

ADMINISTRATIVE PANEL DECISION

SANEF v. SANEF ALBERTIS

Case No. D2022-4169

1. The Parties

The Complainant is SANEF, France, represented by Cabinet Vidon – Marques & Juridique PI, France.

The Respondent is SANEF ALBERTIS, France.

2. The Domain Name and Registrar

The disputed domain name <groupe-sanef.com> (“Disputed Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 3, 2022. On November 4, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On November 4, 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 10, 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 amendment to the Complaint on November 14, 2022.

The Center verified that the Complaint together with the amendment to the 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 November 16, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 6, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 7, 2022.

The Center appointed Isabelle Leroux as the sole panelist in this matter on December 20, 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 French company established in 1963 and a leading actor in the sector of motorway management. The company name of the Complainant is SANEF, acronym of “Société des Autoroutes du Nord et de l’Est de la France” (France’s North and East Motorway Company).

The Complainant has been acquired by the Spanish Group ALBERTIS in 2005.

The Company’s registered office is in Issy-Les-Moulineaux, France.

The Complainant is the owner of various trademarks, including the following:

- SANEF, French trademark n° 4712040 registered on April 9, 2021, in Classes 09, 16, 25, 35, 36, 37, 38, 39, 41, 42, 43, 44, and 45;
-  “saneF” European Union semi figurative trademark n° 008310831, filed on April 17, 2009, and duly registered on January 27, 2010, in Classes 09, 16, 25, 35, 36, 37, 38, 39, 41, 42, 43, 44, and 45 (“Trademarks”).

The Complainant also has websites connected to the domain names <saneF.com> and <groupe.saneF.com>.

According to the Whois registrar’s database, the Respondent’s identity is shown as “redated for privacy” and the Disputed Domain Name was registered on February 25, 2022, through a privacy service whose mailing address is in Iceland.

Based on the information disclosed by the Registrar, the Respondent is registered as “SANEF ALBERTIS”, with an address in Issy-Les-Moulineaux, France.

However, the contact information of the Respondent, as registered with the Registrar, seems to be a telephone number and an email address registered with a private email service provider: protonmail.com.

The Disputed Domain Name used to resolve to a page displaying Pay-Per-Click (PPC) advertising in French about job hunting and human resources.

5. Parties’ Contentions

A. Complainant

The Complainant claims that:

- a) The Disputed Domain Name is identical or at least confusingly similar to the Complainant’s prior Trademarks since it reproduces the verbal sign SANEF of the Complainant’s Trademarks in full.
- b) The Respondent has no rights nor legitimate interests in the Disputed Domain Name since:
 - The Complainant has never granted any license or authorization to use its Trademarks to the Respondent;
 - The Respondent chose to hide his/her identity;
 - The Complainant is not associated with the Respondent in any way whatsoever despite the latter has used the same address to register the Disputed Domain Name;

- The Respondent is not making any legitimate use of the Disputed Domain Name.
- c) The Respondent registered and used the Disputed Domain Name in bad faith given the following factors:
 - The Complainant's Trademarks were registered long before the Disputed Domain Name and protect the core geographical area of its activity, *i.e.* France;
 - The Complainant's trademarks were known, or at least should have been known by the Respondent;
 - The registration of the Disputed Domain Name shows the Respondent's intention to prevent the Complainant from obtaining the same domain name;
 - The Respondent is using the email address associated with the Disputed Domain Name to attempt to attract, for commercial gain, Internet users to its website by creating a confusion with the Complainant's Trademarks.

With respect to the last factor, the Complainant has provided an example of fraudulent emails sent from an email address associated with the Disputed Domain Name: "[...]@groupe-sanef.com", pretending to be the head of purchase of the Complainant's group who was looking for suppliers and inviting people to submit proposals. The email reproduces the Complainant's identification information, including the Complainant's Trademarks, and, its postal address as well as its official website "www.groupe.sanef.com".

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

First of all, the Panel finds that the Complainant has provided evidence that it has prior rights in the SANEF Trademarks since they have been filed and registered several years before the Disputed Domain Name.

