

ADMINISTRATIVE PANEL DECISION

EGIS v. Name Redacted

Case No. D2022-2653

1. The Parties

The Complainant is EGIS, France, represented by Novagraaf France, France.

The Respondent is Name Redacted.¹

2. The Domain Name and Registrar

The disputed domain name <egisinvestment.com> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 20, 2022. On July 20, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 21, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on July 26, 2022, 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 July 29, 2022.

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”).

¹ The Respondent appears to have used the name of a third party when registering the disputed domain name. Considering the potential identity theft, the Panel has redacted the Respondent’s name from this decision. However, the Panel has attached as Annex 1 to this decision an instruction to the Registrar regarding transfer of the disputed domain name, which includes the name of the Respondent. The Panel has authorized the Center to transmit Annex 1 to the Registrar as part of the order in this proceeding and has indicated Annex 1 to this decision shall not be published due to the exceptional circumstances of this case. See *Banco Bradesco S.A. v. FAST-12785241 Attn. Bradescourgente.net / Name Redacted*, WIPO Case No. [D2009-1788](#).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on August 1, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 21, 2022. The Respondent did not submit any response.

The Center appointed Pablo A. Palazzi as the sole panelist in this matter on September 2, 2022. 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 is a consulting, construction, engineering, and operating company that focuses on transport, infrastructure engineering, and building engineering. The Complainant has established a global network in over 100 countries, dedicated to building sustainable communities.

With over 5,000 projects and a team of 16,200 employees, EGIS provides expertise in numerous sectors of transport as well as buildings and cities. The Complainant's emphasis on research and development has not only allowed it to expand into the energy sector; particularly renewable energy, but also into digital and cyber security consultancy.

The complainant is the owner of the following trademark registrations:

- European Union, No. 005831946 filed on March 30, 2007, registered on May 6, 2008 and renewed on March 15, 2017, in classes 35, 36, 37, 39, 40, 41, 42, 44, and 45.
- French trademark registration EGIS No. 97684881 filed and registered on June 30, 1997 and renewed on June 26, 2017, in classes 35, 37, 42, and 45.
- French trademark registration EGIS No. 08 3 585 022 filed and registered on June 27, 2008 and renewed on June 26, 2018, in classes 9, 35, 36, 37, 39, 40, 41, 42, 44, and 45.
- International trademark registration EGIS No. 686345 registered on December 24, 1997, in classes 35, 36, 37, and 42, and duly renewed.
- International trademark registration EGIS No. 1009932 registered on December 19, 2008, in classes 9, 35, 36, 37, 39, 40, 41, 42, 44, and 45.
- European Union trademark registration EGIS PROJECTS No. 005430111 filed on October 19, 2006, registered on November 11, 2007 and renewed on October 26, 2016, in classes 9, 35, 36, 37, 39, and 42.
- International trademark registration EGIS PROJECTS No. 945074 registered on April 10, 2007, in classes 9, 35, 36, 37, 39, 42, and 45, and duly renewed.

In addition the Complainant is the owner of several domain names including the EGIS trademark,

- <like egis.fr> registered on August 16, 2007 and duly operated
- <egis-france.fr> registered on February 5, 2008 and duly operated
- <egis-group.com> registered on March 8, 2001 and duly operated
- <egis-groupe.fr> registered on March 6, 2007 and duly operated
- <egis-hb.fr> registered on July 3, 2012 and duly operated
- <egisindustrie.fr> registered on November 5, 2010 and duly operated
- <egis-industry.com> registered on November 5, 2010 and duly operated

The disputed domain name was registered on January 26, 2022.

According to the complaint, the disputed domain name redirected to a fraudulent website impersonating a subsidiary of the Complainant with contact information.

5. Parties' Contentions

A. Complainant

The Complainant requests that the disputed domain name be transferred to the Complainant.

According to the Complainant, each of the three elements specified in paragraph 4(a) of the Policy are satisfied in the present case.

First, the Complainant submits that the disputed domain name is identical or confusingly similar to the EGIS trademark registrations of the Complainant.

Second, the Complainant argues that the Respondent has neither rights nor legitimate interests in the disputed domain name.

