

PANEL DECISION

ELECNOR, S.A. v. Host Master, PrivActually Ltd
Case No. DEU2023-0037

1. The Parties

The Complainant is ELECNOR, S.A. of Spain, represented by Clarke, Modet & Co., Spain.

The Respondent is Host Master, PrivActually Ltd, Cyprus.

2. The Domain Name, Registry and Registrar

The Registry of the disputed domain name <groupelecnor.eu> (the “Domain Name”) is the European Registry for Internet Domains (“EURid” or the “Registry”). The Registrar of the Domain Name is Sarek Oy.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 20, 2023. On September 22, 2023, the Center transmitted by email to the Registry a request for registrar verification in connection with the Domain Name. On September 25, 2023, the Registry transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the .eu Alternative Dispute Resolution Rules (the “ADR Rules”) and the World Intellectual Property Organization Supplemental Rules for .eu Alternative Dispute Resolution Rules (the “Supplemental Rules”).

In accordance with the ADR Rules, Paragraph B(2), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on September 27, 2023. In accordance with the ADR Rules, Paragraph B(3), the due date for Response was October 17, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 18, 2023.

The Center appointed Indrek Eelmets as the sole panelist in this matter on October 25, 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 ADR Rules, Paragraph B(5).

4. Factual Background

The Complainant is a Spanish corporation active in infrastructure, renewable energy and technology sectors with more than 20,000 employees in 53 countries. The Complainant's net profit in the first nine months of 2023 exceeded EUR 70 million and net revenue stands at EUR 2,518.4 million.

The Complainant is the owner of a large number of trademarks for ELECNOR and GRUPO ELECNOR around the world, for example: Spain, European Union, Angola, Panama, Uruguay, Mexico, Canada, Australia, Argentina, Republic of Honduras, Brazil, Dominican Republic, South Africa, Bolivarian Republic of Venezuela, Republic of El Salvador, Algeria, Ghana, Morocco, United States of America, Ukraine, and United Kingdom. Among others, the Complainant has registered the trademarks:

- ELECNOR (logo) in Spain, Registration No. 2957988, filed on November 30, 2010, registered on April 13, 2011;
- ELECNOR (logo) in the European Union, Registration No. 9496746, filed on November 4, 2010, and registered on April 4, 2011; and
- GRUPO ELECNOR (logo) in the European Union, Registration No. 10572683, filed on January 19, 2012, and registered on June 15, 2012.

The Complainant also owns a number of domain names that incorporate its trademark such as <elecnor-group.com>, <elecnorgroups.com>, <groupelecnor.com>, <elecnorgroup.com>, <elecnorgroup.es>, <grupo-elecnor.net>, <grupoelecnor.net>, <grupoelecnor.pt>, <grupo-elecnor.com>, <grupoelecnor.com>, <grupoelecnor.eu>, and <grupoelecnor.es>.

The Domain Name was registered on August 30, 2023 by the Respondent. The record shows that the Domain Name has been resolving to an inactive webpage.

5. Parties' Contentions

A. Complainant

The Complainant cites its trademark registrations which have been used by the Complainant internationally since at least 1958.

The Complainant contends that the Domain Name is identical or confusingly similar to its trademarks as the Domain Name is composed of the main name of the trademarks owned by the Complainant ELECNOR with the addition of a term "group" which does not avoid a finding of confusing similarity.

The Complainant argues that the Domain Name creates confusion with the Complainant's other trademark "Grupo Elecnor" and the domain name, <grupoelecnor.com>, where the Complainant has its official Elecnor Group website.

The Complainant states that the Respondent has no rights to or legitimate interests in the Domain Name, based on the Complainant's continuous and long prior use of its trademark ELECNOR worldwide as well as on the following circumstances:

- The Complainant has not licensed or otherwise permitted the Respondent to use its trademark, and there is no relationship between the parties, which would justify the registration of the Domain Name by the Respondent.
- Nothing in the record, including the Whois information of the Domain Name, suggests that the Respondent is commonly known by the Domain Name.

- The Respondent's registration of the Domain Name occurred later than those of a vast majority of the Complainant's ELECNOR trademarks, at a time when those had already gained international status as, also from a legal point of view, well-known marks. Consequently, the Respondent could not have been unaware of the Complainant and its business when registering the Domain Name. In fact, the Respondent made a redirect to the Complainant's website after the Complainant sent a cease and desist letter to the Respondent.

The Complainant also submits that its trademark enjoys a worldwide reputation, and that the mark ELECNOR is not one that traders could legitimately adopt other than for creating an impression of an association with the Complainant and consequently dilution of the trademark ELECNOR.

Further, the Complainant alleges that the registration and use of the Domain Name was in bad faith, and submits that the Respondent must have known of the Complainant's trademark ELECNOR and used the mark in the Domain Name to trade-off the goodwill and reputation of the Complainant's trademark or otherwise create a false association, sponsorship or endorsement with or of the Complainant.

