

ADMINISTRATIVE PANEL DECISION

Assystem and Assystem Engineering and Operation Services v. Name Redacted¹

Case No. D2022-4711

1. The Parties

The Complainant is Assystem and Assystem Engineering and Operation Services, France, represented by Vigo Law Firm, France.

The Respondent is Name Redacted.

2. The Domain Name and Registrar

The disputed domain name <engineering-assystem.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 8, 2022. On December 8, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 8, 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 (Redacted for Privacy, Witheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 21, 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 amendment to the Complaint on January 25, 2023.

The Center verified that the Complaint together with the amendment to the 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”).

¹ The Respondent appears to have used the name of a third party (a former employee for Complainant) when registering the disputed domain name. In this light, the Panel has redacted Respondent’s name from this decision. However, the Panel has attached as Annex 1 to this decision an instruction to the Registrar regarding transfer of the disputed domain name, which includes the name of Respondent. The Panel has authorized the Center to transmit Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex 1 to this decision shall not be published due to the exceptional circumstances of this case. See *Banco Bradesco S.A. v. FAST 12785241 Attn. Bradescourgente.net / Name Redacted*, WIPO Case No. [D2009-1788](#).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on January 30, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 19, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 22, 2023.

The Center appointed Fabrice Bircker as the sole panelist in this matter on March 10, 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 Assystem and Assystem Engineering and Operation Services. They both are French companies and according to undisputed information from the Complainant, Assystem Engineering and Operation Services is a 100 per cent-controlled subsidiary of Assystem.

The Complainant describes itself as an independent engineering group which provides industrial infrastructures with engineering services and managing projects that are complex in size, technological content, and safety requirements.

Its activities are notably protected through the following trademark:

ASSYSTEM, French trademark registration filed on April 13, 1995, registered under No. 95568197, regularly renewed since then, and designating services of classes 35, 36, 37, and 42.

The disputed domain name was registered on April 3, 2022.

It is resolving to a parking page displaying pay-per-click links promoting notably computer engineering services.

Besides, according to the record of the case, the disputed domain name was used to send at least one email by which the Respondent has impersonated the Complainant to propose a business partnership to the recipient.

5. Parties' Contentions

A. Complainant

The Complainant requests the transfer of the disputed domain name, and its main arguments can be summarized as follows:

The Complainant contends that the disputed domain name is confusingly similar to its ASSYSTEM trademark because it incorporates said trademark in its entirety and the latter remains recognizable within it.

Besides, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name notably because i) he has not been authorized by the Complainant to use its trademark, ii) he is not in any way related to the Complainant, iii), he is not known under the disputed domain name, and iv) he used the disputed domain name to fraudulently impersonate the Complainant.

Then, the Complainant claims that the disputed domain name was registered and is being used in bad faith notably because the Respondent used it to fraudulently impersonate a (former) employee of the Complainant.

B. Respondent

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

6. Discussion and Findings

6.1. Procedural Issue: the criminal complaint filed by the Complainant

The Complainant has indicated that further to the use of the disputed domain name in the conditions described in Section 4, it has filed a criminal complaint in France on the grounds of identity theft and attempt of swindle.

According to paragraph 18(a) of the Rules "In the event of any legal proceedings initiated prior to or during an administrative proceeding in respect of a domain-name dispute that is the subject of the complaint, the Panel shall have the discretion to decide whether to suspend or terminate the administrative proceeding, or to proceed to a decision".

In this case, the Panel finds that:

- both the criminal complaint and the present procedure have been introduced by the Complainant;
- the grounds of the criminal complaint do not interfere with the question of the possible transfer of the disputed domain name sought by the Complainant in the present UDRP procedure; and
- the Respondent, by remaining silent, has not put forward any argument in favor of the suspension or the termination of the present procedure because of the filing of the criminal complaint.

In this context, the Panel finds that the filing of the criminal complaint in France does not prevent it to proceed to a decision in the present procedure in accordance with the UDRP.

6.2. Substantive Issues

Paragraph 4(a) of the Policy provides that for obtaining the transfer or the cancellation of the disputed domain name, the Complainant must establish each of the following three elements:

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

Besides, paragraph 15(a) of the Rules provides that "[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

Paragraphs 10(b) and 10(d) of the Rules also provide that "[i]n all cases, the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case" and that "[t]he Panel shall determine the admissibility, relevance, materiality and weight of the evidence".

Besides, the Respondent's failure to reply to the Complainant's contentions does not automatically result in a decision in favor of the Complainant, although the Panel is entitled to draw appropriate inferences therefrom, in accordance with paragraph 14(b) of the Rules (see section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Taking the foregoing provisions into consideration the Panel finds as follows.

