

PANEL DECISION

Etablissements Sogal v. Patrice Beaut Case No. DEU2023-0047

1. The Parties

The Complainant is Etablissements Sogal of France, represented by MIIP MADE IN IP, France.

The Respondent is Patrice Beaut of France.

2. The Domain Name, Registry and Registrar

The Registry of the disputed domain name <sogal-france.eu> is the European Registry for Internet Domains (“EURid” or the “Registry”). The Registrar of the disputed domain name is Realtime Register B.V.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 6, 2023. On December 7, 2023, the Center transmitted by email to the Registry a request for registrar verification in connection with the disputed domain name. On December 11, 2023, the Registry 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 (Not disclosed) and contact information in the Complaint. The Center sent an email communication to the Complainant on the same day, providing the registrant and contact information disclosed by the Registry, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on December 18, 2023.

The Center verified that the Complaint together with the amended 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 December 19, 2023. In accordance with the ADR Rules, Paragraph B(3), the due date for Response was January 8, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 9, 2024.

The Center appointed William Lobelson as the sole panelist in this matter on January 11, 2024. 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 the French furniture manufacturer Etablissements Sogal.

It owns trademark rights in the name SOGAL:

- France, device mark SOGAL Reg. No.1281165 of January 11, 1985;
- International device mark SOGAL Reg. No. 489438 of December 10, 1984;
- European Union device mark SOGAL Reg. No. 018366106 of August 5, 2021;

The Respondent registered the disputed domain name <sogal-france.eu> on September 21, 2023. The same does not resolve to any active web page, but is used in an email address in order to send fraudulent emails to the suppliers of the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant claims that the disputed domain name is confusingly similar to its earlier trademarks, that the Respondent has no rights or legitimate interests in the disputed domain name, and that the disputed domain name has been registered and is being used in bad faith. The Complainant requests the transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

Paragraph B(11)(a) of the ADR Rules provides that the Panel "shall decide the Complaint on the basis of the statements and documents submitted and in accordance with the" Rules of Procedure.

Paragraph B(11)(d)(1) of the ADR Rules requires a Complainant seeking the transfer to itself of a domain name registered by a Respondent to prove against the Respondent, cumulatively, that:

- i) the domain name registered by the Respondent is identical or similar to the name in which the national law of the Member State and/or the law of the European Union recognizes or establishes a right; and that either
- ii) the domain name was registered by the Respondent without any right or legitimate interest in the domain 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 disputed domain name <sogal-france.eu> reproduces the Complainant's registered trademark SOGAL.

Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise), in this case the geographical term "France", would not prevent a finding of confusing similarity.

Furthermore, the addition of the Top-Level Domain “.eu” does not prevent a finding of confusing similarity.

The Panel finds therefore that the disputed domain name is confusingly similar to the Complainant's trademark and that the requirements of Paragraph B(11)(d)(1)(i) of the ADR Rules are satisfied.

B. Rights or Legitimate Interests

Article 4.4 of Regulation (EU) 2019/517: “A domain name may also be revoked, and where necessarily subsequently transferred to another party, following an appropriate ADR or judicial procedure [...] where it (a) has been registered by its holder without rights or legitimate interest in the name”.

Pursuant to Paragraph B(11)(e) of the ADR Rules, the legitimate interest condition is considered as fulfilled when:

Prior to any notice of an alternative dispute resolution procedure, the respondent has used the disputed domain name or a name corresponding to the disputed domain name in connection with the offering of goods or services or has made demonstrable preparation to do so;

b) the respondent has been commonly known by the disputed domain name;

c) the respondent is making a legitimate and non-commercial or fair use of the disputed domain name, without intend to mislead consumers or harm the reputation of the name on which a right is recognized.

The overall burden of proof under the above provision rests with the Complainant, which is required to establish that the Respondent *prima facie* lacks any rights to, or legitimate interests in, the disputed domain name, and that if the Respondent fails to answer such case, the Complainant is deemed to have satisfied its burden of proof.

The Complainant states that the Respondent has no rights to or legitimate interests in the disputed domain name on the grounds that:

- the Complainant has not licensed or otherwise permitted the Respondent to use any of its trademarks and has not permitted the Respondent to apply for or use any domain name incorporating the SOGAL mark;
- there is no evidence of 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 within the meaning of paragraph B(11)(e)(1) of the ADR Rules; and
- there is also no evidence which suggests that the Respondent is commonly known by the disputed domain name or the name “Sogal France”, or owns any trademark rights in the name SOGAL FRANCE.

The Respondent, being in default, has not presented any justification for holding the disputed domain name.

The Panel observes that the disputed domain name does not resolve to any website which would indicate that the Respondent has any kind of trademark or trade name rights in the name “Sogal France” or which would contain any reference to a commercial use of the said name in the course of trade or would indicate that the Respondent has been commonly known by the disputed domain name.

In addition, the use of a domain name for illegal activity can never confer rights or legitimate interests on a respondent. The Panel notes here that the disputed domain name is used to send fraudulent emails and therefore, rights or legitimate interests cannot be conferred on the Respondent.

In view of the factual situation, and the Complainant's contentions, that are contested by the Respondent, the Panel finds that the Respondent does not appear to have any rights or legitimate interests in the disputed domain name.

The conditions of Paragraph B(11)(d)(1)(ii) of the ADR Rules are therefore satisfied.

C. Registered or Used in Bad Faith

Article 4.4 of Regulation (EU) 2019/517: “A domain name may also be revoked, and where necessarily subsequently transferred to another party, following an appropriate ADR or judicial procedure where it: (b) has been registered or is being used in bad faith.”

The Complainant has substantiated the fact that its trademark SOGAL benefits from public’s awareness, particularly in France.

When the identity of the Respondent was disclosed by the Registry, it was found that the said Respondent had declared a place of residence in France. Due to the longstanding use of the Complainant’s mark in France, the Respondent could not reasonably be unaware of the Complainant’s rights when it registered the disputed domain name.

The Panel must examine all the circumstances of the case to determine whether the Respondent is acting in bad faith.

In this regard, the evidence supplied in support of the Complainant’s contentions shows that the Respondent is making use of the disputed domain name as an email address associated with the disputed domain name, with a view to extorting funds from the Complainant’s business partners.

This is a fraudulent impersonation of the Complainant that characterizes a use in bad faith of the disputed domain name.

The Panel is thus satisfied that the conditions of Paragraph B(11)(d)(1)(iii) of the ADR Rules are therefore satisfied.

D. Transfer of the disputed domain name / Eligibility of the Complainant

The Complainant is a French company established within the European Union. Therefore, the requirements for the requested transfer of the disputed domain name to the Complainant are satisfied (Paragraph B (1)(b)(12) of the ADR Rules).

The Panel finds that the Complainant satisfies the general eligibility criteria for registration set out in Article 3 of Regulation (EU) 2019/517..

7. Decision

For the foregoing reasons, in accordance with Paragraph B(11) of the ADR Rules, the Panel orders that the disputed domain name, <sogal-france.eu>, be transferred to the Complainant¹.

/William Lobelson/

William Lobelson

Sole Panelist

Date: January 17, 2024

¹ (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.