

ADMINISTRATIVE PANEL DECISION

Société de Négoce et de Participation, Sonepar France Interservices v. bs transit, Company

Case No. D2023-3407

1. The Parties

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

Respondent is bs transit, Company, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <group-sonepar.com> is registered with Marcaria.com International, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 9, 2023. On August 10, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 11, 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 and contact information in the Complaint. The Center sent an email communication to Complainant on August 16, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on August 18, 2023, naming Respondent identified above in Section 1.

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 Respondent of the Complaint, and the proceedings commenced on August 29, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 18, 2023. Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 20, 2023.

The Center appointed Gregory N. Albright as the sole panelist in this matter on September 28, 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 Sonepar group was founded in 1969 and operates internationally in the field of B2B distribution of electrical products, solutions and related services.

Complainant Société de Négoce et de Participation (“Sonepar”) is the owner of the following trademark registrations:

- International trademark Registration No. 736078 for the SONEPAR mark, dated February 3, 2000, designating *inter alia* the United Kingdom (subsequent designation registered March 17, 2015), duly renewed and covering goods and services in classes 9, 11, 37 and 39; and
- International trademark Registration No. 1654996 for the mark SONEPAR + LOGO dated December 3, 2021, designating *inter alia* the European Union and the United Kingdom and covering goods and services in classes 7, 9, 11, 35, 37, 38, 39, 41 and 42.

The disputed domain name was registered on December 14, 2022.

5. Parties’ Contentions

A. Complainants

Complainant Sonepar, the owner of the SONEPAR trademark, is a holding company for the “Sonepar Group,” which includes Complainant Sonepar France Interservices and all other companies controlled directly or indirectly by Sonepar.

Headquartered in Paris, France, Sonepar is an independent, family-owned company with global market leadership in B-to-B distribution of electrical products, solutions and related services. Through a network of 100 brands spanning 40 countries, the Sonepar Group seeks to become the first global B-to-B electrical distributor to provide a fully digitalized and synchronized omnichannel experience to all customers.

The Sonepar Group was founded by Henri Coisne in 1969, through acquisition of le Comptoir d’Electricité Franco-Belge. The Sonepar Group has expanded through acquisition of other French regional distributors, and in North America.

In 2020, Sonepar had 45,000 associates and sales of around EUR23 billion.

Complainant Sonepar France Interservices, located in Boulogne Billancourt, has 401 employees and has generated over USD100 million in sales.

1. Identical or Confusingly Similar

Complainants and their SONEPAR trademark enjoy a worldwide reputation. Complainants own numerous SONEPAR trademark registrations around the world, including the two registrations described in Section 4 above.

The disputed domain name reproduces the entirety of the SONEPAR mark. The addition of the generic term “group,” separated by a hyphen, does not prevent likelihood of confusion, but instead may lead Internet users to believe the disputed domain name is in some way associated with Complainants, or will direct them to the official website promoting Complainants’ brand and products.

In addition, Complainants operate the following domain names, among others, reflecting their trademark in order to promote their services:

- <sonepar.com> registered on April 17, 1997;
- <sonepar.fr> registered on February 12, 1998;
- <sonepar-grp.com> registered on October 6, 2022.

The disputed domain name’s full inclusion of a confusingly similar approximation of the SONEPAR trademark in combination with the term “group” enhances the false impression that the disputed domain name is somehow officially related to Complainants. The extension “.com” is not considered when examining the identity or similarity between the mark and the disputed domain name.

2. Rights or Legitimate Interests

Respondent is not affiliated with Complainants, and Complainants have not authorized Respondent Complainants to use the SONEPAR trademark or register any domain name incorporating said trademark. Furthermore, Respondent cannot claim prior rights or legitimate interest in the domain name as Sonepar obtained rights in the SONEPAR trademark long before the disputed domain name was registered in December 2022.

There is no evidence Respondent is commonly known by the disputed domain name or the name “Sonepar.”

“Even where a domain name consists of a trademark plus an additional term (at the second- or top-level), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner.” WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 2.5.1. Here, the disputed domain name associates the “SONEPAR” trademark with the term “group.” This is clear evidence Respondent wishes to give an overall impression that the disputed domain name is somehow related to Complainants, their corporate group and their activities. This construction of the disputed domain name is likely to lead Internet users to believe they will land on an official website of Complainants or that communications from an e-mail address incorporating the disputed domain name are legitimate.

In this respect, the disputed domain name, which incorporates the SONEPAR trademark, resolves to a default web page of the web server and, most importantly, was used for fraud in a phishing scheme. Respondent used the disputed domain name to fraudulently contact other companies by impersonating Complainants (using an email address the incorporates the disputed domain name), offering a false partnership for the acquisition of various products in the name of Complainants, and asking customers to send their best offer as well as their B2B customer account opening conditions. The disputed domain name therefore is not used in any type of legitimate business or services, but instead is being used to deceive consumers by leading them to believe they are being contacted by Complainants.

3. Registered and Used in Bad Faith

Bad faith can be found where, as here, a respondent knew or should have known of Complainants’ trademark rights and, nevertheless registered a domain name in which it had no rights or legitimate interest. It is implausible that Respondent was unaware of Complainants when the disputed domain name was registered, for several reasons.

First, Sonepar is well known throughout the world.

Second, the composition of the disputed domain name, which identically reproduces the SONEPAR mark in its entirety with the mere addition of the generic term “group,” confirms Respondent was aware of Complainants and the SONEPAR mark and registered the disputed domain name based on the attractiveness of the mark.