Third, the Complainant submits that the disputed domain name was registered and is being used in bad faith. According to the complaint, the disputed domain name redirected to a fraudulent website impersonating a subsidiary of the Complainant with contact information. In the contact tab the company name, postal address, registration number, and VAT number were those of the complainant's subsidiary, namely Egis Investment Sarl. After the sending of a cease-and-desist letter to the email addresses found on the fraudulent website, the domain name has become inactive.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy lists three elements which a complainant must satisfy in order to succeed. The Complainant must satisfy that:

- (i) the 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 such domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain name is identical or confusingly similar to the Complainant's trademark.

The Complainant holds several valid EGIS trademark registrations.

The disputed domain name is confusingly similar to the Complainant's trademarks since it merely reproduces the EGIS trademarks with the addition of the term "investment". As numerous UDRP panels have held, where at least a dominant feature of the relevant trademark is recognizable in the domain name, it is

sufficient to establish that a domain name is identical or confusingly similar to a registered trademark.

The Panel finds the first element of the Policy has therefore been met.

B. Rights or Legitimate Interests

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

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a 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.

There is no evidence of the existence of any of those rights or legitimate interests. The Complainant has not authorized, licensed, or permitted the Respondent to register or use the disputed domain name or its trademarks. The Complainant has prior rights in the trademarks which precede the Respondent's registration of the disputed domain name. The composition of the disputed domain name, combining the Complainant's trademark with the term "investments" that is descriptive of the Complainant's activities, carries a risk of implied affiliation contrary to the fact, which cannot constitute fair use.

The use of the disputed domain name cannot constitute a *bona fide* offering of goods or services, nor a legitimate noncommercial or fair use. According to the complaint, the disputed domain name redirected to a fraudulent website impersonating a subsidiary of the Complainant with contact information. In the contact tab the company name, postal address, registration number, and VAT number were those of the complainant's subsidiary, namely Egis Investment Sarl. The use of a domain name for illegal activity, such as impersonation, can never confer rights or legitimate interests upon a respondent. After the sending of a cease-and-desist letter to the email addresses found on the fraudulent website, the domain name has become inactive.

The Complainant has therefore established a *prima facie* case that the Respondent has no rights and legitimate interests in the disputed domain name and thereby shifted the burden to the Respondent to produce evidence to rebut this presumption.

The Respondent has failed to rebut the Complainant's *prima facie* case.

Therefore, the Panel finds that the Complainant has satisfied the second requirement of paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

The Complainant must prove both that the disputed domain name was registered in bad faith and that it is being used in bad faith.

The Complainant's allegations with regard to the Respondent's registration and use of the domain name in bad faith has been considered by the Panel. These allegations have not been contested by the Respondent.

As indicated above, the Complainant's rights in the EGIS trademark predate the registration of the disputed domain name. In addition the Respondent has added the term "investment" that is related to the Complainant activities.

According to the Complaint, the disputed domain name redirected to a fraudulent website impersonating a subsidiary of the Complainant with contact information. In the contact tab the company name, postal address, registration number, and VAT number were those of the complainant's subsidiary, namely Egis Investment Sarl. After the sending of a cease-and-desist letter to the email addresses found on the fraudulent website, the domain name has become inactive.

This Panel finds that the Respondent was aware of the Complainant's trademark at the time of registration of the disputed domain name, as the Complainant's subsidiary information was available in the content of the disputed domain name. The Respondent in all likelihood registered the disputed domain name with the expectation of taking advantage of the reputation of the Complainant's trademark.

Thus in view of this the Panel is of the view that the Respondent has registered the disputed domain name to attract Internet users to the website for commercial gain in accordance with paragraph 4(b)(iv) of the Policy.

For the above reasons, the Panel finds that the disputed domain name was registered and is being used in bad faith. The current passive holding of the disputed domain name does not, given the totality of the circumstances, prevent a finding of bad faith.

The Complainant has therefore satisfied the third element under paragraph 4(a) 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 <egisinvestment.com> be transferred to the Complainant.

/Pablo A. Palazzi/

Pablo A. Palazzi

Sole Panelist

Date: September 20, 2022