

## **ADMINISTRATIVE PANEL DECISION**

Société de Négoce et de Participation and Sonepar France Interservices v.  
MD Mahabub Alam  
Case No. D2023-0329

### **1. The Parties**

The Complainants are Société de Négoce et de Participation and Sonepar France Interservices, France, represented by Dreyfus & associés, France.

The Respondent is MD Mahabub Alam, Bangladesh.

### **2. The Domain Name and Registrar**

The disputed domain name <sonepar.store> is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 24, 2023. On January 25, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 25, 2023, 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 Complainants on January 31, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainants filed an amended Complaint on February 3, 2023.

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”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on February 6, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 26, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 27, 2023.

The Center appointed Angelica Lodigiani as the sole panelist in this matter on March 8, 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

The Complainants are the French companies Société de Négoce et de Participation which is the holding company of the “Sonepar group”, and its affiliate, Sonepar France Interservices, which is part of the same group (hereinafter the “Complainant”). The Sonepar group was founded in 1969 and operates internationally in the field of B2B distribution of electrical products, solutions and related services. The Sonepar group operates in 40 countries and generated sales of approximately EUR 23 billion in 2020. The group is a global leader in its field of activity.

The Complainant is the owner of the following trademarks:

- SONEPAR (word), International registration No. 736078, registered on February 3, 2000, designating, *inter alia*, Austria, Denmark, Finland, Germany, Sweden, covering goods and services in classes 9, 11, 37 and 39;
- SONEPAR (word), French registration No. 99806224, registered on August 3, 1999, covering goods and services in classes 7, 9, 11, 19, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44 and 45;
- SONEPAR (figurative), International registration No. 1654996, registered on December 3, 2021, designating, *inter alia*, the European Union and covering goods and services in classes 7, 9, 11, 35, 37, 38, 39, 41 and 42.

The Complainant is the owner of the following domain names, which lead to its official English and French websites: <sonepar.com> registered on April 17, 1997, and <sonepar.fr> registered on February 12, 1998.

The disputed domain name was registered on January 11, 2023 and initially resolved to an online website reproducing the look and feel of the Complainant’s official website, legal notice and terms of use, and displaying the Complainant’s figurative trademark, along with some information on the Complainant. The Respondent’s website also contained a link through which to apply for a position at the Complainant and information on why it is worth working at the Complainant. In addition, the mail exchange (“MX”) records have been set up for the disputed domain name.

When the Complainant detected the disputed domain name, it sent a communication to the Registrar, asking for the removal of the website contents and the placing on hold of the disputed domain name. Following this request, the disputed domain name no longer resolves to an active website.

#### 5. Parties’ Contentions

##### A. Complainant

According to the Complainant, the disputed domain name is identical to its SONEPAR trademark, as it reproduces this mark entirely without the addition of other elements.

The Complainant maintains that the Respondent lacks rights or legitimate interests in the disputed domain name. In particular, the Respondent is not affiliated with the Complainant, nor has been authorized by the Complainant to use and register its trademark, or to seek registration of any domain name incorporating said mark. Moreover, the Respondent is not commonly known by the disputed domain name. The Respondent cannot assert that before any notice of this UDRP dispute it was using, or had made demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services. The use that the Respondent was making of the disputed domain name, as described above, is not a *bona*

*fide* use of the disputed domain name. In addition to the above, the Respondent's website was also displaying the name and trademark of the Complainant and its postal address and telephone number. Through the disputed domain name, the Respondent, was falsely suggesting that it is the owner of the trademark SONEPAR, and that its website is the Complainant's official website. The composition of the disputed domain name is such as to give an overall impression that the disputed domain name is related to the Complainant and misleadingly diverts consumers for fraud or commercial gain. Such behavior cannot amount to a legitimate or fair use of the disputed domain name.

Furthermore, MX records have been set up for the disputed domain name and thus, there is a risk that the Respondent is engaged in a phishing scheme.

In relation to bad faith, the Complainant maintains that its SONEPAR trademark enjoys strong reputation and that the composition of the disputed domain name, which identically reproduces the Complainant's trademark SONEPAR confirms that the Respondent was aware of the Complainant and of its trademark when it registered the disputed domain name. The Complainant's trademark significantly predates the date of registration of the disputed domain name, and a simple search on Google would have revealed to the Respondent the existence of the Complainant and of its SONEPAR mark. In light of the foregoing, it is inconceivable that the Respondent did not have the Complainant's trademark in mind when it registered the disputed domain name.

With respect to use in bad faith, the Complainant contends that the Respondent was using the disputed domain name to intentionally attract Internet users to its website, for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of the services offered on the Respondent's website. The way the Respondent used the disputed domain name was highly misleading for Internet users. The disputed domain name pointed to a fake online website that impersonated the Complainant's official website. The Respondent also collected Internet users' personal data through a job application form. Email servers have been configured on the disputed domain name, which entails a risk that the Respondent engaged in some sort of phishing scheme. In the Complainant's view, the Respondent's primary reason to register and use the disputed domain name was to capitalize on, or otherwise take advantage of the Complainant's trademark rights, through the creation of an initial interest confusion.

