

## **ADMINISTRATIVE PANEL DECISION**

Sopra Steria Group v. Nestor Hernandez Sopra Steria  
Case No. D2023-0562

### **1. The Parties**

The Complainant is Sopra Steria Group, France, represented by Herbert Smith Freehills Paris LLP, France.

The Respondent is Nestor Hernandez Sopra Steria, France.

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

The disputed domain name <cybersoprasteria.com> is registered with Amazon Registrar, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 7, 2023. On February 8, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 8, 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 (On behalf of cybersoprasteria.com owner, Identity Protection Service) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 10, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. Upon the Complainant’s request, the Center extended the due date to submit an amendment to the Complaint. The Complainant filed an amended Complaint on February 28, 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 March 1, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 21, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 23, 2023.

The Center appointed Jane Seager as the sole panelist in this matter on March 31, 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**

Established in 2014 upon the merger of the two entities Sopra Group SA and Groupe Steria SCA, the Complainant is a French company, engaged in the provision of consulting and information technology services, as well as software publishing. The Complainant is active in markets throughout the world, notably in Asia, Europe, and North Africa.

For use in connection with its activities in the IT sector, the Complainant is the registered owner of, *inter alia*, the following trademarks:

- French Trademark Registration No. 4125228, SOPRA STERIA (and design), registered on October 13, 2014;
- European Union Trade Mark No. 013623889, SOPRA STERIA (and design), registered on May 15, 2015;
- International Trademark Registration No. 1290669, SOPRA STERIA (and design), registered on September 24, 2015;
- European Union Trade Mark No. 3233335, SOPRA, registered on February 3, 2005; and
- International Trademark Registration No. 714607, STERIA, registered on February 15, 1999.

The Complainant is also the registrant of a number of domain names comprising its SOPRA STERIA trademarks, including <soprasteria.com>, which resolves to a public-facing website.

The disputed domain name was registered on November 28, 2019. The disputed domain name does not resolve to an active website.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant asserts rights in the SOPRA, STERIA, and SOPRA STERIA trademarks. The Complainant submits that the disputed domain name is confusingly similar to its trademarks.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant asserts that the disputed domain name was registered by a former employee, who did so without the Complainant's knowledge and authorization, for purposes that are unknown to the Complainant and which did not fall within the scope of the Respondent's employment contract. The Complainant submits that the Respondent cannot justify use of the disputed domain name in connection with a *bona fide* offering of goods or services, nor of any serious preparations for that purpose. The Complainant further argues that the Respondent is not commonly known by the disputed domain name.

The Complainant submits that the disputed domain name was registered and is being used in bad faith. The Complainant asserts that the Respondent never informed the relevant department of the Complainant regarding the registration of the disputed domain name while being employed at the Complainant, nor did the Respondent do so upon leaving the Complainant's employment. The Complainant submits that as a former employee of the Complainant, the Respondent indisputably had knowledge of the Complainant when

registering the disputed domain name. The Complainant asserts that the inclusion of the term “cyber” is descriptive of the Complainant’s core field of activity, and that in light of the distinctiveness of the Complainant’s SOPRA STERIA trademarks, the disputed domain name could never be used in good faith. The Complainant submits that the disputed domain name is passively held by the Respondent in bad faith.

The Complainant requests transfer of the disputed domain name.

## **B. Respondent**

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

## **6. Discussion and Findings**

In order to prevail, the Complainant must demonstrate, on the balance of probabilities, that it has satisfied the requirements of paragraph 4(a) of the Policy:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

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

The Panel finds that the Complainant has established rights in the SOPRA, STERIA, and SOPRA STERIA trademarks, selected registration details of which are provided in the factual background section above.

The disputed domain name comprises the Complainant’s SOPRA and STERIA trademarks, as well as the textual elements of the Complainant’s SOPRA STERIA trademarks in their entirety, preceded by the term “cyber”, under the generic Top-Level Domain (“gTLD”) “.com”. The Panel finds that the inclusion of the term “cyber” does not prevent a finding of confusing similarity between the disputed domain name and the Complainant’s trademarks, which are clearly recognizable in the disputed domain name. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.8. The gTLD “.com” may be disregarded for purposes of comparison under the first element. See [WIPO Overview 3.0](#), section 1.11.1.

The Panel finds the disputed domain name to be confusingly similar to trademarks in which the Complainant has rights. The Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

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

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. See [WIPO Overview 3.0](#), section 2.1.

As noted above, the disputed domain name does not resolve to an active website. There is no evidence of the Respondent having made demonstrable preparations to use the disputed domain name in connection with a *bona fide* offer of goods or services pursuant to paragraph 4(c)(i) of the Policy.

The Respondent has been identified as “Nestor Hernandez Sopra Steria”. Notwithstanding the inclusion of “Sopra Steria” in the disputed domain name, the Panel finds that there is insufficient evidence to conclude that the Respondent is commonly known by the name “Sopra Steria” independent of the disputed domain name itself so as to give rise to a claim of rights or legitimate interests in the disputed domain name under paragraph 4(c)(ii) of the Policy.

The Respondent’s non-use of the disputed domain name does not support a finding of the Respondent having made any legitimate noncommercial or fair use of the disputed domain name within the meaning of paragraph 4(c)(iii) of the Policy.

In terms of the composition of the disputed domain name itself, prior UDRP panels have held that where a domain name consists of a trademark plus an additional term, such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. See [WIPO Overview 3.0](#), section 2.5.1. The Panel finds that the combination of the Complainant’s SOPRA STERIA trademark together with the term “cyber”, which may be read as referring to a core area of the Complainant’s business, tends to suggest sponsorship or endorsement by the trademark owner, and does not support a claim of fair use of the disputed domain name.

The Panel notes that the Respondent appears to be a former employee of the Complainant. The Complainant asserts that the disputed domain name was registered without authorization, and did not form part of the Respondent’s scope of employment. There is no evidence on record to suggest that the disputed domain name was registered pursuant to any instructions from the Complainant.

The Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in respect of the disputed domain name. The Respondent has not produced any evidence to rebut the Complainant’s case. The Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

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

As a former employee of the Complainant, it is clear that the Respondent would have had prior knowledge of the Complainant’s trademarks. The Panel infers that the Respondent knowingly registered the disputed domain name, without authorization, carrying a risk of implied affiliation with the Complainant, in bad faith.

As noted above, the disputed domain name does not resolve to an active website. It is well established that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put. See [WIPO Overview 3.0](#), section 3.3. See also *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

The Panel finds that all of the above-listed factors are applicable in the context of the present case. The Complainant’s SOPRA STERIA trademark is distinctive and is widely known. There is no evidence of actual or contemplated good-faith use of the disputed domain name. The Respondent concealed its identity by registering the disputed domain name using a privacy service. There is no apparent *bona fide* use that the Respondent could make of the disputed domain name that would not tend to suggest sponsorship by or affiliation with the Complainant.

In light of the above, the Panel finds that the disputed domain name was registered and is being used in bad faith. The Complainant has satisfied the requirements of paragraph 4(a)(iii) 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 <cybersoprasteria.com> be transferred to the Complainant.

*/Jane Seager/*

**Jane Seager**

Sole Panelist

Date: April 14, 2023