

ADMINISTRATIVE PANEL DECISION

Sonepar México, SA de CV v. Bejo Darmawan
Case No. D2024-3356

1. The Parties

The Complainant is Sonepar México, SA de CV, Mexico, represented by Bello, Gallardo, Bonequi & García, SC, Mexico.

The Respondent is Bejo Darmawan, Indonesia.

2. The Domain Name and Registrar

The disputed domain name <warren-pr.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 15, 2024. On August 16, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 16, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on August 22, 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 amended Complaint on August 27, 2024.

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 August 28, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 17, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 18, 2024.

The Center appointed Steven A. Maier as the sole panelist in this matter on September 26, 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 company registered in Mexico. It is a supplier of electrical products, solutions and related services.

In 2003, the Complainant acquired a company named Warren del Caribe in order to expand its operations in Puerto Rico.

The Complainant is the owner of various registrations for trademarks incorporating the term WARREN. Those registrations include, for example:

- Puerto Rico trademark registration number 230428 for a trademark comprising an “atom” logo and the wording “WARREN A Sonepar Company”, registered on December 16, 2021 in International Class 35; and
- United States of America trademark registration number 7370379 for a combined trademark comprising an “atom” logo and the wording “WARREN A Sonepar Company” registered on April 30, 2024 in International Class 35.

The disputed domain name was originally registered by the Complainant’s subsidiary, Warren del Carbide, on November 7, 2013.

The Complainant appears to have maintained the disputed domain name until a date in early November 2023, when it states that it inadvertently failed to renew the disputed domain name.

The Respondent registered the disputed domain name on November 7, 2023.

The disputed domain name has resolved to an Indonesian-language website, offering casino and other gaming services (such activities having no apparent connection with the mark WARREN).

5. Parties’ Contentions

A. Complainant

The Complainant submits that it has used the mark WARREN extensively in commerce, in several countries including in particular Puerto Rico, since 2003. It provides evidence of its use of the disputed domain name for a website promoting its products from 2013 onwards, submitting that it used the abbreviation “PR” within the disputed domain name to emphasize its business in Puerto Rico. The Complainant states that it invested substantially in the promotion of its business by way of the disputed domain name. It provides evidence of search engine results against the disputed domain name which refer to its business, and also exhibits evidence of numerous backlinks to the URL related to the disputed domain name (although the Panel notes that these are undated and many of them appear to relate to gambling websites).

The Complainant submits that the disputed domain name is confusingly similar to its trademarks. It states that the WARREN element of its trademarks is reproduced entirely, and that the hyphen and abbreviation “PR” in the disputed domain name do not prevent that element from being recognizable within the disputed domain name.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name. It states that the Respondent is not known by the disputed domain name, and that there is no evidence of any use, or demonstrable preparations to use, the disputed domain name for the purpose of any bona fide offering of goods or services. The Complainant contends that, instead, the Respondent has registered and used the disputed domain name solely for the purpose of taking unfair advantage of the Complainant's trademark, and the goodwill attaching to that trademark, by redirecting Internet users to a network of websites in which the Respondent has a financial interest.

The Complainant submits that the disputed domain name was registered and is being used in bad faith. The Complainant contends that the Respondent likely obtained the disputed domain name via a drop catch service, in which case the Respondent was, or ought to have been, aware that the disputed domain name had previously been used by a prior registrant. The Complainant states that the use to which the Respondent has put the disputed domain name bears no relation whatsoever to the disputed domain name itself, and that the Respondent's sole intention was to divert Internet traffic to its own websites by creating a likelihood of confusion with the Complainant's trademark.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

In order to succeed in the Complaint, the Complainant is required to show that all three of the elements set out under paragraph 4(a) of the Policy are present. Those elements are 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.

A. Identical or Confusingly Similar

The Complainant has established that it is the owner of registered trademark rights in a mark combining an "atom" logo with the words "WARREN A Sonepar Company". The Panel finds that the term WARREN is the dominant, and a distinctive, element of that trademark. The disputed domain name comprises the term "warren" together with a hyphen and the abbreviation "PR", neither of which additions prevent the Complainant's mark WARREN from being recognizable within the disputed domain name.

The Panel therefore finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

In the view of the Panel, the Complainant's submissions set out above give rise to a prima facie case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. However, the Respondent has failed to file a Response in this proceeding and has not submitted any explanation for its registration and use of the disputed domain name, or evidence of rights or legitimate interests on its part in the disputed domain name, whether in the circumstances contemplated by paragraph 4(c) of the Policy or otherwise.

A respondent may be able to establish rights or legitimate interests in respect of a domain name comprising a dictionary term, which the respondent uses for a purpose relating to that dictionary term and without targeting the relevant complainant's trademark. The Panel does not find this to be such a case: neither does the disputed domain name comprise a dictionary term, nor does the Respondent's use of the disputed domain name bear any apparent relationship to the disputed domain name itself. The Panel concludes moreover that the Respondent registered the disputed domain name in order to take unfair advantage of the Complainant's goodwill attaching to its trademark and to the disputed domain name itself.

The Panel therefore finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

C. Registered and Used in Bad Faith

The Panel finds the Complainant's trademark, and in particular the WARREN component thereof, to be distinctive in nature. The Panel also finds that both that trademark and the disputed domain name, which had been used by the Complainant itself for the preceding 10 years, had become associated in the minds of the public with the Complainant's commercial operations in Puerto Rico in particular. Since the Respondent has provided no explanation for its choice of the disputed domain name, and has not used it for any purpose apparently related to the disputed domain name, the Panel can only infer that the Respondent registered the disputed domain name with the intention of taking unfair commercial advantage of the goodwill attaching to the Complainant's trademark and to the disputed domain name itself. The Panel's conclusion in this regard is reinforced by the circumstances in which the disputed domain name appears to have been acquired by the Respondent, carrying a strong inference that the Respondent was, or should reasonably have been aware, that the disputed domain name had previously been used by a prior registrant.

The Panel concludes in the circumstances that, by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of its website or of a product or service on its website (paragraph 4(b)(iv) of the Policy).

The Panel therefore finds that the disputed domain name has been registered and is being used in bad faith.

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 <warren-pr.com> be transferred to the Complainant.

/Steven A. Maier/

Steven A. Maier

Sole Panelist

Date: October 9, 2024