

ADMINISTRATIVE PANEL DECISION

Veolia Environnement SA v. Mark Scotto Di Perta
Case No. DAU2023-0051

1. The Parties

The Complainant is Veolia Environnement SA, France, internally represented.

The Respondent is Mark Scotto Di Perta, Australia.

2. The Domain Name and Registrar

The disputed domain name <veolia.au> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 21, 2023. On November 21, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 21, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. In response to a notification by the Center that the Complaint was administratively deficient, the Complainant filed an amendment to the Complaint on November 22, 2023.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the .au Dispute Resolution Policy (the “Policy” or “.auDRP”), the Rules for .au Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .au Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceeding commenced on November 24, 2023. In accordance with the Rules, paragraph 5(a), the due date for Response was December 14, 2023. The Respondent sent an email to the Center on December 12, 2023; however, the Respondent did not submit any formal response. On December 13, 2023, the Complainant submitted a supplemental filing by email. The Center notified the commencement of the panel appointment process on December 15, 2023.

The Center appointed Sebastian M.W. Hughes as the sole panelist in this matter on December 19, 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

A. Complainant

The Complainant is a company incorporated in France and the holding company of the Veolia Group, founded 170 years ago, operating globally, with core businesses relating to water, waste, and energy, and offering its products to customers worldwide, including customers in Australia, under the trade mark VEOLIA (the "Trade Mark").

The Complainant is the owner of, amongst other registrations, International registration No. 814678 for the Trade Mark (with designation including Australia), with a registration date of September 11, 2003.

B. Respondent

The Respondent is an individual resident in Australia.

C. The Disputed Domain Names

The disputed domain name was registered on October 3, 2022.

D. Use of the Disputed Domain Name

The disputed domain name has not been used in respect of an active website.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is identical to the Trade Mark, the Respondent has no rights or legitimate interests in respect of the disputed domain name, and the disputed domain name has been registered or subsequently used in bad faith.

B. Respondent

The Respondent did not respond formally to the Complainant's contentions.

In his email communication to the Center dated December 12, 2023, the Respondent asserted (i) that he registered the disputed domain name as it was publicly available and had not been registered by the Complainant; (ii) he and his business partners have strategic plans for the disputed domain name that bear no correlation to the sector in which the Complainant operates; (iii) there is no evidence of the disputed domain name being used in bad faith or of the Respondent engaging in trade mark infringement; and (iv) the Respondent has offered to transfer the disputed domain name to the Complainant, and the Respondent and his business partners remain receptive to receiving a fair and equitable offer for the disputed domain name.

6. Discussion and Findings

6.1 Eligibility

The .au Domain Administration Rules: Licensing (the “Eligibility Rules”) provide relevantly as follows:

“2.4 ELIGIBILITY AND ALLOCATION CRITERIA

2.4.1 A Person applying for a licence must:

1. have an Australian presence; and
2. satisfy any eligibility and allocation criteria for the namespace being applied for as specified in paragraphs 2.4.3 to 2.4.11.

2.4.2 Where a Person is applying for a licence on behalf of a related body corporate, the related body corporate must satisfy the Australian presence requirement.

.au namespace

2.4.3 A Person applying for a licence in the .au direct namespace must have an Australian presence and .au direct domain names will be allocated according to the Priority allocation process set out in the .au Direct Priority Rules.”

“Australian presence” is defined under the Eligibility Rules relevantly as follows:

“*Australian presence* means:

...

17. the applicant or owner of an Australian Trade Mark can rely upon that application or registration to establish an Australian presence, but only in respect of a domain name that is an exact match of the words which are the subject of the Australian Trade Mark application or registration...”

The Panel finds that the Complainant, as the owner of an international registration for the Trade Mark designating Australia (and in respect of which the disputed domain name – disregarding the country code Top-Level Domain - is an exact match), meets the alternative eligibility requirements set out in Section 2.4 of the Eligibility Rules.

6.2 Supplemental Filing

Panels have sole discretion, under paragraphs 10 and 12 of the Rules, whether to accept an unsolicited supplemental filing from either party, bearing in mind the need for procedural efficiency, and the obligation to treat each party with equality and ensure that each party has a fair opportunity to present its case. The party submitting its filing would normally need to show its relevance to the case and explain why it was unable to provide that information in the complaint or response (for example, owing to some exceptional circumstance).

