain name is identical to the Complainant's trademarks, 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 demonstrating 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.

In this case, the Respondent claims to be in the business of acquiring and selling generic and descriptive domain names consisting of dictionary words.

The Respondent has further alleged having acquired the disputed domain name as part of a project consisting in a side development to <chambresdnotes.com> so as to be more present on the "gite rural segment", without any knowledge of or intention to take advantage of the Complainant's trademark. The Respondent decided to offer the disputed domain name for sale in the interest of the good management of its portfolio of domain names consisting of dictionary words.

The Panel notes that the disputed domain name consists of the dictionary term "sycamore", which is the obsolete spelling of "sycamore" which is a name that has been applied to several types of trees

In addition, the Panel notes that registering a domain name comprising a dictionary term without intent to target the trademark of an existing trademark owner, and offering this domain name for sale could be legitimate.

However, given its finding under the third element, it is not necessary for the Panel to make a finding under the second element of the Policy.

C. Registered and Used in Bad Faith

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

The Respondent maintains that before this proceeding and receiving the Complaint, it had no knowledge of the Complainant or its SYCOMORE trademarks and there was no reason for the Respondent to have believed that the registration of such a dictionary word was (or is) unlawful.

According to the evidence produced, at the time of the registration of the disputed domain name, SYCOMORE trademarks were not registered by the Complainant. The Panel also finds that on balance that the Complainant has not provided relevant evidence that it had used the word SYCOMORE as unregistered

trademark. The mere claim that it has used “SYCOMORE unregistered trademark on the market for about 18 years” is not sufficient. Furthermore, in cases involving unregistered marks that are comprised of descriptive terms which are not inherently distinctive, there is a greater onus on the Complainant to present evidence of acquired Distinctiveness/secondary meaning. See section 1.3 of the [WIPO Overview 3.0](#).

In this type of scenario, where the disputed domain name was registered before the Complainant acquired trademark rights, UDRP panels do not normally find bad faith on the part of the respondent, unless very specific circumstances proved by the Complainant apply. See section 3.8, [WIPO Overview 3.0](#).

Consequently, the Panel considers on balance that it is difficult to consider that the Respondent targeted the Complainant and/or its trademarks when it registered the disputed domain name, before the registration and use by the Complainant of the dictionary terms “sycomore” as trademarks. In the circumstances of this case, the Panel finds it highly unlikely that the Respondent had the Complainant in mind when it registered the disputed domain name.

Under these circumstances, the Panel finds that the Complainant has not met its burden of establishing that the Respondent registered the disputed domain name in bad faith.

D. Reverse Domain Name Hijacking

Paragraph 1 of the Rules states that Reverse Domain Name Hijacking (“RDNH”) means using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name.

Paragraph 15(e) of the UDRP Rules provides that, if after considering the submissions the Panel finds that the Complaint was brought in bad faith, for example in an attempt at RDNH or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.

To establish RDNH, a respondent typically must show that the complainant knew of its own lack of relevant trademark rights, or of the respondent’s rights or legitimate interests in, or lack of bad faith concerning, the disputed domain name.

In this case, the Respondent has sought a finding of RDNH be made against the Complainant.

According to the Respondent, the Complainant “knew or should have known at the time it filed the Complaint that it could not prove one of the essential elements required by the Policy.”

Indeed, as the Respondent alleges, the Complaint was filed “in a so called B Plan case”. The Panel considers that the Complainant first tried to purchase the disputed domain name through the website “sedo.com” and as the price was too high, the Complainant tried to obtain the transfer of the disputed domain name through an administrative proceeding.

However, the Panel is not persuaded that the Complaint was filed in bad faith and that the circumstances of this case justify a finding of reverse domain name hijacking. The Panel further notes that the launching of this proceeding does not appear to have involved the Respondent in any trouble or expense.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Elise Dufour/

Elise Dufour

Sole Panelist

Date: April 3, 2023