

ADMINISTRATIVE PANEL DECISION

Société de Négoce et de Participation v. Hirschkuss
Case No. D2023-3708

1. The Parties

The Complainant is Société de Négoce et de Participation, France, represented by Dreyfus & associés, France.

The Respondent is Hirschkuss, Germany.

2. The Domain Name and Registrar

The disputed domain name <sonepar.bayern> (the “Domain Name”) is registered with PSI-USA, Inc. dba Domain Robot (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 4, 2023. On September 4, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On September 6, 2023, the Registrar transmitted by email to the Center its verification response, disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on September 6, 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 September 7, 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 September 8, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 28, 2023. The Respondent did not submit a timely response. Accordingly, the Center notified the Respondent’s default on October 5, 2023. On October 12, 2023, the Respondent sent an informal communication to the Center.

The Center appointed Gregor Vos as the sole panelist in this matter on October 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 French company active in the field of electrical products, solutions, and related services. The Complainant has been operating since 1969 and has a network of 100 brands spanning 40 countries and includes 45,000 associates.

The Complainant is the owner of *inter alia* the following trademark registrations (hereinafter together referred to as the "Trademarks"):

- French trademark registration No. 99806224 for SONEPAR, registered on August 3, 1999; and
- International trademark registration No. 736078 for SONEPAR, with designations of *inter alia* Germany and the United Kingdom, registered on February 3, 2000.

Further, it is undisputed that the Complainant is the holder of the following domain name:

- <sonepar.com> registered on April 17, 1997.

The Domain Name was registered on October 8, 2014. Currently and at the time that the Complainant filed the Complaint, the Domain Name resolves to an inactive webpage.

5. Parties' Contentions

A. Complainant

With the Complaint, the Complainant seeks that the Domain Name is transferred to the Complainant. The Complaint is based on the following factual and legal grounds: the Domain Name is identical or confusingly similar to the Trademarks of the Complainant, the Respondent has no rights or legitimate interests in the Domain Name and the Domain Name has been registered and is being used in bad faith.

Firstly, according to the Complainant, the Domain Name is identical or confusingly similar to its Trademarks that enjoy a reputation. The Domain Name fully incorporates the Complainant's Trademarks with the mere addition of the generic Top-Level Domain ("gTLD") ".bayern".

Secondly, according to the Complainant, the Respondent has no rights or legitimate interests in the Domain Name. The Complainant has not given its consent to the Respondent to use its Trademarks in domain names. The Respondent is not commonly known under the name "sonepar.bayern", and does not provide a *bona fide* offering of goods or services. On the contrary, the Respondent has offered the Domain Name for sale to the Complainant for valuable consideration in excess of the documented out-of-pocket costs.

Lastly, according to the Complainant, the Respondent has registered and uses the Domain Name in bad faith. The composition of the Domain Name, which identically reproduces the Complainant's well-known Trademarks in combination with the gTLD ".bayern" that refers to the well-known German state Bavaria, confirms that the Respondent was aware of the Complainant and its Trademarks when it registered the Domain Name. The Complainant further submits that the passive holding of the Domain Name does not preclude a finding of bad faith. Finally, the Respondent has attempted to sell the Domain Name for a sum of EUR 2,000 which is in excess of the Respondent's out of pocket expenses for registering the Domain Name.

B. Respondent

The Respondent did not reply to the Complainant's contentions. On October 12, 2023, the Respondent informed the Center that it did not understand the Center's messages. The Respondent states that it earlier communicated that it was willing to transfer the Domain Name.

6. Discussion and Findings

The Respondent's untimely communication does not dispute the Complainant's contentions. On the contrary, it confirms that the Respondent offered to transfer the Domain Name to the Complainant. Hence, under paragraphs 5(f), 14(a), and 15(a) of the Rules, the Panel is directed to decide this administrative proceeding on the basis of the Complainant's undisputed factual presentations.

For the Complainant to succeed, it must prove, within the meaning of paragraph 4(a) of the Policy and on the balance of the probabilities that:

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

Only if all three elements have been fulfilled, the Panel is able to grant the remedy requested by the Complainant. The Panel will deal with each of the requirements in turn.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the Domain Name is (i) identical or confusingly similar to a trademark or service mark, (ii) in which the Complainant has rights.

With respect to having rights pursuant to paragraph 4(a)(i) of the Policy, it is noted that the Complainant is registered as the owner of the Trademarks. Consequently, the Panel finds that the Complainant has proven that it has rights in the Trademarks.

