

## **ADMINISTRATIVE PANEL DECISION**

COLAS v. Elsa Linerudt

Case No. D2023-2344

### **1. The Parties**

The Complainant is COLAS, France, internally represented.

The Respondent is Elsa Linerudt, United States of America (“US”).

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

The disputed domain name <colas-be.xyz> is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 31, 2023. On June 7, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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 June 8, 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 June 12, 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 June 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 4, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 5, 2023.

The Center appointed Anna Carabelli as the sole panelist in this matter on July 10, 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 is a globally leading French company established in 1929, and specialized in 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.

The Complainant employs around 58,000 people and undertakes about 60,000 projects every year via a network of 900 construction units and 3,000 material production and recycling sites in around 50 countries worldwide. In 2022, the Complainant's consolidated revenue totaled EUR 15,5 billion.

The Complainant is the owner of several trademark registrations for COLAS, including:

- the 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; and
- the International trademark registration No. 1380590 for COLAS (figurative mark), registered on July 26, 2017, in classes 1, 19 and 37, designating several jurisdictions, including the US.

The Complainant is also the owner of the domain name <colas.com>, registered on March 10, 1997, and of 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 name <colas-be.xyz> was registered on May 23, 2023, and does not resolve to an active website. According to the evidence submitted with the Complaint, which has not been contested by the Respondent, email addresses based on the disputed domain name have been used to deliver email communications misappropriating the Complainant's trademarks and soliciting payments from customers of the Complainant under the name of an employee of the Complainant, and under email addresses which are close to the Complainant's genuine and official email addresses.

#### 5. Parties' Contentions

##### A. Complainant

The Complainant asserts and contends that:

- The disputed domain name is confusingly similar to the Complainant's trademark COLAS as it reproduces the trademark in its entirety with the mere addition of the term "be" which refers to the country code for Belgium and the Top-Level Domain ("TLD") ".xyz". The presence of the term "be" reinforces such a confusion as the Complainant has been operating in Belgium for many years, notably through its website "www.colas.be" of which the associated domain name <colas.be> is extremely close and similar to the disputed domain name;
- The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant points out that, originally, the disputed domain name was 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 rights or legitimate interests in the disputed domain name;
- The Respondent: (i) has no connection whatsoever with the Complainant, (ii) has not been authorized or somehow given consent by the Complainant to use the trademark COLAS, (iii) does not own any registered trademark for COLAS, and (iv) is not commonly known by the disputed domain name;

- The disputed domain name is not being used in connection with a *bona fide* offering of goods or services, or for a legitimate noncommercial or fair use, since it does not resolve to an active website. The disputed domain name has been registered by the Respondent for conducting phishing activities that the Respondent is accustomed to, including against the Complainant. In this regard, the Complainant explains that on March 28, 2023, it was informed that the Respondent attempted to take the identity of an employee of the Complainant's Belgian subsidiary Colas Centrum in communications it sent to a Complainant's customer, by using the domain name <colas-be.com>. In such email communications, where the Complainant's trademarks were used along with the contact details of the Complainant's subsidiary and the name of an employee of Colas Centrum, the author of the fraud informed the Complainant's customer of a change in the bank details, requesting payment to a different bank account located in Portugal. Then, on April 3, 2023, the same fraudulent activity was conducted with the same customers of the Colas Group, this time under the domain name <colas-be.net>, which was registered on the same date. The disputed domain name was registered on May 23, 2023, and on the exact same date, the Respondent pursued the same exact fraudulent activity with the same customer of the Complainant, and using the same identity of Colas Centrum's employee. This indicates that the Respondent is linked to all those three domain names (<colas-be.com>, <colas-be.net> and the hereby disputed domain name <colas-be.xyz>) and seeks to extort money from the Complainant's customers. The Complainant further underlines that the domain names <colas-be.net> and <colas-be.com> were registered anonymously, but with the indication of a customer number 7151571251 which was later found involved in almost 70 UDRP cases and WIPO decisions rendered in 2022 and 2023, a circumstance which would show that the Respondent is more than familiar with proceedings concerning fraudulent and malware activities, including phishing.
- The Respondent has registered and used the disputed domain name in bad faith, to deceive Internet users and to receive commercial gain through the operation of the disputed domain name.

Based on the above, the Complainant requests that the disputed domain name be transferred to the Complainant.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 15(a) of the Rules instructs the panel to decide the complaint based on the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Under paragraph 4(a) of the Policy, the complainant must prove each of the following:

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

Paragraph 4(b) of the Policy sets out four illustrative circumstances, which for the purposes of paragraph 4(a)(iii) of the Policy, shall be evidence of registration and use of a domain name in bad faith.

