

ADMINISTRATIVE PANEL DECISION

ALSTOM v. Rudy Mort
Case No. DCO2023-0002

1. The Parties

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

The Respondent is Rudy Mort.

2. The Domain Name and Registrar

The disputed domain name <alstomgroup.co> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 5, 2023. On January 5, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 5, 2023, 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, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 12, 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 13, 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 25, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 14, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default February 21, 2023.

The Center appointed Petra Pecar as the sole panelist in this matter on February 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, ALSTOM, is a French company founded in 1928, which operates globally in the power generation, power transmission, and rail infrastructure industries. With a workforce of over 36,000 individuals spanning more than 60 countries, the Complainant offers systems, equipment, and services related to rail transportation, including electric buses. The Complainant has been involved in various projects in Iceland for the past two decades and has established significant partnerships with French regions and operators throughout Europe, providing railway vehicles and systems for national rail networks, metros, and the Eurostar. Currently, the Complainant is engaged in ongoing projects in Germany and the Netherlands. In the United States and Canada, the Complainant has a longstanding presence in Hornell and offers mobility solutions to both public and private operators across the United States.

The Complainant is the owner of several trademark registrations, including the following registrations:

- European Union mark ALSTOM (word), with registration No. 000948729 and with a registration date of August 8, 2001, for goods and services in classes 6, 7, 9, 11, 12, 16, 19, 24, 35, 36, 37, 38, 39, 40, 41 and 42,
- International Registration mark ALSTOM (word), with registration No. 706292 and with a registration date of August 28, 1998, for goods and services in classes 1, 2, 4, 6, 7, 9, 11, 12, 13, 16, 17, 19, 24, 35, 36, 37, 38, 39, 40, 41, and 42 and
- United States mark ALSTOM (word), with registration No. 4570546 and with a registration date of July 22, 2014, for goods and services in classes 1, 6, 7, 9, 11, 12, 13, 17, 19, 24, 35, 36, 37, 38, 39, 40, 41, 42, 43 and 45;

(together referred to as the “ALSTOM Trademark”).

The Complainant has registered various domain names under different generic and country code TLDs that are associated with its trademark. These domain names include variations of the terms “alstom” and “alstomgroup” as for example <alstom.is>, <alstom.com>, <alstom.ch>, <alstom.net>, and <alstom.co.uk>, among others, which are redirected to ALSTOM’s group website, “www.alstom.com”. The Complainant has also registered domain names that reflect its corporate identity, such as <alstomgroup.com> and <alstomgroup.fr>. All these domain names were registered on different dates ranging from 1998 to 2018.

The Complainant owns multiple companies and trade names with the denomination “ALSTOM” and these companies form the ALSTOM group.

The disputed domain name <alstomgroup.co> was registered on November 6, 2022. The Complainant sent a claim to the Registrar and the Respondent on December 16 and 28, 2022 respectively, requesting that they cut off access to the content accessible at the URL and delete or transfer the domain name to the Complainant. No satisfactory response was received, and the URL was at time of filing the Complaint inaccessible.

5. Parties’ Contentions

A. Complainant

The Complainant alleges that the domain name <alstomgroup.co> is confusingly similar to their trademark ALSTOM. The domain name combines the elements “ALSTOM” (which reproduces ALSTOM’s prior marks), the word “GROUP” (which refers to the ALSTOM group of companies), and the suffix “.co” (which only indicates the domain name is registered in the <.co> ccTLD). Prior cases have held that when a domain name wholly incorporates a Complainant’s mark and adds a generic word, there is a risk of confusion. The addition of the ccTLD <.co> is not to be taken into consideration when examining the identity or similarity between the trademark and disputed domain name. Thus, the disputed domain name is confusingly similar to Complainant’s prior rights, resulting in a likelihood of confusion between the Complainant’s trademark and the domain name.

The Complainant argues that the Respondent does not have any rights or legitimate interests in the domain name in question, as they are not affiliated with the Complainant as trademark owner, have not obtained any related trademark registrations, and are not commonly known under the name in question. As a result, the Complainant considers that the Respondent has no rights or legitimate interests in the disputed domain name.

The domain name in question was registered and is being used in bad faith, according to prior UDRP cases. The Respondent's bad faith is established because the domain name in dispute reproduces the Complainant's trademarks, which were well-known when the domain name was registered, and it is virtually impossible that the Respondent was not aware of the Complainant's activities at the time. The Respondent did not respond to the claim and attempted to conceal their identity by registering the domain name through an anonymization company. The contact information provided by the Respondent appear to be false, and the domain name is not used in relation to a *bona fide* offering of goods or services. The subject domain name has no substance and is only intended to impinge upon the Complainant's legal rights and damage their reputation.

B. Respondent

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

6. Discussion and Findings

Even if the Respondent did not file a Response to the Complainant's contentions, the Panel shall consider the issues present in the case based on the statements and documents submitted by the Complainant. "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", as indicated in paragraph 15(a) of the Rules.

