

ADMINISTRATIVE PANEL DECISION

Umicore v. monika wasanm, and origin data
Case No. D2023-3721

1. The Parties

The Complainant is Umicore, Belgium, represented by Gevers Legal, Belgium.

The Respondent is monika wasanm, United States of America, and origin data, United States of America.

2. The Domain Name and Registrar

The disputed domain names <umicore-eu.com> (the “first disputed domain name”) and <euumicore.com> (the “second disputed domain name”) are registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 5, 2023. On September 5, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the first disputed domain name. On September 5, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the first disputed domain name which differed from the named Respondent (Anonymous Party/Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 7, 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 September 12, 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 September 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 3, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 9, 2023.

The Center appointed Tobias Malte Müller as the sole panelist in this matter on October 16, 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.

On September 27, 2023, the Complainant requested to add the second disputed domain name to the proceeding. On October 16, 2023, the Complainant requested the Center to confirm if the second disputed domain name had been added to the proceeding as requested.

Per the Panel's instruction, on October 25, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the second disputed domain name. Still on October 25, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the second disputed domain name which differed from the named Respondent of the first disputed domain name in the amended Complaint.

On October 30, 2023, the Panel issued the Procedural Order No.1 providing the registrant and contact information disclosed by the Registrar in relation to the second disputed domain name, and allowing the Complainant to provide further consolidation arguments within November 4, 2023 if it wished so, and subsequently the Respondent to make any submissions regarding the consolidation of the proceeding, and to file a Response in respect of the second disputed domain name as deemed appropriate within November 14, 2023. Finally, the decision due date has been extended until November 21, 2023.

None of the Parties filed additional submissions in reply to this Procedural Order No.1.

4. Factual Background

It results from the Complainant's undisputed allegations that the Complainant is a global materials technology and recycling group, with more than 10,000 employees and a turnover of EUR 10.4 billion with offices in Europe, United States of America, Canada, Asia, and Africa.

The Complaint is based amongst others on International Trademark no. 775794 for UMICORE (word mark) registered on January 22, 2002, for goods and services in classes 1, 2, 6, 9, 14, 40, and 42 and designating a large number of countries and territories throughout the world.

The first disputed domain name was registered on August 29, 2023. The second disputed domain name was registered on September 20, 2023.

The first disputed domain name does not resolve to any active website ("This site can't be reached"). The second disputed domain name resolves to the Registrar's parking page indicating that this disputed domain name has been suspended. However, it remains undisputed amongst the Parties that both disputed domain names have active mail exchanger (MX) servers connected. In addition, it results from the Complainant's documented evidence that at least on one occasion, i.e. on August 29, 2023, an email has been sent to one of the Complainant's customers from an email address under the first disputed domain name. This email was fraudulently signed in the name of the Complainant and by using the full name and contact details of one of the Complainant's employees. In that email the customer was requested to proceed with future payments for services rendered by the Complainant to a bank account (not linked to the Complainant), aiming to divert funds from the Complainant to the Respondent.

5. Parties' Contentions

A. Complainant

First, the Complainant requests the Panel to consolidate the disputed domain names in this complaint. Both

disputed domain names appear to be under the common control because: (1) there is an evident similarity in the naming pattern, as they both replicate the UMICORE mark combined with the “eu”-abbreviation and the same generic Top-Level-Domain (“gTLD”) “.com”; (2) both disputed domain names have been registered using the same privacy service provided by Withheld for Privacy ehf with the same Registrar; and (3) both disputed domain names have active MX servers connected.

Secondly, the Complainant points out that the disputed domain names are virtually identical or confusingly similar to the Complainant’s trademark. The only alteration made to the mark is the addition of two-letter country code “eu”, which references the Complainant’s presence in Europe, and the gTLD “.com”. Accordingly, the mark remains clearly recognizable within the disputed domain names.

Thirdly, the Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain names. In particular, the Complainant contends that (1) 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; (2) the Respondent was never known by any name or trade name that incorporates “Umicore”; (3) the first disputed domain name is being used for sending fraudulent emails in which the Complainant is being impersonated, and the Complainant suspects that the second disputed domain name is also being used for conducting fraudulent activities.