Paragraph 12 of the Rules expressly provides that it is for the panel to request, in its sole discretion, any further statements or documents from the parties it may deem necessary to decide the case. Unsolicited supplemental filings are generally discouraged, unless specifically requested by the panel.

It is not usual practice, absent special circumstances and a satisfactory explanation from the respondent, for panels to allow supplemental responses to be filed (see Overview of Panel Views on Selected auDRP Questions, Second Edition (“auDRP Overview 2.0”), section 4.6).

In his email communication with the Center, the Respondent has not raised any issues that have not already been covered by the Complainant in the Complaint. In the circumstances the Panel declines to accept the Complainant's supplemental filing, filed in response to the Respondent's email.

6.3 Substantive Elements of the Policy

The Complainant must prove each of the three elements in paragraph 4(a) of the Policy in order to prevail.

A. Identical or Confusingly Similar

The Panel finds that the Complainant has rights in the Trade Mark.

Disregarding the country code Top-Level Domain, the disputed domain name is identical to the Trade Mark.

The Panel therefore finds that the disputed domain name is identical to the Trade Mark.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of non-exhaustive circumstances any of which is sufficient to demonstrate that a respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to the respondent of the dispute, the respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services (not being the offering of disputed domain names that the respondent has acquired for the purpose of selling, renting or otherwise transferring); or
- (ii) the respondent (as an individual, business, or other organization) has been commonly known by the disputed domain name even if the respondent has acquired no trade mark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue.

The Complainant has not authorised, licensed, or permitted the Respondent to register or use the disputed domain name or to use the Trade Mark. The Panel finds on the record that there is therefore a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name, and the burden is thus on the Respondent to produce evidence to rebut this presumption.

The Respondent has failed to show that he has acquired any trade mark rights in respect of the disputed domain name or that the disputed domain name has been used in connection with a *bona fide* offering of goods or services. To the contrary, despite referring to "strategic plans" – which the Panel notes no evidence or even detail as to what those plans may be, the disputed domain name has not been used. Furthermore, the Respondent has offered to engage in "meaningful negotiations" to transfer the disputed domain name to the Complainant for a "fair and equitable offer", apparently for an amount in excess of his costs incurred in registering the disputed domain name.

There has been no evidence adduced to show that the Respondent has been commonly known by the disputed domain name; and there has been no evidence adduced to show that the Respondent is making a legitimate noncommercial or fair use of the disputed domain name.

In addition, the nature of the disputed domain name (which is identical to the Complainant's Trade Mark) carries a high risk of implied affiliation with the Complainant (see auDRP Overview 2.0, section 2.5).

In light of the above uncontested matters, the Panel finds that the Respondent has failed to produce any evidence to establish genuine rights or legitimate interests in the disputed domain name.

C. Registered or Used in Bad Faith

Given (i) the reputation of the Complainant and of its Trade Mark in water, waste and energy industries; (ii) the distinctiveness of the Trade Mark; (iii) the fact the disputed domain name is identical to the Trade Mark; (iv) the lack of use by the Respondent of the disputed domain name (and the lack of evidence of any intended use by the Respondent of the Trade Mark); and (v) the evidence of the Respondent's offer to sell the disputed domain name to the Complainant apparently for a price in excess of the Respondent's reasonable out-of-pocket expenses incurred in registering the disputed domain name (amounting to bad faith under paragraph 4(b)(i)), the Panel finds, in all the circumstances, that the requisite element of bad faith has been made out.

The evidence suggests that the Respondent has targeted the Complainant in registering the disputed domain name; and that there cannot be any actual or contemplated good faith use of the inherently misleading disputed domain name by the Respondent.

Furthermore, in all the circumstances, the Respondent's non-use or passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy (see auDRP Overview 2.0, section 3.3).

For all the foregoing reasons, the Panel concludes that the disputed domain name has been registered or subsequently used in bad faith.

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, <veolia.au>, be transferred to the Complainant.

/Sebastian M.W. Hughes/

Sebastian M.W. Hughes

Sole Panelist

Date: January 4, 2024