

ADMINISTRATIVE PANEL DECISION

Somfy Activites SA v. Gilles Guillouet
Case No. D2022-3828

1. The Parties

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

The Respondent is Gilles Guillouet, France.

2. The Domain Name and Registrar

The disputed domain name <fr-somfy.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 October 12, 2022. On October 13, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 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 October 17, 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 amended Complaint on October 21, 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 October 24, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 13, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 14, 2022.

The Center appointed Benjamin Fontaine as the sole panelist in this matter on November 18, 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 one of the leaders in housing technologies. Its activities extend in particular to motorization and automation for windows and doors. Founded in France in 1969, it has expanded since then in numerous countries.

The Complainant owns several hundred trade marks worldwide over the word SOMFY. As a basis for this Complaint, it relies in particular on the European Union trade mark SOMFY (word) No. 12191367, which is registered since February 27, 2014. The Complainant also owns and operates a variety of domain names as part of its activities, including <somfy.com>.

The disputed domain name was registered on March 7, 2022. The identity of the Respondent, which was concealed from the public WhoIs records, was disclosed by the Registrar in the course of this proceeding. The disputed domain name resolves to a parking page of a web host services provider.

5. Parties' Contentions

A. Complainant

The arguments of the Complainant can be summarized as follows:

On the first element of the Policy, the Complainant indicates that the disputed domain name is confusingly similar to its trade mark SOMFY. Indeed, it reproduces it identically, and the addition of the elements "fr" does not prevent finding of the confusing similarity.

On the second element of the Policy, the Complainant claims that the Respondent is not licensed or authorized to use its trade marks. It adds that "there is no plausible explanation for the Respondent's registration of the domain name. The Respondent did not have any personal attachment to the name". Also, no legitimate interest can be inferred from the (lack of) use of the disputed domain name.

On the third element of the Policy, the Complainant relies on the doctrine of bad faith passive holding. In this sense, it claims that its trade marks are highly distinctive and have a strong reputation; that the disputed domain name was registered in order to prevent it from reflecting its trade mark in a corresponding domain name; that the disputed domain name directs to a Registrar parking page; that the Respondent has concealed his identity when registering the disputed domain name; and finally that the Respondent has already been involved in acts of cybersquatting. In this respect, the Complainant refers to a recent precedent in WIPO Case No. [D2022-1338](#), *Sopra Steria Group v. Gilles Guillouet*.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy requires that the Complainant prove all of the following three elements in order to be successful in these proceedings:

- (i) the disputed domain name is identical or confusingly similar to a trade mark 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

The Complainant, under the first requirement of paragraph 4(a) of the Policy, needs to establish that the disputed domain name is identical or confusingly similar to a trade mark or a service mark in which it has rights. As per UDRP jurisprudence, this first criterion is perceived primarily as a standing requirement for the Complainant.

The Complainant has shown that it holds rights over the trade mark SOMFY.

The disputed domain name <fr-somfy.com> includes the Complainant's trade mark in its entirety, combined with the term "fr". These two words are separated with hyphens. This addition does not prevent the Complainant's trade mark from being immediately recognizable in the disputed domain name. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"): "Where the relevant trade mark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements."

As the disputed domain name includes the Complainant's trade mark in its entirety combined with a term that does not prevent the Complainant's trade mark from being recognizable in the disputed domain name, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trade mark.

Therefore, the first element of the Policy is satisfied.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a non-exclusive list of circumstances that may indicate the Respondent's rights or legitimate interests in the disputed domain name. These circumstances are:

- i. before any notice of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or
- ii. the Respondent (as individuals, businesses, or other organizations) has been commonly known by the disputed domain name, in spite of not having acquired trade mark or service mark rights; or
- iii. the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue.

The Respondent, in not responding to the Complaint, has failed to invoke any of the circumstances which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain name. This entitles the Panel to draw any inferences from such default as it considers appropriate, pursuant to paragraph 14(b) of the Rules. Nevertheless, the burden of proof is still on the Complainant to make at least a *prima facie* case against the Respondent under the second UDRP element.

In that sense, and according to the evidence submitted, the Complainant has made a *prima facie* case against the Respondent that it has not been commonly known by the disputed domain name and is not

affiliated with the Complainant, nor has it been licensed or otherwise permitted to use the Complainant's trade mark SOMFY or to register a domain name incorporating the trade mark SOMFY.

Under these circumstances and absent evidence to the contrary, the Panel finds that the Respondent does not have rights or legitimate interests with respect to the disputed domain name.

The second element set out in paragraph 4(a) of the Policy is satisfied.

C. Registered and Used in Bad Faith

In order to prevail under the third element of paragraph 4(a)(iii) of the Policy, the Complainant must demonstrate that the disputed domain name has been registered and is being used in bad faith.

Paragraph 4(b) of the Policy lists a number of circumstances which, without limitation, are deemed to be evidence of the registration and use of a domain name in bad faith. These are:

- “(i) circumstances indicating that [the respondent has] registered or acquired a disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name to the complainant or to a competitor of the complainant, for valuable consideration in excess of [the respondent's] documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) [the respondent has] registered the disputed domain name in order to prevent the complainant from reflecting the complainant's trade mark or service 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 disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the disputed domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent's] 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 [the respondent's] website or location or of a product or service on [the respondent's] website or location.”

The Panel concurs with the Complainant that the disputed domain name was registered, and is being passively used in bad faith by the Respondent.

The factors which are normally taken into account for a finding of bad faith passive holding are listed in section 3.3 of the [WIPO Overview 3.0](#), as follows: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.

All these factors are met in this case:

First, the Complainant's trade mark SOMFY is inherently distinctive, and at least in France it is directly associated to the Complainant. In this respect, the Complaint contains a printout of a recent Google search which shows results exclusively related to the Complainant when searching for “somfy”. Also, the addition of the term “fr” which typically stands for “France”, suggests that the Respondent has knowledge of the Complainant and its trade mark, as it configured the disputed domain name as a specific declination for the French market.

Second, the Respondent has failed to file a response to the Complaint.

Third, the Respondent's identity was indeed concealed from the public Whois records.

Fourth, the Respondent has already been involved in cybersquatting activities, as outlined under section 5(A) above.

Finally, the Panel does not conceive any possible use in good faith of the disputed domain name. Much the contrary: for the reasons indicated above, the disputed domain name was possibly used or is likely to be used in the future for illegal phishing activities.

To conclude: a finding of bad faith registration and passive use is in order, and accordingly, the third criteria set out in paragraph 4(a) of the Policy is also satisfied.

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, <fr-somfy.com>, be transferred to the Complainant.

/Benjamin Fontaine/

Benjamin Fontaine

Sole Panelist

Date: December 2, 2022