Finally, the Complainant contends that the disputed domain names were registered and are being used in bad faith. In particular, the email scam was designed to mislead the recipient into believing that they are corresponding with a representative of the Complainant while this was not the case. A false representation that deceives and is intended to deceive another so that the individual will act upon it to her or his legal injury constitutes fraud. The Respondent, by using the disputed domain names, has intentionally attempted to create a likelihood of confusion with the Complainant’s trademarks as to the source of the disputed domain names and/or any emails sent from an associated email address. The Respondent has registered the disputed domain names primarily for the purpose of disrupting the business of the Complainant, the intellectual property rights holder.

B. Respondent

The Respondent did neither reply to the Complainant’s contentions nor the Procedural Order No.1.

6. Discussion and Findings

6.1 Procedural Issues

A. Addition of Domain Name

According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), section 4.12.2, “Requests for addition of domain names to a complaint after it has been notified to the respondent and the proceedings have formally commenced would be addressed by the panel on appointment”. On September 27, 2023, the Complainant requested to add the second disputed domain name to the proceeding.

Considering a) the second disputed domain name was registered after the commencement of the proceeding, b) it has the same naming pattern as the first disputed domain name, and has an active MX server which carries a risk that it may be used for fraudulent purposes as the first disputed domain name, and c) the Respondent has raised no objection to the Complainant’s request, the Panel finds that it would be practical, fair, and efficient to allow the Complainant to add the second disputed domain name to this proceeding. Therefore, the Complainant’s request for addition of the second disputed domain name has been granted.

B. Consolidation of Multiple Registrants

Paragraph 10(e) of the Rules, which empowers a panel to consolidate multiple domain disputes in accordance with the Policy and Rules. A consolidated complaint may be accepted by the Center where the criteria described below are *prima facie* met. Furthermore, it is up to the panel to issue a final determination on consolidation, which may apply its discretion in certain circumstances to order the separation of a filed complaint. In all cases, the burden falls to the party seeking consolidation to provide evidence in support of its request ([WIPO Overview 3.0](#), section 4.11).

Furthermore, where a complaint is filed against multiple registrants, as in the case at hand, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario ([WIPO Overview 3.0](#), paragraph 4.11.2).

In the case at hand, the Panel notes that the following factors as indications of a common control so that the requested consolidation is appropriate:

- (1) both disputed domain names follow the same naming pattern, i.e., the combination of the Complainant's trademark UMICORE combined with the geographic abbreviation EU (for European Union) and the gTLD “.com”;
- (2) both disputed domain names have been registered using the same privacy service provided by Withheld for Privacy ehf;
- (3) both disputed domain names have been registered through the same Registrar;
- (4) both disputed domain names are connected to active MX servers; and, finally
- (5) both disputed domain names have been registered in close proximity to one another, being August 29, 2023 and September 20, 2023 respectively. The second disputed domain name was also registered shortly after the commencement of the proceeding related to the first disputed domain name. It is possible that the Respondent registered another domain name after receiving the notification of the Complaint.

In the light of these facts, this Panel finds that it is more likely than not that both disputed domain names are subject to common control. Furthermore, the Respondent had the possibility to object the consolidation and respond to the Complaint and the Complainant's consolidation request, however, the Respondent remains silent. Therefore, the Panel does not see any reasons why a consolidation should not be fair and equitable.

6.2 Substantive Issues

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 should be transferred or cancelled:

- (i) the disputed domain names are 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 names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

The Panel is satisfied that the registrants of record for the disputed domain names are the Respondent and 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 names are 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, amongst others, International Trademark no. 775794 for UMICORE (word mark) registered on January 22, 2002, and designating a large number of countries and territories throughout the world.

Many UDRP panels have found that a disputed domain name is confusingly similar to a complainant's trademark for purposes of the first element, where the relevant trademark is recognizable within the disputed domain name. Under such circumstances, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element (*cf.* section 1.8 of the [WIPO Overview 3.0](#)). This Panel shares the same view and notes that both disputed domain names contain the Complainant's registered trademark UMICORE in full. The additional element "eu" does not preventing a finding of confusing similarity. Consequently, this Panel is of the opinion that the trademark UMICORE remains recognizable within both disputed domain names.

Finally, the gTLD ".com" of the disputed domain names may be disregarded under the first element confusing similarity test (see section 1.11.1 of the [WIPO Overview 3.0](#)).