The Complainant argues that its reputation and strong presence on the Internet make it unlikely that the Respondent did not know the trademark that identify the services of the Complainant. It is unlikely that the Respondent has chosen to register the Domain Name in a casual manner, without having in mind the trademark of the Complainant, which, depending on the circumstances of the case, qualifies its performance as bad faith, given the likelihood of association that the Domain Name can generate with the well-known trademark of the Complainant.

In addition, the Complainant refers to several other cases, for example *ELECNOR, S.A. v. Tomas Tobajas Romero*, WIPO case [D2021-0586](#) and *Elecnor, S.A. v. Privacy Protection / Premium Domain Seller, YUHUAYUAN, BEIJINGDONGLU, HUAIYINQU*, WIPO Case [D2022-1534](#), and in all those cases the panels have recognized the notoriety of the trademark ELECNOR. The Complainant contends that the fact of registering domain names of notorious trademarks is already a more than evident circumstance of bad faith.

B. Respondent

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

6. Discussion and Findings

Pursuant to Paragraph B(11)(d) of the ADR Rules the Panel shall issue a decision granting the remedies requested by the Complainant in the event that the Complainant proves the following three elements:

- (i) The domain name is identical or confusingly similar to a name in respect of which a right is recognized or established by the national law of a Member State and/or European Union law and; either
- (ii) The domain name has been registered by the Respondent without rights or legitimate interest in the name; or
- (iii) The domain name has been registered or is being used in bad faith.

A. Identical or Confusingly Similar to a name in respect of which a right or rights are recognized or established by national law of a Member State and/or European Union law

The Complainant has established that it has rights in the trademarks ELECNOR, and GRUPO ELECNOR in the European Union.

The Panel finds that the Domain Name is confusingly similar to the Complainant's trademarks ELECNOR, and GRUPO ELECNOR. The word "elecnor" is entirely included in the Complainant's trademarks and, as such, the Domain Name contains sufficiently recognizable aspects of the Complainant's mark (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.9)¹. The addition of the word "group" does not prevent a finding of confusing similarity. Further, it is accepted case law that the ".eu" suffix should be disregarded for assessing identity or confusing similarity.

In view of the above, the Panel finds that the Domain Name is confusingly similar to the Complainant's trademarks. Therefore, the Complainant has established the first element of Paragraph B(11)(d)(1)(i) of the ADR Rules.

B. Rights or Legitimate Interests

The Complainant has put forward un rebutted assertions that the Respondent has no rights or legitimate interests in the Domain Name, and there is no evidence that the Respondent can establish rights or legitimate interests in the Domain Name. The Respondent failed to reply to the Complainant's contentions. The Panel infers that the Respondent is not commonly known by the Domain Name, and is not making noncommercial fair use of the Domain Name. The Complainant has not authorized or given consent to the Respondent to register the Domain Name confusingly similar to the Complainant's trademarks.

Moreover, since the Domain Name consists of the trademark ELECNOR plus the term "group" (which is also an almost identical composition to the Complainant's GRUPO ELECNOR trademark), the Panel finds that such composition cannot constitute fair use, as it effectively impersonates or suggests sponsorship or endorsement by the trademark owner (See [WIPO Overview 3.0](#), section 2.5.1).

The Panel finds that the Complainant has established the second element of Paragraph B(11)(d)(1)(ii) of the ADR Rules.

C. Registered or Used in Bad Faith

Having established that the Domain Name is confusingly similar to the Complainant's trademark and that the Respondent lacks rights or legitimate interests in the Domain Name, it is not necessary for the Complainant to show, or for the Panel to make a decision, that the Respondent registered or is using the Domain Name in bad faith. However, for the sake of completeness of the case, the Panel concludes that the evidence and arguments submitted by the Complainant show that the Domain Name has been registered in bad faith by the Respondent.

The Panel notes that the Complainant's trademark is highly distinctive and the Panel finds it probable that the Respondent was aware of the Complainant and its services when the Respondent registered the confusingly similar Domain Name. Thus, the Panel concludes that the Respondent was motivated to take unfair advantage of the Complainant's trademark.

Furthermore, the Respondent has not provided any evidence of good faith use. Under the circumstances of the case, the non-use of the Domain Name does not prevent a finding of bad faith.

Consequently, the Panel finds that the Complainant has established the third element of Paragraph B11(d)(1)(iii) of the ADR Rules.

¹ Considering the similarities between the ADR Rules and the Uniform Domain Name Dispute Resolution Policy ("UDRP"), the Panel also refers to the WIPO Overview 3.0, where appropriate.

7. Decision

For the foregoing reasons, in accordance with Paragraph B(11) of the ADR Rules, the Panel orders that the Domain Name, <groupelecnor.eu> be transferred to the Complainant².

/Indrek Eelmets/

Indrek Eelmets

Sole Panelist

Date: November 8, 2023

² (i) The decision shall be implemented by the Registry within thirty (30) days after the notification of the decision to the Parties, unless the Respondent initiates court proceedings in a Mutual Jurisdiction, as defined in Paragraph A(1) of the ADR Rules.

(ii) As the Complainant is established in Spain, the Complainant satisfies the general eligibility criteria for registration set out in Article 3 of Regulation (EU) 2019/517.