Paragraph 4(c) of the Policy sets out three illustrative circumstances any one of which, if proved by the respondent, shall be evidence of the respondent's rights to or legitimate interests in a disputed domain name for the purpose of paragraph 4(a)(ii) of the Policy above.

## A. Identical or Confusingly Similar

The Panel finds that the Complainant has established rights over the trademark COLAS based on the evidence submitted in the Complaint.

The disputed domain name consists of the Complainant's trademark COLAS with addition of a hyphen, the two-letter term "be" (which could be interpreted as the country code for Belgium), followed by the TLD ".xyz".

The addition of the TLD such as ".xyz" is viewed as a standard registration requirement and as such is typically disregarded under the first element confusing similarity test (see section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Therefore, the relevant comparison to be made is with the second-level portion of the disputed domain name, *i.e.*, "colas-be". As highlighted in section 1.7 of the [WIPO Overview 3.0](#), the threshold test for confusing similarity typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. The disputed domain name entirely incorporates the Complainant's mark COLAS and this is a sufficient element to establish confusing similarity, as held by previous UDRP panels (*e.g.*, *Banca Mediolanum S.p.A. v. Domains By Proxy, LLC / Marzia Chiarello*, WIPO Case No. [D2020-1955](#); *Virgin Enterprises Limited v. Domains By Proxy LLC, Domainsbyproxy.com / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2020-1923](#); *Patagonia, Inc. v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2019-1409](#)).

As recorded in section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element.

Accordingly, the Panel finds that disputed domain name is confusingly similar to a mark in which the Complainant has rights. Therefore, the Complainant has established paragraph 4(a)(i) of the Policy.

## B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, a respondent may demonstrate its rights or legitimate interests in a domain name by showing any of the following circumstances, in particular but without limitation:

- (i) before any notice to it of the dispute, its use of, or demonstrable preparation to use the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods and services;
- (ii) it has been commonly known by the domain name, even if it has acquired no trademark or service mark rights;
- (iii) it is 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.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name, based on the following: (a) the Complainant holds prior rights in the globally registered and well-known COLAS mark, (b) the Respondent has not been authorized to use the Complainant's trademark in any way, and is not commonly known by the disputed domain name (c) the disputed domain name does not resolve to an active website and is being used to conduct a fraudulent activity.

According to section 2.1 of the [WIPO Overview 3.0](#), 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.

Here the Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. By not submitting a response, the Respondent has failed to invoke any circumstance, including those listed under paragraph 4(c) of the Policy.

According to the evidence submitted by the Complainant – which has not been challenged by the Respondent – the disputed domain name, despite not being directed to an active website, have been used for the creation of an email address for the sending of emails in which the Respondent impersonated an employee of a Complainant's subsidiary, and solicited payments to the addressee. Previous Panels have unanimously and consistently 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 (see section 2.13.1 of the [WIPO Overview 3.0](#)).

Based on the above, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name and the Complainant has satisfied the requirement under paragraph 4(a)(ii) of the Policy.

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

According to paragraph 4(a)(iii) of the Policy, the Complainant must establish that the disputed domain name has been registered and used in bad faith.

The Complainant's trademark COLAS is distinctive and well known, and the date of its first registration significantly precedes the date of registration of the disputed domain name. The uncontested evidence submitted by the Complainant shows that the email address based on the disputed domain name was used to send scam emails which misused the Complainant's trademarks and the contact details of the Complainant's subsidiary Colas Centrum, and pretended to be sent on behalf of an employee of the latter. This indicates that the Respondent knew and targeted the Complainant when registering the disputed domain name, and leads to a finding of registration in bad faith. The Panel also notes that the domain names <colas-be.com> and <colas-be.net>, related with *Colas v. ENT, Centrum Boekhouding (BEL01)*, *Colas*, WIPO Case No. [D2023-1489](#), were used in an almost identical fraudulent email scheme as the one in the current case. Even though the Respondent's name in the aforementioned case was reportedly different, the Panel finds it more likely than not that all these domain names were subject to common control, showing that the Respondent has engaged in a pattern of abusive registrations.

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".

Based on the above, the Panel finds that the Complainant has established also 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, <colas-be.xyz> be transferred to the Complainant.

*/Anna Carabelli/*

**Anna Carabelli**

Sole Panelist

Date: July 21. 2023