

ADMINISTRATIVE PANEL DECISION

Colas v. ENT, Centrum Boekhouding (BEL01), Colas
Case No. D2023-1489

1. The Parties

The Complainant is Colas, France, internally represented.

The Respondent is ENT, Centrum Boekhouding (BEL01), Colas, United Kingdom.

2. The Domain Name and Registrar

The disputed domain names <colas-be.com> and <colas-be.net> are registered with Google LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 5, 2023. On April 5, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On April 5, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Contact Privacy Inc. Customer 7151571251) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 13, 2023, 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 April 19, 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 April 20, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 10, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 16, 2023.

The Center appointed Luca Barbero as the sole panelist in this matter on May 26, 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 Complainant was established in 1929 and is the head of an international group operating in the construction and maintenance of transport infrastructure. The group operates in three segments: road construction and maintenance, production and recycling of construction materials and railways. The Complainant is also present in other lines of business such as road safety and signaling and networks.

Backed by a workforce of 57,000 people, the Complainant undertakes 60,000 projects every year through a network of 3,000 construction units and material production and recycling sites, based in 50 countries worldwide.

The Complainant is the owner of several trademark registrations for COLAS, including the following, as per trademark certificates submitted as annexes to the Complaint:

- European Union trademark registration No. 010799559 for COLAS (word mark), filed on April 11, 2012 and registered on January 11, 2013, in classes 1, 19 and 37;
- International trademark registration No. 1380590 for COLAS (figurative mark), registered on July 26, 2017, in classes 1, 19 and 37.

The Complainant is also the owner of the domain name <colas.com>, registered on March 10, 1997, and the domain name <colas.be>, registered on May 20, 2006, both used by the Complainant to promote its services under the trademark COLAS.

The disputed domain names <colas-be.com>, registered on March 23, 2023, and <colas-be.net>, registered on April 3, 2023, are not pointed to active websites. According to the correspondence submitted as Annex 12 to the Complaint, which has not been contested by the Respondent, email addresses based on the disputed domain names have been used to deliver email communications misappropriating the Complainant's trademarks and soliciting payments due to the Complainant's subsidiary Colas Centrum.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain names <colas-be.com> and <colas-be.net> are confusingly similar to the trademark COLAS in which the Complainant has rights as they reproduce the trademark in its entirety with the mere addition of the geographical indicator "be" for Belgium and the generic Top-Level Domains ("gTLDs") ".com" and ".net".

With reference to rights or legitimate interests in respect of the disputed domain names, the Complainant states that, originally, the disputed domain names were registered through a privacy service, which could be taken as an indication of the Respondent's desire to hide its identity because of its lack of legitimate interest in the disputed domain names.

The Complainant submits that the Respondent is not commonly known by the disputed domain names, since "ENT, Centrum Boekhouding (BEL01)" does not correspond to any active business in the United Kingdom, no entity named "Colas" is based at the addresses mentioned in the Whois records of the disputed domain names and the Respondent has not used the trademark COLAS in connection with a legitimate business. The Complainant further states that the Respondent does not own any registered trademark for COLAS.

The Complainant further states that it has never authorized the Respondent to use the trademark COLAS in any way and that the Respondent is in no way affiliated with the Complainant.

Moreover, the Complainant contends that the disputed domain names are not being used in connection with a *bona fide* offering of goods or services, or for a legitimate noncommercial or fair use, since both disputed domain names resolve to inactive websites.

With reference to the circumstances evidencing bad faith, the Complainant contends that the disputed domain names have been registered by the Respondent for the purpose of conducting phishing activities, since the Respondent has sent fraudulent emails seeking payments to a Complainant's client from email addresses based on the disputed domain names.

The Complainant explains that it was informed on March 28, 2023, that the Respondent attempted to take the identity of the Complainant's subsidiary Colas Centrum in communications it sent to a Complainant's client, from an email address based on the disputed domain name <colas-be.com>. In such email communication, where the Complainant's trademarks were published along with the contact details of the Complainant's subsidiary and the name of an employee of Colas Centrum, the Respondent informed of a change in the bank details, requesting payment to a different bank account located in Portugal. The email was sent on March 23, 2023, on the same day upon which the disputed domain name <colas-be.com> was registered.

Similarly, the Respondent sent a second email to the same client of the Complainant, on April 3, 2023, *i.e.* on the same date on which the second disputed domain name <colas-be.net> was registered, seeking information about the status of a payment.

In view of the above, the Complainant submits that the registration of the disputed domain names was nothing more than a deliberate attempt to take unfair and undue advantage of the Complainant's name, trademark and reputation to conduct serious fraudulent activity, to the detriment of the Complainant and its clients.

The Complainant further underlines that Contact Privacy Inc. Customer 7151571251, indicated as registrant of the disputed domain names in the public Whois records, has been involved in 70 other UDRP cases between 2022 and 2023, a circumstance which would show the Respondent is more than familiar with proceedings concerning fraudulent and malware activities, including phishing.

