

## **ADMINISTRATIVE PANEL DECISION**

### **LEGRAND FRANCE v. Joshua Delga**

#### **Case No. D2024-4206**

#### **1. The Parties**

The Complainant is Legrand France, France, represented by EBRAND France.

The Respondent is Joshua Delga, United States of America (“United States”).

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

The disputed domain name <legrandpromofr.com> is registered with Dynadot Inc. (the “Registrar”).

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 11, 2024. On October 14, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 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 (REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 17, 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 October 17, 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 October 18, 2024. In accordance with the Rules, paragraph 5, the due date for Response was November 7, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 8, 2024.

The Center appointed Gökhan Gökçe as the sole panelist in this matter on November 13, 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 an international group founded in 1904 and specialized in electrical and digital building infrastructures.

The Complainant is the owner of several trademark registrations for LEGRAND including the following:

- International trademark registration No. 510016 for LEGRAND (word mark), registered on August 11, 1986, in classes 6, 8, 9, 11, 17 and 20;
- United States trademark registration No. 1192446 for LEGRAND/ , registered on March 23, 1982, in class 9;
- European Union trademark registration No. 004130861 for LEGRAND/ , registered on January 4, 2006, in classes 6, 8, 9, 11, 16, 17, 19, 20, 35, 37, 38, 41 and 42; and
- French trademark registration No. 1359109 for LEGRAND/ , registered on February 21, 1986, in classes 6, 8, 9, 11, 17 and 20.

The Complainant is also the owner of the domain names <legrand.com>, registered on December 22, 1995, which resolves to its global website used to redirect to national websites, and <legrand.fr>, registered on June 26, 1996, which resolves to its website for the French market.

The disputed domain name was registered on May 14, 2024. The disputed domain name resolves to a website in French which allegedly offers LEGRAND products by using the Complainant's brands, logos and photos.

#### **5. Parties' Contentions**

##### **A. Complainant**

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

Notably, the Complainant contends that the disputed domain name is confusingly similar to its registered trademarks because it adopts the trademarks in their entirety and merely adds the words "promo" and "fr", which are normally insufficient to avoid a finding of confusing similarity and in fact may serve to increase the likelihood of confusion by suggesting that the disputed domain name could refer, for example, to the idea of a significant discount on products and to the Complainant's historical country, France.

Then, the Complainant states that the Respondent has no rights or legitimate interests in respect of the disputed domain name. According to the Complainant, the Respondent is not commonly known under the disputed domain name and has not registered any trademarks with it. Furthermore, the Complainant highlights that its LEGRAND trademarks all predate the registration of the disputed domain name. Therefore, the Respondent could not have been unaware of the existence of the Complainant. Additionally, the Complainant argues that the Respondent's website mirrors the look and feel of the Complainant's website and replicates the Complainant's logo identically.

The Complainant, finally, says that the disputed domain name was registered and has been used in bad faith. The Complainant argues that the Respondent's website replicates the Complainant's official website by reproducing the Complainant's trademark, copyrighted images and selling potentially counterfeit products under the Complainant's trademark. The Respondent is therefore misleading Internet users to its website by creating confusion with the Complainant's trademark.

## B. Respondent

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

## 6. Discussion and Findings

According to paragraph 15(a) of the Rules, the Panel shall decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In accordance with paragraph 4(a) of the Policy, the Complainant must prove that each of the three following elements is satisfied:

- (i) the disputed domain name is identical or confusingly similar to a trademark 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(a) of the Policy states that the Complainant bears the burden of proving that all these requirements are fulfilled, even if the Respondent has not replied to the Complainant's contentions. *Stanworth Development Limited v. E Net Marketing Ltd.*, WIPO Case No. [D2007-1228](#).

However, concerning the uncontested information provided by the Complainant, the Panel may, where relevant, accept the reasonable factual allegations provided in the Complaint as true. See, section 2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

It is further noted that the Panel has taken note of the [WIPO Overview 3.0](#) and, where appropriate, will decide consistent with the [WIPO Overview 3.0](#).

### 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 3.0](#), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the LEGRAND trademark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

It is also well accepted that a generic Top-Level Domain, in this case ".com", is typically ignored when assessing the similarity between a trademark and a domain name. [WIPO Overview 3.0](#), section 1.11.

Although the addition of other terms, in this case "promo" and "fr", may bear on assessment of the second and third elements, the Panel finds the addition of such terms do not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

## **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. [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.

In this regard, the Panel particularly believes that the Respondent cannot be assessed as a legitimate distributor of the Complainant’s products in light of *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) (“Oki Data”) and thus is not entitled to use the disputed domain name accordingly. The criteria as set forth in *Oki Data* are apparently not fulfilled in the present case. The website which was linked to the disputed domain name does not accurately and prominently disclose the relationship, or rather the lack thereof, between the Respondent and the Complainant, thus creating the false impression that the Respondent might be an official and/or authorized reseller/distributor of the Complainant’s products in France. In the view of the Panel, all this takes the Respondent out of the *Oki Data* safe harbor for purposes of the second element.

Moreover, given the composition of the disputed domain name, wholly incorporating the Complainant’s trademark with the addition of the terms “promo” and “fr” and the absence of any relationship between the Respondent and the Complainant, the disputed domain name carries a risk of implied affiliation with the Complainant, and can constitute neither a bona fide use nor a legitimate noncommercial or fair use of the disputed domain name. [WIPO Overview 3.0](#), section 2.5.1.

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.

In the present case, the Panel notes that the Respondent’s use of the disputed domain name to purportedly offer the Complainant’s products at discounted prices using the Complainant’s images creates a false association with the Complainant and constitutes bad faith pursuant to the Policy. It is highly unlikely for the Respondent to not have known about the Complainant prior to registering the disputed domain name. In fact, a search for “legrand” or “legrand promo fr” on an Internet search engine will automatically show results for “legrand” which almost exclusively pertain to the Complainant.

Additionally, the Panel notes that the Respondent must have had the Complainant and its LEGRAND trademark in mind when registering the disputed domain name. It is obvious to the Panel that the Respondent has deliberately chosen the disputed domain name to target and mislead Internet users

searching for the Complainant and its products. Furthermore, the Complainant's LEGRAND trademark is well known. It is therefore beyond the realm of coincidence that the Respondent chose the disputed domain name containing the Complainant's trademark entirely without the intention of creating a false association with the Complainant.

In addition, the Panel accepts the failure of the Respondent to submit a response to the Complainant's contentions as an additional indication for bad faith.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

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 <legrandpromofr.com> be transferred to the Complainant.

*/Gökhan Gökçe/*

**Gökhan Gökçe**

Sole Panelist

Date: November 25, 2024