

ADMINISTRATIVE PANEL DECISION

Alstom v. SaqibAhmed

Case No. D2023-0074

1. The Parties

The Complainant is Alstom, France, represented by Lynde & Associates, France.

The Respondent is SaqibAhmed, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <alstomext.com> (the “Domain Name”) is registered with Google LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 6, 2023. On January 9, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On January 9, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Contact Privacy Inc. Customer 7151571251) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 13, 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 January 16, 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 January 17, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 6, 2023. The Respondent sent an email to the Center on January 17, 2023, but did not submit any formal response. On February 7, 2023, the Center informed the Parties of the Commencement of Panel Appointment Process.

The Center appointed Olga Zalomiy as the sole panelist in this matter on March 2, 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 a French rolling stock manufacturer created in 1928, and holds trademark registrations that comprise the term “alstom” in numerous jurisdictions around the world, including the following:

- United States of America Trademark Registration N° 4236513 for ALSTOM (word and design) registered on November 6, 2012, and duly renewed;
- Canadian Trademark Registration N° TMA562412 for ALSTOM registered on May 23, 2002, and duly renewed;
- United Kingdom Trademark Registration N° UK00900948729 for ALSTOM registered on August 08, 2001, duly renewed.

Prior decisions under the Policy have recognized the well-known character of the ALSTOM mark¹.

The Domain Name was registered on August 17, 2022. The Domain Name has not resolved to any active website.

The Complainant sent several cease and desist letters to the Respondent via e-mail address of the Privacy service, which remained unanswered.

5. Parties' Contentions

A. Complainant

The Complainant's contentions can be summarized as follows:

The Complainant submits that the Domain Name is confusingly similar to its ALSTOM trademarks because the Domain Name includes the ALSTOM mark in its entirety. The Complainant contends the Complainant's ALSTOM mark is recognizable within the Domain Name, so the addition of a descriptive term “ext”, which is an abbreviation of the word “extension”, would not prevent finding of confusing similarity between the ALSTOM mark and the Domain Name. The Complainant contends that it is generally accepted that the generic Top-Level Domain (“gTLD”) suffix, such as “.com”, can be disregarded when assessing the similarities between a domain name and a trademark.

The Complainant submits that the Respondent has no rights or legitimate interests in the Domain Name for the following reasons: 1) the Respondent who does not own any trademark rights in the Domain Name, was not authorized by the Complainant to use its well-known mark in the Domain Name; 2) the Complainant's letters about infringement of its marks sent to the Respondent, remained unanswered; and 3) the Domain Name does not direct to an active website.

The Complainant asserts that the Domain Name was registered and is being used in bad faith. The Complainant contends that the Respondent registered the Domain Name in bad faith. The Complainant claims that the Respondent could not have been unaware of the Complainant's well-known trademark at the

¹*Alstom v. Kiran Mehta*, WIPO Case No. [D2021-2799](#); *Alstom v. Registration Private, Domains By Proxy, LLC / WEIZHONG XU*, WIPO Case No. [D2021-3417](#); *Alstom v. WhoisGuard, Inc. / Thai Bui, Thai An commercial and architecture JSC*, WIPO Case No. [D2021-0410](#).

time of the Domain Name registration. In the Complainant's opinion, such knowledge of the Complainant's mark suggests bad faith. The Complainant further claims that the Respondent's bad faith should be established based on the following: the Respondent is trying to hide its real identity behind the privacy shield. The Complainant asserts that the Domain Name does not resolve to any active website, which would not prevent a finding of bad faith use under the doctrine of passive holding given the overall circumstances of the case.

B. Respondent

The Respondent did not reply to the Complainant's contentions. The Respondent informally replied on January 17, 2023 stating: "I understand there [sic] concern I am happy to give up the domain and they can have it. I'm sorry there was no infringement intended."

6. Discussion and Findings

Pursuant to paragraph 4(a) of the UDRP, to succeed in this proceeding, the Complainant must prove each of the following elements with respect to the Domain Name:

- (i) the 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 Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the UDRP, the Complainant must prove that the Domain Name is identical or confusingly similar to the trademark or service mark in which the Complainant has rights.

The submitted evidence shows that the Complainant owns several trademark registrations for the ALSTOM mark. Pursuant to section 1.2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), this satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case.