With regard to the assessment of identity or confusing similarity of the Domain Name with the Trademarks, it is generally accepted that this test involves a reasoned but relatively straightforward comparison between the Complainant's Trademarks and the Domain Name (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). In cases where a Domain Name incorporates the entirety of a trademark, the Domain Name will normally be considered confusingly similar to that mark (see section 1.7 of the [WIPO Overview 3.0](#)).

In the present case, the Trademarks are incorporated in their entirety in the Domain Name. The addition of the gTLD ".bayern" does not prevent a finding of confusing similarity with the Trademarks (see section 1.11 of the [WIPO Overview 3.0](#)). Consequently, the Panel finds that the requirement under paragraph 4(a)(i) of the Policy has been satisfied.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the Domain Name. The onus of proving this requirement, like each element, falls on the Complainant. Given the difficulty in proving a negative, however, it is usually sufficient for a complainant to make out a *prima facie* case that a respondent lacks rights or legitimate interests. If a complainant does establish a *prima facie* case, the burden of production shifts to the respondent (see, e.g. [WIPO Overview 3.0](#), section 2.1; *Sanofi v. Cimpress Schweiz GmbH*, WIPO Case No. [D2017-0522](#)).

Paragraph 4(c) of the Policy lists three non-limitative examples of instances in which a respondent may establish rights or legitimate interests in the Domain Name.

The Complainant has substantiated that none of these circumstances apply in this case. In the Respondent's untimely communication, the Respondent has failed to address the *prima facie* case thus established by the Complainant. Furthermore, based on the record before it, the Panel does not find any of the circumstances of paragraph 4(c) of the Policy present.

Further, the fact that the Trademarks are identical to the Domain Name results in a high risk of implied affiliation, with the TLD ".bayern" increasing this risk, since this could be considered to refer to a region specific website of the Complainant ([WIPO Overview 3.0](#), section 2.5.1).

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name. Paragraph 4(a)(ii) of the Policy is thereby fulfilled.

C. Registered and Used in Bad Faith

Under paragraph 4(a)(iii) of the Policy, a complainant must show that the disputed domain name has been registered and is being used in bad faith. Paragraph 4(b) of the Policy lists four non-limitative circumstances which may be considered as evidence of registration and use in bad faith of a domain name.

In the present case, the Trademarks are registered by the Complainant and have been used for many years. The Complainant's rights to the Trademarks predate the registration date of the Domain Name. In light of the fact that the Trademarks at least enjoy a reputation in the field of business in which the Complainant is active, the Panel agrees with the Complainant that it is not conceivable that the Respondent chose the Domain Name without knowledge of the Complainant's activities and its Trademarks under which the Complainant is doing business (see *e.g. Solvay SA v. Domain Administrator*, WIPO Case No. [D2015-1867](#)). The reputation of the Trademarks of the Complainant has been confirmed by an earlier UDRP panel (see *e.g. Société de Négoce et de Participation and Sonepar France Interservices v. Privacy service provided by Withheld for Privacy ehf / David Mark*, WIPO Case No. [D2021-1506](#))

Further, it is generally accepted by UDRP panels that the non-use of a domain name does not prevent a finding of bad faith (section 3.3 of the [WIPO Overview 3.0](#)). In light of the reputation of the Trademarks, the lack of any rights or legitimate interest in the Domain Name by the Respondent, and in the absence of any conceivable good faith use of the inherently misleading Domain Name, the Panel finds from the present circumstances that the Respondent has intentionally sought to take unfair advantage of or otherwise abuse the Trademarks.

In addition, the Respondent has offered the Domain Name for sale to the Complainant for an amount likely in excess of its documented out-of-pocket costs. It is well established that such conduct can contribute to a finding of registration and use of the Domain Name in bad faith (see *e.g. Imara Trade Marks BVI Limited v. Direct Privacy ID 1078D, Domain Name Proxy Service, Inc.*, WIPO Case No. [D2012-2183](#)).

Accordingly, the Panel finds that the Domain Name has been registered and is being used in bad faith, and that the third element of paragraph 4(a)(iii) of the Policy is fulfilled.

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 Domain Name, <sonepar.bayern>, be transferred to the Complainant.

/Gregor Vos/

Gregor Vos

Sole Panelist

Date: October 27, 2023