

ADMINISTRATIVE PANEL DECISION

Wendel-Participations SE v. Host Master, 1337 Services LLC
Case No. D2022-4883

1. The Parties

The Complainant is Wendel-Participations SE, France, represented by Dreyfus & associés, France.

The Respondent is Host Master, 1337 Services LLC, Saint Kitts and Nevis.

2. The Domain Name and Registrar

The disputed domain name <wendelcapital.com> is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 20, 2022. On December 20, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 20, 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) 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 amended Complaint on December 23, 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 December 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 18, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 19, 2023.

The Center appointed Federica Togo as the sole panelist in this matter on January 23, 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 the registered owner of several trademarks worldwide for WENDEL, e.g. United States of America (“US”) trademark No. 4689735, dated November 22, 2013 and covering services in class 36; International trademark No. 1233694, dated November 17, 2014, designating several countries and covering services in classes 35 and 36.

The disputed domain name was registered on October 7, 2022.

Furthermore, the undisputed evidence provided by the Complainant proves that the disputed domain name resolved to a website allegedly promoting investment activities, CFDs trading services and access to financial markets and reproducing without authorization the Complainant’s trademark and logo. The Complainant sent a cease and desist letter to the Respondent on November 10, 2022. The Respondent did not reply to it. The Complainant also sent a notification to the Registrar asserting its trademark rights and requesting to block the domain name, along with a notification to the hosting provider requesting the deactivation of the infringing website. The Registrar complied with the request and placed the domain name on status client hold. The disputed domain name currently directs to an inactive page.

5. Parties’ Contentions

A. Complainant

It results from the Complainant’s allegations that it is a company that serves customers worldwide and provides investment management services. It offers portfolio management, financial planning, advisory, investment banking, private equity, real estates, brokerage, and research services for corporate, institutional investors, and individuals. Founded in France in 1704, the Wendel Group developed its business over more than 300 years in diverse range of industrial sectors, with a focus on steelmaking. Today, the Complainant is one of Europe’s leading listed investment firms, working at the intersection of industry and finance. A long-term investor with permanent capital, the Complainant has been supported for over three centuries by the Wendel family, its reference shareholder.

The Complainant contends that its trademark WENDEL is distinctive and well-known worldwide, especially in the field of investments.

In addition, the Complainant uses the domain name <wendelgroup.com>, registered on March 9, 2007, to promote its services.

The Complainant further contends that the disputed domain name is confusingly similar to the Complainant’s trademark WENDEL, since it reproduces the Complainant’s trademark WENDEL in its entirety with the addition of the term “capital”, which do not prevent any likelihood of confusion. The trademark WENDEL is recognizable within the disputed domain name.

The Complainant further contends that the Respondent has no rights or legitimate interests in the disputed domain name. According to the Complainant, the Respondent is neither affiliated with the Complainant in any way nor has it been authorized by the Complainant to use and register its trademark, or to seek registration of any domain name incorporating said trademark. In addition, according to the Complainant there is no evidence that Respondent may be commonly known by the name WENDEL. Since the disputed domain name resolved to a website allegedly promoting investment activities and reproducing without authorization the Complainant’s trademark and logo, it cannot be inferred that the Respondent is making a

legitimate non-commercial or fair use of disputed domain name, without intent for commercial gain and in order to misleadingly divert consumers, or to tarnish the trademark at issue.

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith. According to the Complainant, it is implausible that the Respondent was unaware of the Complainant when it registered the disputed domain name, since it is well-known throughout the world and the composition of the disputed domain name entirely reproducing the Complainant's trademark WENDEL, with the addition of the term "capital", directly referencing the Complainant's field of activity, confirms that the Respondent was aware of the Complainant and its trademark. Furthermore, the Respondent neither tried to defend his rights nor stated any valid arguments to justify the registration of the domain name in response to the Complainant's cease-and-desist letter. In light of this knowledge, the Respondent used the disputed domain name to direct Internet users and generate more traffic to its fraudulent website.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this Panel to "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". Paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements in order to obtain an order that the disputed domain name be transferred or cancelled:

- (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.

The Panel will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

A. Identical or Confusingly Similar

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

It results from the evidence provided that the Complainant is the registered owner of several trademark registrations for the term WENDEL. Reference is made in particular to US trademark No. 4689735, dated November 22, 2013 and covering services in class 36.

Prior UDRP panels have found that a disputed domain name is confusingly similar to a complainant's trademark where the disputed domain name incorporates the complainant's trademark in its entirety (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") at section 1.7).