Under paragraph 4(a) of the Policy, the Complainant is required to prove 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 by the Respondent in bad faith.

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must, firstly, 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.

A trademark registration provides a clear indication that the rights in the trademark belong to the Complainant (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 1.2.1). The Panel finds that the Complainant has provided evidence of ownership of registrations for the ALSTOM trademark, demonstrating that it has rights in the ALSTOM trademark, through registrations, which predate the registration date of the disputed domain name for 24 years.

Furthermore, it is the view of this Panel that the addition of "group", and the ccTLD ".co" of the disputed domain name does not affect the finding of confusing similarity between the Complainant's trademark and the disputed domain name. Such additional terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) do not prevent a finding of confusing similarity between the disputed domain

name and the Complainant's trademarks, in accordance with section 1.8 of the [WIPO Overview 3.0](#). Finally, it is well accepted practice by UDRP panels that a TLD (such as ccTLD ".co" in this case), is typically ignored when assessing whether a domain name is identical or confusingly similar to a trademark (see section 1.11.1 of the [WIPO Overview 3.0](#)). Accordingly, the Panel determines that the disputed domain name is confusingly similar to the Complainant's trademarks.

In accordance with the above, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy in establishing its trademark rights and showing that the disputed domain name is confusingly similar to its ALSTOM mark.

B. Rights or Legitimate Interests

Under this second element of 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. Once such *prima facie* case is made, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, the complainant is generally deemed to have satisfied the second element, as set out in paragraph 4(a)(ii) of the Policy (see also [WIPO Overview 3.0](#), section 2.1).

Moreover, the Policy provides guidance to respondents on how to demonstrate rights or legitimate interests in the domain name. In particular, paragraph 4(c) of the Policy gives examples that might show rights or legitimate interests in a domain name, including: (i) use of the domain name "in connection with a *bona fide* offering of goods or services"; or (ii) demonstration that the respondent has been "commonly known by the domain name"; or (iii) "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".

The Panel notes that the Respondent has not filed a response and thus did not deny the Complainant's assessment, nor brought any information or evidence demonstrating any rights or legitimate interests. The Respondent is not affiliated with the Complainant in any way, and the Complainant never authorized the Respondent to use its trademark as part of the disputed domain name.

The Complainant further contends that the Respondent is not commonly known under the disputed domain name or affiliated in any way to them. The Complainant has not authorized, licensed or permitted the Respondent to register or use a domain name incorporating its trademarks and does not make any *bona fide* use, either commercial or noncommercial, of the same.

Numerous previous UDRP panels have found that the Complainant's ALSTOM trademark is well-known (see for example *ALSTOM v. Daniel Bailey*, WIPO Case No. [D2010-1150](#)) and the Panel also holds that the ALSTOM trademark certainly enjoys reputation throughout the world. Having in mind the well-known status of the Complainant's trademark, the Panel agrees with the Complainant's argument that it is indeed difficult to conceive a plausible circumstance in which the Respondent could legitimately use the disputed domain name.

The Panel therefore finds that the Complainant has made a *prima facie* demonstration of the Respondent's lack of rights or legitimate interests in respect of the disputed domain name, which has not been rebutted by the Respondent, and that the Complainant has accordingly established the second element of the Policy in accordance with paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

The third element of paragraph 4(a) of the Policy requires the Complainant to demonstrate that the Respondent registered and is using the disputed domain name in bad faith. [WIPO Overview 3.0](#), section 3.1, states that "bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark".

The Policy describes several non-exhaustive circumstances demonstrating a respondent's bad faith registration and use. Under paragraph 4(b)(iv) of the Policy, a panel may find bad faith when, by using the domain name, the respondent 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 trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location.

Based on the information and the evidence provided by the Complainant, the Panel finds that it is highly unlikely that the Respondent was not aware of the Complainant's ALSTOM trademarks at the time of registration of the disputed domain name since such registration occurred at least 24 years after the registration of the Complainant's trademarks and since a trademark register search or even a simple online search prior to the registration of the disputed domain name would have informed the Respondent of the existence of the Complainant's trademarks and the Complainant's extensive use of the ALSTOM trademark as a source identifier. Moreover, the construction of the disputed domain name itself, namely the combination of the Complainant's trademark along with the descriptive term "group" is such to imply that the Respondent was aware of the Complainant and its products.

The Complainant has submitted evidence that the disputed domain name resolves to an inaccessible website displaying an error message when accessed. Based on the circumstances of this case, the Panel finds that the non-use of the disputed domain name does not prevent a finding of bad faith under the doctrine of passive holding (see [WIPO Overview 3.0](#), section 3.3).

When taken together with the Respondent's failure to respond to the Complaint and to explain itself in the course of these proceedings, the only reasonable inference, in the opinion of the Panel, is that the Respondent registered and is using the disputed domain name in bad faith in terms 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, <alstomgroup.co> be transferred to the Complainant.

/Petra Pecar/

Petra Pecar

Sole Panelist

Date: March 3, 2023