

ADMINISTRATIVE PANEL DECISION

Elecnor S.A. v. Domains By Proxy, LLC / Pamela Dressler
Case No. D2022-0099

1. The Parties

The Complainant is Elecnor S.A., Spain, represented by Clarke, Modet y Cia. S.L., Spain.

The Respondent is Domains By Proxy, LLC, United States of America / Pamela Dressler, United States of America.

2. The Domain Name and Registrar

The disputed domain name <elecnorgroups.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 January 12, 2022. On January 13, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 14, 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 January 18, 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 January 19, 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 February 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 22, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 24, 2022.

The Center appointed Miguel B. O'Farrell as the sole panelist in this matter on March 4, 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, Elecnor S.A., is a Spanish company involved in project developing, construction and operation through two major business areas: the infrastructure business which carries out engineering, construction and services projects and the concessions business.

The Complainant claims to be the parent company of a group comprised of nearly 80 companies located in Spain and in more than 50 other countries with about 15,000 workers.

The Complainant owns many trademark registrations for ELECNOR in several jurisdictions, including the following:

European Union Trade Mark Registration No. 9496746 ELECNOR, registered on April 4, 2011, in classes 37, 40 and 42;

European Union Trade Mark Registration No. 10572857 ELECNOR, registered on June 15, 2012, in classes 6, 9, 11, 16, 19, 35, 36, 38, 41 and 45;

- Spanish Trademark Registration No. 1159100 ELECNOR, registered on June 5, 1987, in class 16;
- Spanish Trademark Registration No. 1159101 ELECNOR, registered on May 5, 1989, in class 19;
- Spanish Trademark Registration No. 1159106 ELECNOR, registered on May 3, 1990, in class 42;
- Spanish Trademark Registration No. 2957988 ELECNOR, registered on April, 13, 2011, in classes 6, 9, 11, 16, 19, 35, 36, 37, 38, 39, 40, 41, 42 and 45;

United Kingdom Trademark Registration No. 9496746 ELECNOR, registered on April 4, 2011, in classes 37, 40 and 42.

European Union Trade Mark Registration No. 10572683 GRUPO ELECNOR, registered on June 15, 2012, in classes 9, 11, 19, 35, 37, 38, 39, 40, and 42.

The Complainant is the owner of several domain names which include the trademark ELECNOR, such as <elecnorgroup.com> and many others.

The disputed domain name <elecnorgroups.com> was registered on October 8, 2021, and resolves to a webpage with links to companies possibly competing with the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant is actively using its trademarks ELECNOR not only in Spain, but also in many other countries since at least 1958.

With nearly 60 years of continued growth and presence in more than 50 countries, Elecnor has become one of the most outstanding Spanish business groups and is a benchmark in the infrastructure, renewable energy and technology sectors.

The Complainant claims that the disputed domain name is confusingly similar with the trademark ELECNOR in which the Complainant has rights and that the Respondent has no rights or legitimate interests in the disputed domain name, which was registered and is being used in bad faith.

More specifically, the Complainant has not licensed the Respondent to use its trademark and there is no relationship between the Parties that would justify the registration of the disputed domain name by the Respondent.

Nothing suggests that the Respondent is commonly known by the disputed domain name.

The Respondent has no registered trademark corresponding to the disputed domain name.

The Respondent registered the disputed domain name at a time when the Complainant's trademarks ELECNOR had already gained international status, also from a legal point of view, well-known marks. Consequently, the Respondent could not have been unaware of the Complainant and its business when registering the disputed domain name.

The Respondent registered the disputed domain name to trade off the goodwill and reputation of the Complainant's trademark or otherwise create a false association, sponsorship or endorsement with or of the Complainant and has therefore acted with "opportunistic bad faith".

Finally, the Complainant requests the Panel to issue a decision ordering 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

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the disputed domain name, the Complainant must prove each of the following, namely that:

- (i) the disputed domain name is identical or confusingly similar with 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 was registered and is being used in bad faith.