This Panel shares this view and notes that the Complainant's registered trademark WENDEL is fully included in the disputed domain name, followed by the term "capital". Furthermore, it is the view of this Panel that the addition of the term "capital" in the disputed domain name does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark since the Complainant's trademark is clearly recognizable in the disputed domain name (see [WIPO Overview 3.0](#) at section 1.8).

Finally, the generic Top-Level Domain (“gTLD”) “.com” of the disputed domain name may be disregarded under the first element confusing similarity test (see [WIPO Overview 3.0](#) at section 1.11.1).

In the light of the above, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent’s rights or legitimate interests to the disputed domain name.

In the Panel’s view, based on the undisputed allegations stated above, the Complainant has made a *prima facie* case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain name.

According to the Complaint, which has remained unchallenged, the Complainant has no relationship in any way with the Respondent and did, in particular, not authorize the Respondent’s use of the trademark WENDEL or the registration of the disputed domain name.

Furthermore, the Panel notes that there is no evidence showing that the Respondent might be commonly known by the disputed domain name in the sense of paragraph 4(c)(ii) of the Policy.

Moreover, the Panel notes that the disputed domain name is clearly constituted by the Complainant’s registered trademark WENDEL and the term “capital”, which clearly refer to the Complainant’s core business, tending to suggest sponsorship or endorsement by the Complainant. The Panel finds it most likely that the Respondent selected the disputed domain name with the intent to attract Internet users for commercial gain (see e.g. *Banca Monte dei Paschi di Siena S.p.A. v. Privacy service provided by Withheld for Privacy ehf / Julius Boyler*, WIPO Case No. [D2021-2296](#)). This is also confirmed by the content of the website to which the disputed domain name resolves, allegedly promoting investment activities, CFDs trading services and access to financial markets and reproducing without authorization the Complainant’s trademark and logo.

Furthermore, the composition of the disputed domain name directly targeting the Complainant’s field of activity enhances the false impression that the disputed domain name is somehow officially related to the Complainant and an official website promoting the Complainant’s business. Such composition of the disputed domain name cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. See section 2.5.1 of the [WIPO Overview 3.0](#).

It is acknowledged that once the Panel finds a *prima facie* case is made by a complainant, the burden of production under the second element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name (see [WIPO Overview 3.0](#) at section 2.1). Since the Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name and the Respondent in the case at hand failed to come forward with any allegations or evidence, this Panel finds, in the circumstances of this case, that the Respondent has no rights or legitimate interests in the disputed domain name.

The Panel finds that the Complainant has therefore satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain

circumstances specified in paragraph 4(b) of the Policy may, “in particular but without limitation”, be evidence of the disputed domain name’s registration and use in bad faith. One of these circumstances is that the Respondent by using the disputed domain name, has intentionally attempted to attract, for commercial gain, Internet users to its 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 its website or location or of a product or service on its website or location (paragraph 4(b)(iv) of the Policy).

It is the view of this Panel that these circumstances are met in the case at hand.

It results from the Complainant’s documented allegations that the disputed domain name resolves to a website allegedly promoting similar services to those of the Complainant and reproducing without any authorization the Complainant’s trademark and the logo. For the Panel, it is therefore evident that the Respondent knew the Complainant’s mark. Consequently, and in the absence of any evidence to the contrary, the Panel is convinced that the Respondent also knew that the disputed domain name included the Complainant’s trademark when it registered the disputed domain name. This is underlined by the fact that the disputed domain name is clearly constituted by the Complainant’s registered trademark WENDEL followed by the term “capital”.

Finally, the further circumstances surrounding the disputed domain name’s registration and use confirm the findings that the Respondent has registered and is using the disputed domain name in bad faith (see [WIPO Overview 3.0](#) at section 3.2.1):

- (i) the nature of the disputed domain name (a domain name incorporating the Complainant’s mark plus the addition of the term “capital”);
- (ii) the content of the website to which the disputed domain name directs, promoting similar services to those of the Complainant and reproducing without any authorization the Complainant’s trademark and the logo;
- (iii) a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent’s choice of the disputed domain name;
- (iv) finally, the Respondent’s failure to reply to the cease and desist letter sent by the Complainant through the Registrar.

The Panel finds that the Complainant has therefore satisfied 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, <wendelcapital.com>, be transferred to the Complainant.

/Federica Togo/

Federica Togo

Sole Panelist

Date: February 6, 2023