"Where the relevant trademark 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." Section 1.8, [WIPO Overview 3.0](#). It is well-established that the applicable gTLD should be disregarded under the confusingly similarity test as a standard registration requirement. Section 1.11.1, [WIPO Overview 3.0](#).

The Domain Name consists of the Complainant's ALSTOM mark, the letters "ext" and the gTLD ".com". Because the Complainant's ALSTOM mark is recognizable within the Domain Name, the addition of the letters "ext" does not prevent a finding of confusing similarity. The gTLD ".com" is disregarded as a standard registration requirement. Therefore, the Domain Name is confusingly similar to the Complainant's ALSTOM mark.

The Complainant has satisfied the first element of the UDRP.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on the evidence, shall demonstrate a respondent's rights or legitimate interests to a domain name for the purposes of paragraph 4(a)(ii) of the Policy:

- (i) before any notice 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 (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent 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 or to tarnish the trademark or service mark at issue.

To succeed under the second UDRP element, the Complainant must make out a *prima facie* case² in respect of the lack of rights or legitimate interests of the Respondent.

The Panel finds that the Complainant satisfied its burden of production for the following reasons. First, the Complainant contends, and the Respondent does not dispute that the Respondent does not own any trademarks corresponding to the Domain Name, nor did the Complainant authorize or license the Respondent's use of the Complainant's well-known trademark in the Domain Name. The Respondent's January 17, 2023, email does not dispute this conclusion. Second, the Respondent has not been commonly known by the Domain Name. Third, the Respondent's use of the Domain Name does not satisfy requirements of *bona fide* offering of goods and services because the Domain Name does not resolve to an active website.³ Finally, where a domain name consists of a trademark plus an additional term, UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner.⁴ Here, the Domain Name consists of the Complainant's trademark and the letters "ext", which is likely to be an abbreviation for the word "extension". Such combination of the mark and the letters "ext" suggests sponsorship or endorsement by the Complainant.

Based on the foregoing, the Panel finds that the Complainant has made out the *prima facie* case and the burden of producing evidence demonstrating it has rights or legitimate interests in the Domain Name has shifted to the Respondent.⁵ Because the Respondent failed to present any rebutting evidence, the Complainant is deemed to have satisfied the second element of the UDRP.

C. Registered and Used in Bad Faith

Pursuant to paragraph 4(a)(iii) of the Policy, the Complainant must prove that the Domain Name was registered and is being used in bad faith.

It is likely that the Respondent registered the Domain Name with the Complainant's trademark in mind because the Domain Name consists of the Complainant's well-known trademark and a term related to the Complainant's business. Prior panels held that knowledge of a corresponding trademark at the time of the domain name registration suggests bad faith. The Panel is not convinced by the Respondent's email claiming, without supporting evidence, that that it did not intend to infringe [on the Complainant's rights]. Thus, the Respondent registered the Domain Name in bad faith.

"Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith."⁶ The Complainant's ALSTOM mark has acquired considerable goodwill and renown worldwide.

² Section 2.1, [WIPO Overview 3.0](#).

³ See *Instagram, LLC v. Zafer Demir, Yok*, WIPO Case No. [D2019-1072](#).

⁴ Section 2.5.1, [WIPO Overview 3.0](#).

⁵ Section 2.1, [WIPO Overview 3.0](#).

⁶ Section 3.1.4, [WIPO Overview 3.0](#).

The Respondent is, therefore, presumed to have registered and used the Domain Name in bad faith.

The Respondent's non-use or passive holding of the Domain Name also constitutes evidence of the Respondent's bad faith. It is well-established that non-use of a domain name would not prevent finding of bad faith if the totality of the circumstances of the case support a finding of bad faith. This is exactly such a case because of the following: (i) the Respondent registered the Domain Name comprising the Complainant's well-known mark; (ii) the Respondent failed to submit a response to the Complainant's allegations; (iii) the Respondent concealed his identity by using a privacy shield; and (iv) there is no plausible good faith use to which the Domain Name may be put.

Therefore, the totality of the circumstances of this case indicate that the Respondent has registered and is using the Domain Name in bad faith.

The Complainant has satisfied the third element of the UDRP.

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 Domain Name, <alstomext.com>, be transferred to the Complainant.

/Olga Zalomiy/

Olga Zalomiy

Sole Panelist

Date: March 16, 2023