In the light of the above, the Panel finds that the disputed domain names are 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 names.

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 in the disputed domain names. In the Panel's view, based on the unrebutted 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 names.

According to the Complainant's uncontested assertions and evidence, both disputed domain names are connected to active MX servers. In addition, it results from the Complainant's documented evidence that at least on one occasion, i.e, on August 29, 2023, an email has been sent to one of the Complainant's customers from an email address under the first disputed domain name. This email was fraudulently signed in the name of the Complainant and by using the full name and contact details of one of the Complainant's employees. In that email the customer was requested to proceed with future payments for services rendered by the Complainant to a bank account (not linked to the Complainant), aiming to divert funds from the Complainant to the Respondent. The Panel considers this as illegal activity and joins previous UDRP panels' views, categorically holding that the use of a domain name for illegal activity can never confer rights or legitimate interests on a respondent (see section 2.13.1 of the [WIPO Overview 3.0](#), with further references).

In any case, the Panel holds that such use cannot be qualified as a *bona fide* offering of goods or services in accordance with paragraph 4(c)(i) of the Policy, since such use capitalizes on the reputation and goodwill of the Complainant's trademarks and is likely to mislead Internet users (see, e.g., *TELUS Corporation v. Fortefusion Fortefusion, Wordcounts*, WIPO Case No. [D2021-0787](#)). The Panel further notes that the

second disputed domain name simply resolves to the Registrar's parking page indicating it has been suspended. Such use cannot be qualified as a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use either in accordance with paragraphs 4(c)(i) and 4(c)(iii) of the Policy.

Finally, the Panel notes that there is no evidence in the record showing that the Respondent might be commonly known by the disputed domain names pursuant to paragraph 4(c)(ii) of the Policy.

It is acknowledged that once the Panel finds a *prima facie* case has been established by the Complainant, the burden of production shifts to the Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain names. Since the Respondent in the case at hand failed to come forward with any allegations or evidence, this Panel finds that the Respondent has no rights or legitimate interests in the disputed domain names.

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 names have been registered and are 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 those circumstances are those specified in paragraph 4(b)(iv) of the Policy, i.e., where the domain name is used to intentionally attempt 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.

This Panel approves the approach taken by previous UDRP panels following which the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include sending email, phishing, identity theft, or malware distribution. Many such cases involve the respondent's use of the domain name to send deceptive emails, e.g., to obtain sensitive or confidential personal information from prospective job applicants, or to solicit payment of fraudulent invoices by the complainant's actual or prospective customers (see section 3.4 of the [WIPO Overview 3.0](#)). As explained above under section 6.2.B., it results from the undisputed evidence submitted by the Complainant that at least one of the disputed domain names has been used for email scam for financial fraud impersonating the Complainant by using its company name and the name of one of its employees. In addition, this use of the first disputed domain name in such an illegal scheme additionally demonstrates that the Respondent not only knew of the Complainant, its business and marks, but also attempted to pass itself off as the Complainant.

Although the second disputed domain name resolves to a website with no substantive content, panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, considering the distinctiveness and reputation of the Complainant's trademark, lack of response from the Respondent, and the implausibility of any good faith use the second disputed domain name may be put, the Panel finds the non-use of the second disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding (see section 3.3 of the [WIPO Overview 3.0](#)).

Having reviewed the available record, the further circumstances surrounding the disputed domain names registration and use confirm the findings that the Respondent has registered and is using the disputed domain names in bad faith:

- (1) the distinctiveness of the trademark UMICORE which has been registered since at least 2002;
- (2) the Respondent's failure to respond to this Complaint and the Procedural Order No.1 with conceivable

explanation of its behavior within this proceeding so that no legitimate use of the disputed domain names by the Respondents is actually conceivable for the Panel; and

(3) the fact that the Respondent originally marked its identities behind the same privacy shield.

In the light of the above, the Panel finds that the disputed domain names have been registered and are being used in bad faith pursuant to paragraph 4(a)(iii) of the Policy. The Complainant also has satisfied the third element under the 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 names, <umicore-eu.com> and <euumicore.com>, be transferred to the Complainant.

/Tobias Malte Müller/

Tobias Malte Müller

Sole Panelist

Date: November 21, 2023