Then, the Panel notes that the Disputed Domain Name is composed of the identical reproduction of the SANEF Trademark in its entirety, to which the word "group" has been added associated with a hyphen, and the generic Top-Level Domain ("gTLD") ".com".

The mere addition of the term "group" with a hyphen does not prevent a finding of confusing similarity since the SANEF Trademarks are fully recognizable in the Disputed Domain Name.

Accordingly, the Panel finds that the Disputed Domain Name is confusingly similar to the trademarks in which the Complainant has rights, meaning that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Numerous UDRP panels have found that, even though the Complainant bears the general burden of proof under paragraph 4(a)(ii) of the UDRP, the burden of production shifts to the Respondent once the Complainant makes a *prima facie* showing that the Respondent lacks rights or legitimate interests.

Hence, after the Complainant has made a *prima facie* showing that the Respondent has no rights to or legitimate interests in the Disputed Domain Name, it will be deemed to have satisfied paragraph 4(a)(ii) of the UDRP when the Respondent fails to submit a response.

In this case, the Complainant brings forward the following elements:

- The Complainant has never granted any license or authorization to use its Trademarks to the Respondent;
- The Respondent chose to hide his/her identity through a proxy service since it used the Complainant's identity information to register the Disputed Domain Name;
- The Complainant is not associated with the Respondent in any way whatsoever despite the latter has used the same address to register the Disputed Domain Name;
- The Respondent has not used the Disputed Domain Name for a *bona fide* offering goods and services.

With respect to the last element, the Complainant's has provided evidence to establish that the Respondent was using the Disputed Domain Name to impersonate the Complainant to attempt to attract, for commercial gain, the Complainant's suppliers, which creates a confusion, or at least a risk of affiliation to the detriment of the Complainant.

In this regard, the Panel also notes that the nature of the Disputed Domain Name, combining the entirety of the Complainant's Trademarks with the term "groupe", carries a risk of implied affiliation (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 2.5.1). In addition, UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner.

Therefore, the Panel finds that the Complainant has made a *prima facie* case that the Respondent lacks rights to or legitimate interests in the Disputed Domain Name.

The Respondent has not come forward with any relevant evidence demonstrating rights to or legitimate interests in the Disputed Domain Name.

Given these circumstances, the Panel finds that the second element of paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

The Panel considers that the Respondent could not plausibly ignore the existence of the Complainant's Trademarks at the time the Disputed Domain Name was registered since it was registered several years after the registration of the Complainant's trademarks. Therefore, it is very likely that the Respondent had the Complainant's Trademarks in mind at the moment of registration of the Disputed Domain Name.

In addition, the fact that the Respondent used the address of Complainant's registered office to register the Disputed Domain Name further proves that the Respondent has the knowledge of the existence and the activity of the Complainant. Such use without authorization of the Complainant characterizes an attempt of impersonation.

As to the use of the Disputed Domain Name, the Complainant has evidenced that the Disputed Domain Name resolves to a parked webpage hosting PPC sponsored links. Previous UDRP panels have found that while the intention to earn click-through-revenue is not in itself illegitimate, the use of a domain name that is deceptively similar to a trademark to obtain click-through-revenue is found to be bad faith use. See *In Mpire Corporation v. Michael Frey*, WIPO Case No. [D2009-0258](#).

Furthermore, the Complainant has evidenced that the Disputed Domain Name was used to send emails to attract suppliers of the Complainant's by the Respondent who pretends to be the Complainant's employee. In the absence of any explanation from the Respondent, the Panel cannot but only believe that the Disputed Domain Name is being used for fraud purposes.

Taking into account all of the above, it is demonstrated that the use of the Disputed Domain Name by the Respondent is in bad faith.

Therefore, the Panel finds that the Respondent registered the Disputed Domain Name in bad faith and is using it in bad faith.

Consequently, the Panel finds that the third and final element of the Policy is met.

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, <groupe-sanef.com>, be transferred to the Complainant.

/Isabelle Leroux/

Isabelle Leroux

Sole Panelist

Date: January 3, 2023