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must first establish rights in a trademark or service mark and secondly establish that the disputed domain name is identical or confusingly similar to its trademark.

It results from the documents supporting the Complaint, and in particular from Annex 3, that the Complainant is the owner of trademark registrations for ASSYSTEM, such as the one detailed in section 4 above.

Turning to whether the disputed domain name is identical or confusingly similar to the Complainant's trademark, as indicated in section 1.7 of the [WIPO Overview 3.0](#): “[w]hile each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trade mark [...], the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.”

This test is satisfied here, as the disputed domain name identically reproduces the ASSYSTEM trademark, and because the added element, namely “engineering”, does not prevent the Complainant's trademark to remain recognizable.

Indeed, there is a consensus view among UDRP panels that where the relevant trademark is recognizable within the disputed domain name, the addition of other terms would not prevent a finding of confusing similarity under the first element of the Policy (see [WIPO Overview 3.0](#), section 1.8).

Besides, the generic Top-Level-Domain (“gTLD”) “.com” may be ignored for the purpose of assessing the confusing similarity, because it only plays a technical function.

Consequently, the first element under the Policy set for by paragraph 4(a)(i) is fulfilled.

B. Rights or Legitimate Interests

Under the Policy, a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the domain name at issue. Once such a *prima facie* case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy ([WIPO Overview 3.0](#), section 2.1; or for instance *Applied Materials, Inc. v. John Warren*, WIPO Case No. [D2020-0950](#)).

In this case, the Respondent has not been authorized by the Complainant to register and to use the disputed domain name.

Besides, according to un rebutted explanations and supporting material provided by the Complainant, the disputed domain name appears to have been used in a fraudulent scheme where the Respondent has impersonated the Complainant to propose a business partnership by email.

Obviously, such use of the disputed domain name does not amount to a legitimate noncommercial or fair use. On the contrary, such use is made with intent for commercial gain by misleadingly diverting the recipient of the fraudulent email and may also tarnish the Complainant's trademark. In this respect, panels have categorically held that the use of a domain name for illegal activity (such as phishing or impersonation) can never confer rights or legitimate interests on a respondent (see [WIPO Overview 3.0](#), section 2.13; or *Colas, Société Anonyme v. Concept Bale*, WIPO Case No. [D2020-2733](#)).

At last, nothing suggests that the Respondent may legitimately be commonly known under the disputed domain name.

In view of all the above, the Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Respondent has had an opportunity to rebut the Complainant's contentions but has not done so.

Taking all the above into consideration, the Panel concludes that the Respondent has no rights or legitimate interests in the disputed domain name, and therefore that the Complainant has satisfied the second element in paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy provides that the Complainant must establish that the Respondent registered and is using the disputed domain name in bad faith.

The circumstances deemed to be evidence of the registration and use of a domain name in bad faith listed at paragraph 4(b) of the Policy are non-exhaustive examples.

In the present case, the Panel finds that:

- the disputed domain name identically reproduces the Complainant's ASSYSTEM trademark which is distinctive and predates the disputed domain name by almost 30 years,
- the Respondent has registered the disputed domain name indicating to the Registrar the Complainant's identity and address,
- the disputed domain name has been used 9 days after its registration to send at least one email deceitfully impersonating the Complainant (see paragraphs 4 and 6.B. above),
- the Respondent, while invited to defend its case, has been remaining silent in this procedure.

It necessarily results from the above findings that the Respondent registered the disputed domain name being fully aware of the Complainant's prior rights.

As mentioned above, the Respondent intentionally used the disputed domain name by deceitfully impersonating the Complainant to mislead the recipient of the email as to the identity of the sender and to fraudulently propose to the latter a business partnership.

Such conduct is deceptive, illegal, and made for commercial gain. In that regard, it is consistently held that the use of a domain name for illegitimate activity, such as fraudulent email scheme, is considered as manifest evidence of bad faith (see [WIPO Overview 3.0](#), sections 3.1.4 and 3.4).

Furthermore, and for sake of completeness, it also results from the record of the case that the disputed domain name resolves to a parking page displaying sponsored links promoting, among others, engineering activities liable to compete with the Complainant's activities. It is consistently held by prior panels that such a commercial use that unduly capitalizes on the value of a third party's trademark and misleadingly diverts consumers given the closeness between the Complainant's trademark and the disputed domain name, constitutes further evidence of bad faith use.

As a conclusion of the above, the Panel finds that the disputed domain name was registered and has been used in bad faith, within the meaning of paragraph 4(a)(iii) of the Policy

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, <engineering-assystem.com>, be transferred to the Complainant.

/Fabrice Bircker/

Fabrice Bircker

Sole Panelist

Date: March 22, 2023