Third, Sonepar holds trademark registrations that significantly predate the December 2022 registration date of the disputed domain name. Under Section 2 of the ICANN Policy, it is established that when someone registers a domain name, he represents and warrants to the registrar that, to his knowledge, the registration of the domain name will not infringe the rights of any third party. This means Respondent had a duty to verify that the registration of the disputed domain name would not infringe the rights of any third party before registering said domain name.

Finally, it appears the disputed domain name was registered through identity theft; the name of a French company’s CEO was used for the registration even though that company is in no way connected to the disputed domain name.

In sum, there is abundant evidence that Respondent registered the disputed domain name in bad faith.

Respondent is also using the disputed domain name in bad faith. Most important, Respondent is engaged in a phishing scheme using the disputed domain name as part of an email-address. In the phishing emails which incorporate the disputed domain name, Respondent has impersonated a purchase director at Sonepar Connect/ Groupe Sonepar. In addition, the phishing emails include Complainants’ official logo, and the postal address of Complainant Sonepar France Interservices.

By making infringing use of Sonepar’s trademarks, in a fraudulent phishing scheme, Respondent is make bad faith use of the disputed domain name.

B. Respondent

Respondent did not reply to Complainant’s contentions.

6. Discussion and Findings

Paragraph 4(a) of the Policy requires the Complainant to prove that: (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 has been registered and is being used in bad faith.

Paragraph 4(b) of the Policy elaborates some circumstances that shall be evidence of the registration and use of the disputed domain name in bad faith. Paragraph 4(c) sets out various circumstances which, if found by the Panel to be proved based on the evaluation of all the evidence presented, shall demonstrate that the Respondent has rights or legitimate interests in the disputed domain name.

A. Preliminary Matter: Two Complainants

Complainant Sonepar is a holding company, and the owner of the registered SONEPAR marks. Complainant Sonepar France Interservices is part of the Sonepar Group, and complains that Respondent is impersonating it as part of a phishing scheme using emails that include the SONEPAR mark and Logo, and contact information for one of the companies in the Sonepar Group. Complainants jointly request that the disputed domain name be transferred to Complainant Sonepar.

The Panel finds Complainants have a common grievance against Respondent; Respondent has engaged in common conduct that has affected Complainants in a similar fashion; and it is equitable and efficient to permit the consolidation of their complaints in this proceeding. [WIPO Overview 3.0](#), section 4.11.1.

B. Identical or Confusingly Similar

Under Paragraph 4(a) of the Policy, a complainant must prove that (1) the complainant has rights in a trademark or service mark; and (2) the disputed domain name is identical or confusingly similar to the complainant's mark. The first element is a question of standing. [WIPO Overview 3.0](#), section 1.7 ("It is well accepted that the first element functions primarily as a standing requirement.").

Here, Complainant Sonepar has standing because it holds trademark mark registrations for the SONEPAR marks, as discussed in Section 4, above. From the relationship between the two Complainants, as part of the Sonepar Group, the Panel infers that Complainant Sonepar has granted rights to Complainant Sonepar France Interservices to use the marks. [WIPO Overview 3.0](#), section 1.4.1 (trademark licensee is considered to have rights in a trademark under the UDRP for purposes of standing to file a complaint).

The Panel also finds that the disputed domain name is identical or confusingly similar to the SONEPAR marks. The disputed domain name incorporates "Sonepar" in its entirety. [WIPO Overview 3.0](#), section 1.7 ("While each case is judged on its merits, in cases where a domain name incorporates the entirety of a trademark, ... the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing."). Here, the addition of "group" to the SONEPAR mark in the disputed domain name does not avoid a finding of confusing similarity for purposes of the Policy.

The first element of paragraph 4(a) of the Policy is satisfied.

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

Complainants have made out a *prima facie* case that Respondent does not have rights or legitimate interests in respect of the disputed domain name by asserting that Complainants have not granted Respondent any right to use the disputed domain name. Furthermore, Complainants have submitted evidence that Respondent is using the disputed domain name to impersonate Complainants in connection with fraudulent phishing. See [WIPO Overview 3.0](#), 2.13.1 ("Panels have categorically held that the use of a domain name for illegal activity (e.g., phishing, impersonation / passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent.").

In addition, Respondent has not responded to the Complaint to assert any rights or legitimate interests in respect to the disputed domain name. There is no evidence that "Sonepar" is Respondent's personal name, or that Respondent is known by, or has acquired any trademark rights in "sonepar" or "group-sonepar."

The second element of paragraph 4(a) of the Policy is satisfied.

D. Registered and Used in Bad Faith

The Panel finds sufficient evidence that Respondent registered the disputed domain name in bad faith. It may be inferred that Respondent registered the disputed domain name with knowledge of Complainants and the SONEPAR marks because the marks are well known, and Sonepar obtained registrations of the SONEPAR marks before Respondent registered the disputed domain name on December 14, 2022.

In addition, Respondent's incorporation of the entirety of the SONEPAR mark in the disputed domain name is evidence that Respondent intended to create the false impression that the disputed domain name is associated with and/or authorized by Complainants.

Complainants have also shown Respondent has used the disputed domain name in fraudulent phishing, impersonating an employee of Complainants and using an unauthorized email address incorporating the disputed domain name to try to deceive potential customers. This is quintessential bad faith. See [WIPO Overview 3.0](#), section 3.1.4 ("given that the use of a domain name for per se illegitimate activity such as the sale of counterfeit goods or phishing can never confer rights or legitimate interests on a respondent, such behavior is manifestly considered evidence of bad faith").

The third element of paragraph 4(a) of the Policy is satisfied.

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 <group-sonepar.com> be transferred to Complainant Sonepar.

/Gregory N. Albright/

Gregory N. Albright

Sole Panelist

Date: October 12, 2023