A. Identical or Confusingly Similar

As set forth in section 1.7 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") the standing test for confusing similarity involves a reasoned but relatively straightforward comparison between the trademark and the disputed domain name to determine whether the disputed domain name is confusingly similar with the trademark. The test involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

The Panel considers that the disputed domain name is confusingly similar with the Complainant's ELECNOR and GRUPO ELECNOR trademarks.

The disputed domain name <elecnorgroups.com> incorporates the Complainant's trademark ELECNOR in its entirety with the addition of the descriptive word "groups", which means "grupo" in Spanish, and certainly does not prevent a finding of confusing similarity.

The “.com” generic Top-Level Domain (“gTLD”) is viewed as a standard registration requirement and is generally disregarded under the first element confusing similarity test, as set forth in section 1.11 of [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the trademarks ELEC NOR and GRUPO ELEC NOR in which the Complainant has rights and that the requirements of paragraph 4(a)(i) of the Policy are fulfilled.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights to or legitimate interests in a domain name by demonstrating any of the following non-exclusive defenses:

- (i) before any notice to it 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 has been commonly known by the domain name, even if it has acquired no trademark 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.

Although the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a disputed domain name, it is well established, as it is put in section 2.1 of [WIPO Overview 3.0](#), that a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the domain name. Once such *prima facie* case is made, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

There is no evidence in the present case that the Respondent has been commonly known by the disputed domain name, enabling it to establish rights or legitimate interests therein.

Furthermore, there is no evidence in the file to prove any of the circumstances mentioned in paragraph 4(c) of the Policy, nor any other circumstances to suggest that the Respondent has rights or legitimate interests in the disputed domain name.

Likewise, and as further discussed under section 6.C of this decision, it does not seem that the Respondent is making any legitimate noncommercial or fair use of the disputed domain name, but rather that it intends to use the disputed domain name for the purpose of deriving unfair monetary advantage by confusing Internet users and leading them to believe that the site to which the disputed domain name relates is an official site of the Complainant.

As established in section 2.5 of [WIPO Overview 3.0](#): “Fundamentally, a respondent’s use of a domain name will not be considered ‘fair’ if it falsely suggests affiliation with the trademark owner; the correlation between a domain name and the complainant’s mark is often central to this inquiry.” Here, the nature of the disputed domain name carries a high risk of implied affiliation.

The Panel finds that the Complainant has made out a *prima facie* case, a case calling for an answer from the Respondent. The Respondent has not responded and the Panel is unable to conceive of any basis upon which the Respondent could sensibly be said to have any rights or legitimate interests in respect of the disputed domain name (*Telstra Corporation Ltd. v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

The Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name and that the requirements of paragraph 4(a)(ii) of the Policy have been fulfilled.

C. Registered and Used in Bad Faith

The Panel is satisfied that the Respondent must have been aware of the Complainant's trade name and trademarks ELECNOR and GRUPO ELECNOR mentioned in section 4 above (Factual Background) and also the Complainant's domain name <elecnorgroup.com> when it registered the disputed domain name <elecnorgroups.com> on October 8, 2021. By that time, the Complainant had widely and intensely used the trademark ELECNOR.

By registering the disputed domain name, the Respondent was targeting the Complainant and its business by incorporating the Complainant's trademark ELECNOR in its entirety and adding the descriptive word "groups", which only contributes to increase confusion particularly with the Complainant's trademark GRUPO ELECNOR, with the intention to confuse Internet users and capitalize on the fame of the Complainant's trade name and trademarks for its own benefit.

The fact that there is a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent's choice of the disputed domain name, the nature of the disputed domain name, the use of the disputed domain name to resolve to a website with links to companies possibly competing with the Complainant, the Respondent's offering for sale the disputed domain name and its failure to respond to two letters sent by the Complainant through the Registrar in order to solve the issue are indicative of bad faith (as stated in section 3.2.1 of the [WIPO Overview 3.0](#)). The Panel finds that the Respondent registered and is using the disputed domain name in bad faith.

For the above reasons, the Panel finds that the requirements of paragraph 4(a)(iii) of the Policy have been fulfilled.

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 <elecnorgroups.com>, be transferred to the Complainant.

/Miguel B. O'Farrell/

Miguel B. O'Farrell

Sole Panelist

Date: March 18, 2022