B. Respondent

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

6. Discussion and Findings

According to paragraph 15(a) of the Rules: "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable." Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

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

A. Identical or Confusingly Similar

The Panel finds that the Complainant has established rights over the trademark COLAS based on the

trademark registrations cited under section 4 above and the related trademark registration details submitted as Annex 6 to the Complaint.

It is well accepted that the first element functions primarily as a standing requirement, and that the threshold test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain names to assess whether the trademark is recognizable within the disputed domain names (section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#))).

The Panel finds that the disputed domain names are confusingly similar to the trademark COLAS as they reproduce the trademark in its entirety with the mere addition of a hyphen, the two-letter term "be" (which could be interpreted as the country code for Belgium) and the gTLDs ".com" and ".net", which would not prevent a finding of confusing similarity under the first element (sections 1.8 and 1.11.1 of the [WIPO Overview 3.0](#)).

Therefore, the Panel finds that the Complainant has proven that the disputed domain names are confusingly similar to a trademark in which the Complainant has established rights according to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

It is well established that the burden of proof lies on the Complainant. However, satisfying the burden of proving a lack of the Respondent's rights or legitimate interests in respect of the disputed domain names according to paragraph 4(a)(ii) of the Policy is potentially onerous, since proving a negative can be difficult considering such information is often primarily within the knowledge or control of the Respondent.

Accordingly, in line with previous UDRP decisions, it is sufficient that the Complainant shows a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names in order to shift the burden of production on the Respondent. If the Respondent fails to demonstrate rights or legitimate interests in the disputed domain names in accordance with paragraph 4(c) of the Policy or on any other basis, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

In the case at hand, the Panel finds that the Complainant has made a *prima facie* case and that, by not submitting a Response, the Respondent has failed to invoke any circumstance that could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain names.

The Panel notes that there is no relation, disclosed to the Panel or otherwise apparent from the record, between the Respondent and the Complainant. The Respondent is not a licensee of the Complainant, nor has the Respondent otherwise obtained an authorization to use the Complainant's trademarks.

Moreover, there is no element from which the Panel could infer a Respondent's right over the disputed domain names, or that the Respondent might be commonly known by the disputed domain names. Indeed, despite the inclusion of the term "Colas" in the Respondent's name, there appear to be no business with such name located at the Respondent's addresses listed in the Whois records and there is no evidence that the Respondent might have used the name "Colas" in connection with a legitimate business.

On the contrary, according to the evidence submitted by the Complainant - which has not been challenged by the Respondent - the disputed domain names, despite not being directed to active websites, have been used for the creation of email addresses used for the sending of emails in which the Respondent impersonated an employee of a Complainant's subsidiary and solicited payments to the addressee.

The Panel finds that the Respondent's use of the disputed domain names does not amount to a *bona fide* offering of goods or services or a legitimate noncommercial or fair use without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's trademark.

Indeed, as stated in section 2.13.1 of the [WIPO Overview 3.0](#), Panels have categorically held that the use of a domain name for illegal activity, such as phishing, impersonation/passing off or other types of fraud, can never confer rights or legitimate interests on a respondent.

Therefore, the Panel finds that the Complainant has proven that the Respondent has no rights or legitimate interests in the disputed domain names according to paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires that the Complainant prove that the disputed domain names were registered and are being used by the Respondent in bad faith.

As to bad faith at the time of registration, the Panel finds that, in light of i) the prior registration and use of the Complainant's trademark COLAS in connection with the Complainant's products and services, promoted also online via the Complainant's website "www.colas.com", ii) the widely known character of the trademark in its sector and iii) the confusing similarity of the disputed domain names with the Complainant's trademark, the Respondent very likely registered the disputed domain names having the Complainant's trademark in mind.

In addition, according to the evidence on records, email addresses based on the disputed domain names were used for the sending of scam emails which misused the Complainant's trademarks and the contact details of a Complainant's subsidiary Colas Centrum and pretended to be sent on behalf of an employee of the Complainant's subsidiary. The Panel finds that this is compelling evidence of actual knowledge of the Complainant and its trademarks that leads to a finding of registration in bad faith.

The Panel finds that the Respondent's use of the disputed domain names in connection with the sending of scam/phishing email communications clearly shows the Respondent's bad faith. As stated in section 3.4 of the [WIPO Overview 3.0](#), "Panels have held that the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include sending email, phishing, identity theft, or malware distribution. (...) Many such cases involve the respondent's use of the domain name to send deceptive emails, e.g., to obtain sensitive or confidential personal information from prospective job applicants, or to solicit payment of fraudulent invoices by the complainant's actual or prospective customers".

Therefore, the Panel finds that the Complainant has also proven that the Respondent registered and has been using the disputed domain names in bad faith according to 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 names <colas-be.com> and <colas-be.net> be transferred to Complainant

/Luca Barbero/

Luca Barbero

Sole Panelist

Date: June 13, 2023