

ADMINISTRATIVE PANEL DECISION

Societe Anonyme De Presse et D'edition Du Sud-Ouest (S.A.P.E.S.O.) v.
zaid, zaid alamin elfilahi elfilahi
Case No. D2023-2540

1. The Parties

The Complainant is Societe Anonyme De Presse et D'edition Du Sud-Ouest (S.A.P.E.S.O.), France, represented by Selarl Valerie Gastinel, France.

The Respondent is zaid, zaid alamin elfilahi elfilahi, Morocco.

2. The Domain Name and Registrar

The disputed domain name <sudoouest-fr.com> is registered with Hostinger, UAB (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on June 13, 2023. On June 13, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 14, 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 Protect, LLC (PrivacyProtect.org)) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 26, 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 26, 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 27, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 17, 2023. The Respondent did not submit any formal response. However, an email communication was received from the Respondent on June 27, 2023 in the following terms: "Hello everyone, at the request of one of our customers we have reserved the domain name

<sudoest-fr.com.> we are not responsible for the customer's activities or the content of the site, following your intervention we have suspended this domain name reserved at hostinger. This "descution" is terminated by us." Accordingly, the Center notified Commencement of Panel Appointment Process on July 25, 2023.

The Center appointed Antony Gold as the sole panelist in this matter on August 1, 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 French media group located in Bordeaux, France. It owns the Sud Ouest newspaper, which it describes as the second biggest regional, daily newspaper in France. The Complainant's newspaper was first published in August 1944 and it has a current circulation of 219,000.

The Complainant has registered trade marks to protect its use of SUD OUEST. These include, by way of example only, French trade mark, registration number 99783560 for SUD OUEST (stylized) in classes 16, 35, 38, 39 and 41, registered on March 24, 1999. The Complainant also owns many domain names which comprise or include the term "sud ouest", including <sudoest.fr>, which resolves to the online edition of its newspaper.

The disputed domain name was registered by the Respondent on June 21, 2021. It has previously resolved to a website the home page was which was in a form similar to the home page of the online edition of the Complainant's newspaper, and included a semi-figurative trade mark of the Complainant. The home page of the website featured a pay-per-click ("PPC") advertisement for a well-known charge card. Other links on the Respondent's website took Internet visitors to pages of the Complainant's website. The disputed domain name does not presently resolve to an active website.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name. Notably, the Complainant contends that;

- the disputed domain name is confusingly similar to the Complainant's SUD OUEST trade mark in that it fully incorporates the Complainant's mark and neither the additional letters "fr" nor the hyphen in the disputed domain name are of significance;
- the Respondent does not have rights or a legitimate interest in the disputed domain name. The Respondent is not known by the disputed domain name and is not engaged in fair use of it. Moreover, the Respondent has copied the Complainant's official website without authorization;
- the disputed domain name was registered and is being used in bad faith. The disputed domain name appears to have been registered for the purpose of disseminating commercial offers by falsely presenting them as having been produced by the Complainant. By way of example, as at May 2023, advertising banners from a charge card company had been added on every page of the Respondent's website. Moreover, clicking on the various tabs of the Respondent's website redirected the viewer to the pages of the Complainant's official website. Such use is obviously fraudulent and harmful in that Internet users were misled into believing that the disputed domain name is legitimate and was the official website of the Complainant's newspaper.

B. Respondent

Save for its email to the Center dated June 27, 2023 referred to above, the Respondent did not reply to the Complainant's contentions. So far as this communication is concerned, notwithstanding the Respondent's denial of responsibility for the website to which the disputed domain name has previously resolved, the Respondent is recorded by the Registrar as the registrant of the disputed domain name. It is accordingly the proper Respondent to the Complaint and, in the absence of any credible evidence to the contrary, is *prima facie* responsible for the use to which the disputed domain name has been put.

6. Discussion and Findings

Dealing, first, with the Respondent's failure to file a formal response to the Complaint, paragraph 14(b) of the Rules provides that if a party, in the absence of exceptional circumstances, does not comply with a provision of, or requirement under, these Rules, the Panel shall be entitled to draw such inferences from this omission as it considers appropriate.

Paragraph 4(a) of the Policy requires that the Complainant proves each of the following three elements in order to succeed in its Complaint: (i) the disputed domain name is identical or confusingly similar to a trade mark 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.

A. Identical or Confusingly Similar

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

Based on the available record, the Panel finds the Complainant has shown rights in respect of its SUD OUEST trade mark for the purposes of the Policy, see the [WIPO Overview 3.0](#), section 1.2.1. As a technical requirement of registration, the generic Top-Level Domain ("gTLD"), that is ".com" in the case of the disputed domain name, is usually disregarded when assessing confusing similarity. The comparison is between the textual component of the Complainant's stylized marks and the disputed domain name, see section 1.10 of the [WIPO Overview 3.0](#). With this in mind, the Complainant's SUD OUEST trade mark is reproduced in its entirety within the disputed domain name and is clearly recognizable within it. In these circumstances, neither the addition of a hyphen nor the letters "fr" prevents a finding of confusing similarity between the disputed domain name and the Complainant's mark for the purposes of the Policy, see the [WIPO Overview 3.0](#), section 1.8.

