

## **ADMINISTRATIVE PANEL DECISION**

Skandia Brands AB v. Yassin Boutwaline, Skandia-Stockholm  
Case No. D2024-3047

### **1. The Parties**

The Complainant is Skandia Brands AB, Sweden, represented by Abion AB, Sweden.

The Respondent is Yassin Boutwaline, Skandia-Stockholm, Belgium.

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

The disputed domain name <skandia-stockholm.com> (the “Disputed Domain Name”) is registered with Tucows Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 25, 2024. On July 26, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On June 29, 2024, 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 Protected, Contact Privacy Inc. Customer 0171345599) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 7, 2024, 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 amendment to the Complaint on August 8, 2024.

The Center verified that the Complaint together with the amendment to the 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 August 13, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 2, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 6, 2024.

The Center appointed Nick J. Gardner as the sole panelist in this matter on September 12, 2024. 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 limited company incorporated in Sweden. It is a financial services business<sup>1</sup> and was founded in 1855. Its headquarters are in Stockholm.

The Complainant is the owner of numerous trademark registrations for the term SKANDIA including for example European Union Trademark Registration for SKANDIA (word) No. 001075076, registered on February 17, 2000. These trademarks are referred to as the SKANDIA trademark in this decision.

The Complainant is also the owner of many domain names which comprise or contain the term “skandia” including <skandia.se> and <skandia.com>.

The Disputed Domain Name was registered on June 1, 2024. There is no evidence of the Disputed Domain Name having been used.

On July 3, 2024, the Complainant sent a cease-and-desist letter to the Registrar with a request that it be forwarded to the Respondent. No response was received.

#### **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. In particular, the Complainant contends as follows.

The Disputed Domain Name is confusingly similar to the SKANDIA Trademark as it simply adds the geographic designation Stockholm to that trademark.

The Respondent has no rights or legitimate interests in the term “skandia”.

In consequence the Complainant alleges that the Disputed Domain Name was registered and is being used in bad faith. It says the Respondent must have had the Complainant in mind when it registered the Disputed Domain Name and did so to take advantage of its name and reputation. It also says that as the MX records connected to the Disputed Domain Name are active, there is a high risk that the Disputed Domain Name is used for email-communication and phishing.

##### **B. Respondent**

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

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<sup>1</sup> The Panel thinks it likely that technically the Complainant is a company within a larger Skandia group and the Complainant holds the trademarks that the Skandia group uses. However, nothing turns on the distinction between the Complainant itself and the larger group so the Panel will adopt the approach used in the Complaint of assuming that there is no distinction between the Complainant and any larger group of associated companies.

## 6. Discussion and Findings

### Preliminary Matters

The Panel notes that no communication has been received from the Respondent. However, given the Complaint and Written Notice were sent to the relevant addresses disclosed by the Registrar, then the Panel considers that this satisfies the requirement in paragraph 2(a) of the Rules to “employ reasonably available means calculated to achieve actual notice”. Accordingly, the Panel considers it is able to proceed to determine this Complaint and to draw inferences from the Respondent’s failure to file any Response. While the Respondent’s failure to file a Response does not automatically result in a decision in favour of the Complainant, the Panel may draw appropriate inferences from the Respondent’s default (see, e.g., *Verner Panton Design v. Fontana di Luce Corp*, WIPO Case No. [D2012-1909](#)).

### Substantive Matters

To succeed, in accordance with paragraph 4(a) of the Policy, the Complainant must satisfy the Panel that:

- (i) the Disputed Domain Name is identical with 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;
- (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. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (“[WIPO Overview 3.0](#)”), section 1.7.

The Complainant has rights in the SKANDIA trademark. The Disputed Domain Name simply adds the word “stockholm” to the SKANDIA trademark. The Panel finds the Disputed Domain Name is confusingly similar to the SKANDIA trademark. Previous UDRP panels have consistently held that domain names are identical or confusingly similar to a trademark for purposes of the Policy “when the domain name includes the trademark, or a confusingly similar approximation, regardless of the other terms in the domain name” (*Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. [D2000-0662](#)). It is established that, where a mark is recognizable within the disputed domain name, the disputed domain name is considered to be confusingly similar to the mark ([WIPO Overview 3.0](#) at section 1.7).

It is also established that the addition of a geographic term (such as here “Stockholm”) to a disputed domain name would not prevent a finding of confusing similarity between the domain name and the mark ([WIPO Overview 3.0](#) at section 1.8).

It is also established that the Top-Level Domain (“TLD”), in this case “.com”, is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. See [WIPO Overview 3.0](#) at section 1.11.

Accordingly, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant’s trademark and hence the first condition of paragraph 4(a) of the Policy has been fulfilled.

#### B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. See [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, 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 finds the second element of the Policy has been established.

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

The Panel notes that, 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.

There is no evidence that the Respondent has made any use of the Disputed Domain Name in the time since he registered it. In the circumstances of this case the Panel adopts the approach set out in the [WIPO Overview 3.0](#) at 3.3 as follows:

“Can the ‘passive holding’ or non-use of a domain name support a finding of bad faith?”

From the inception of the UDRP, panelists 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 composition of the disputed domain name, (iii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iv) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement). and (v) the implausibility of any good faith use to which the domain name may be put.”

Overall, it does not generally matter that the Respondent has not as yet used the Disputed Domain Name. “Passive holding” can itself amount to bad faith registration and use where the holding involves a domain name deliberately chosen because of its association with the Complainant. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); *Jupiters Limited v. Aaron Hall*, WIPO Case No. [D2000-0574](#); *Ladbroke Group Plc v. Sonoma International LDC*, WIPO Case No. [D2002-0131](#); *Westdev Limited v. Private Data*, WIPO Case No. [D2007-1903](#); *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#); and *Intel Corporation v. The Pentium Group*, WIPO Case No. [D2009-0273](#).

In the present case the Panel adopts the above described approach and the principles set out in the above decisions. The Panel considers that the term SKANDIA is distinctive. The Panel agrees with the Complainant that the Respondent more likely than not had the Complainant in mind when he registered the Disputed Domain Name. It is clearly not coincidental that the Respondent has combined the SKANDIA trademark with the word “Stockholm” when Stockholm is where the Complainant is headquartered. The Panel cannot at present conceive of any legitimate use the Respondent could have for the Disputed

Domain Name. No Response has been provided so the Respondent has not shown any evidence of actual or contemplated good-faith use. The Respondent's identity was concealed by use of a privacy service. It follows that all of the above factors relevant to the application of the passive holding doctrine are applicable.

Applying the principles set out in [WIPO Overview 3.0](#) as described above and in the above noted UDRP decisions the Panel finds that the Disputed Domain Name has been registered and is being used in bad faith.

The Complainant also says that bad faith is established because the Disputed Domain Name may be used for phishing purposes given that there are configured MX records. The Panel appreciates that as a financial services provider phishing attacks directed at the Complainant's customers are likely, and the Panel can well see how the Disputed Domain Name could be used in this regard. There is however no evidence that such activity has actually occurred. Given the above analysis of bad faith based on the passive holding of the Disputed Domain Name the Panel does not need to reach a conclusion on this latter issue.

Accordingly, the third condition of paragraph 4(a) of the Policy has been fulfilled. The Panel finds that the Complainant has established the third element 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 <skandia-stockholm.com> be transferred to the Complainant.

*/Nick J. Gardner/*

**Nick J. Gardner**

Sole Panelist

Date: September 27, 2024