Although the disputed domain name is currently inactive, this is simply due to the result of the Complainant's intervention. Furthermore, the Respondent registered the disputed domain name through a privacy shield service to hide its identity and contact details, thus preventing the Complainant from contacting the Respondent. Lastly, the Complainant underlines that given the Complainant's goodwill and renown worldwide, and the nature of the disputed domain name, it is not possible to conceive a plausible circumstance in which the Respondent could legitimately use the disputed domain name, as it would invariably result in misleading diversion and taking unfair advantage of the Complainant's rights.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

The Panel agrees with the Complainant that the disputed domain name is identical to the Complainant's earlier trademark SONEPAR. Indeed, the disputed domain name solely consists of the trademark SONEPAR, followed by the Top-Level domain ("TLD") ".store", which is a standard registration requirement and as such is disregarded under the first element confusing similarity test.

Therefore, the Panel is satisfied that the first condition under the Policy is met.

## **B. Rights or Legitimate Interests**

While the overall burden of proof rests with the complainant, UDRP panels have recognized that this could result in the often impossible task of proving a negative, requiring information that is often primarily within the knowledge of the respondent. As such, where a complainant makes a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name.

In the instant case, the Complainant has indicated that it has no relationship whatsoever with the Respondent and that it never authorized the Respondent to register a domain name incorporating its SONEPAR trademark. Moreover, nothing in the file shows that the Respondent has been commonly known by the disputed domain name.

The Complainant notes that disputed domain name is identical to its SONEPAR trademark. Furthermore, although the TLD is usually not taken into consideration under the first element of the Policy, it can have some bearing under the second and third elements. In the instant case, the Panel finds that the adoption of the TLD “.store” in the disputed domain name enhances the confusion with the Complainant’s trademark, as the Complainant is an international reseller of electric products and the TLD “.store” is related to the Complainant’s activity. The nature of the disputed domain name carries a high risk of implied affiliation.

Before the intervention of the Complainant, the disputed domain name led to a website displaying the SONEPAR figurative trademark and containing information on the Complainant. The website also enabled to apply for a position at the Complainant through a given link, and provided explanations of the good reasons to work at the Sonepar group. Furthermore, the website reproduced the Complainant’s legal terms and conditions, as well as the Complainant’s name, postal address and telephone number. Such composition and use of the disputed domain name cannot constitute fair use as it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. The use of the disputed domain name also can not amount to a *bona fide* offering of goods or services, or to a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert Internet users or to tarnish the trademark at issue. The Internet users searching for the Complainant would certainly be misled as to the true origin of the disputed domain name.

The Respondent had the chance to rebut the Complainant’s arguments but chose not to do so. Therefore, the Panel is satisfied that the Complainant has made out a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.

In consideration of the foregoing, the Panel finds that the Complainant successfully proved the second condition under the Policy.

## **C. Registered and Used in Bad Faith**

As far as registration in bad faith is concerned, the Complainant has indicated that the SONEPAR trademark enjoys strong reputation worldwide. The Panel finds that the Complainant has not provided sufficient evidence to conclude that its SONEPAR trademark enjoys a worldwide reputation, including reputation in Bangladesh, where the Respondent resides. However, the Panel finds that the trademark SONEPAR is distinctive and that the Google search results provided by the Complainant show that the SONEPAR mark is uniquely associated with the Complainant. This circumstance, along with the fact that the disputed domain name: (i) is identical to the Complainant’s mark; (ii) is coupled with a TLD which is strictly connected to the Complainant’s activity; and (iii) resolves to a misleading website displaying the Complainant’s figurative trademark and containing information on the Complainant, lead to the undisputable conclusion that the Respondent was well aware of the Complainant and of its trademark when it registered the disputed domain name. The mere registration of a domain name that is identical to a third party’s trademark, being aware of such trademark and without rights or legitimate interests in the domain name, is evidence of bad faith.

With respect to use in bad faith, the Panel notes that the Respondent has intended to use the disputed domain name for a misleading website. Furthermore, the configuration of MX records entails that the Respondent could send fraudulent emails under the disputed domain name. Likewise, the Respondent could obtain personal and confidential information from the job applications made through its website. The Respondent has therefore attempted to impersonate the Complainant to mislead Internet users as to the source, sponsorship, affiliation or endorsement of the Respondent's website and to attract Internet users to the Respondent's website for commercial gain or other illegitimate advantage.

The fact that the disputed domain name is currently inactive cannot undermine a finding of bad faith, as the disputed domain name is held passively since the time the Complainant contacted the Registrar to place the disputed domain name on hold and to remove its illegitimate contents.

For the reasons set forth above, the Panel finds that the disputed domain name has been registered and is being used in bad faith. Therefore, also the third and last condition under the Policy has been 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 <sonepar.store> be transferred to the Complainant.

*/Angelica Lodigiani/*

**Angelica Lodigiani**

Sole Panelist

Date: March 22, 2023