For the above reasons, the Panel therefore finds that the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out circumstances, without limitation, by which a respondent might demonstrate that it has rights or a legitimate interest in a domain name. These are, summarized briefly: (i) if the respondent has been using the domain name in connection with a *bona fide* offering of goods and services; (ii) if the respondent has been commonly known by the domain name; or (iii) if the respondent has been making a legitimate non-commercial or fair use of the domain name.

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. [WIPO Overview 3.0](#), section 2.1.

The record of this case reflects that:

- before any notice to the Respondent of the dispute, the Respondent did not use, nor has it made demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services. Specifically, the use of the disputed domain name to resolve to a website purporting to be the online edition of the Complainant's newspaper and featuring links which take Internet visitors to pages of the Complainant's newspaper is intended to mislead Internet users into believing that it has reached the Complainant's website. See section 2.13.1 of [WIPO Overview 3.0](#), which explains that panels have categorically held that the use of a domain name for illegal activity, including impersonation/passing off, can never confer rights or legitimate interests on a respondent.
- there is nothing in the available case file that would suggest that the Respondent has been commonly known by the disputed domain name or that it has been making a legitimate noncommercial or fair use of the disputed domain name; see paragraphs 4(c)(ii) and 4(c)(iii) of the Policy and the [WIPO Overview 3.0](#), section 2.3;
- the record contains no other factors demonstrating rights or legitimate interests of the Respondent in the disputed domain name. The fact that the disputed domain name is a dictionary term, the English translation of which means "south west", is not, in the circumstances of this case, sufficient to give the Respondent rights or a legitimate interests in it because it is apparent from the use to which it has been put by the Respondent that it has specifically targeted the Complainant's SUD OUEST mark rather than having used this term in a descriptive manner; see section 2.10 of the [WIPO Overview 3.0](#);
- the current inactive status of the disputed domain name self-evidently does not amount to use in connection with a *bona fide* offering of goods and services.

For the above reasons, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise. The Panel accordingly finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The disputed domain name incorporates the Complainant's SUD OUEST mark in full together with a hyphen, which is of minimal significance, and the letters "fr", which will be perceived by Internet users as denoting the country code TLD for France. The only known use of the disputed domain name has been to resolve to a website, which replicated that of the Complainant's newspaper and contains links to it. These factors, in combination, indicate that the Respondent was aware of the Complainant as at the date of registration of the disputed domain name and that it was registered because of its propensity to mislead Internet users into believing that any website to which it resolved was likely to be that of the Complainant.

It is well-established under the Policy that registration of a domain name by an unconnected party with knowledge of a complainant's trade mark registration, in circumstances where the domain name is put to a misleading use, amounts to bad faith; See, for example, *VKR Holding A/S v. Li Pinglong*, WIPO Case No. [D2016-2269](#). Moreover, as explained at section 3.1.4 of the [WIPO Overview 3.0](#): "Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known

trademark by an unaffiliated entity can by itself create a presumption of bad faith.” The Panel accordingly finds that disputed domain name was registered in bad faith.

The only known use to which the disputed domain name has been put was to resolve to a website, the form of which has been described above. As explained above, Internet users aware of the Complainant’s Sud Ouest newspaper who visited the Respondent’s website whilst it was operative are apt to have assumed, from the confusing similarity between the disputed domain name and the Complainant’s mark and its form and content, that it was that of the Complainant. The Respondent has thereby gained the opportunity to seek to derive financial benefit from those Internet users who visit its website, most likely PPC income from the prominent advertisement for the charge card, which featured on at least the home page of the Respondent’s website.

For the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. The Respondent’s conduct falls within the circumstance of bad faith registration and use set out at paragraph 4(b)(iv) of the Policy namely it has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of its website. See also section 3.1.4 of the [WIPO Overview 3.0](#) which indicates that using a domain name to redirect to a complainant’s website is one of the indicia on which a finding of bad faith may be made in respect of the circumstance set out at paragraph 4(b)(iv) of the Policy.

So far as the current inactive use of the disputed domain name is concerned, prior UDRP panels have found that the non-use of a domain name (including a blank or “coming soon” page) 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 and (iv) the implausibility of any good faith use to which the domain name may be put by the respondent; See [WIPO Overview 3.0](#), section 3.3 and, by way of example, *Compagnie Générale des Etablissements Michelin v. zhouhaotian*, WIPO Case No. [D2015-1728](#). So far as the first of these factors is concerned, whilst the Complainant’s mark is the French language term for “south west” and is not therefore inherently distinctive, the Complainant has shown an established reputation in the mark SUD OUEST for French language newspapers. The remaining factors, in the circumstances of these proceedings, are also supportive of a finding of bad faith passive holding on the part of the Respondent and the Panel accordingly finds that the passive holding of the disputed domain name by the Respondent comprises bad faith use under the Policy.

For the above reasons, based on the available record, the Panel finds that the third element of the Policy has been established.

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, <sudouest-fr.com>, be transferred to the Complainant.

/Antony Gold/

Antony Gold

Sole Panelist

Date: August 15, 2023