

## **ADMINISTRATIVE PANEL DECISION**

Arkema France v. Privacy service provided by Withheld for Privacy ehf / Dom Link

Case No. DME2022-0009

### **1. The Parties**

The Complainant is Arkema France, France, represented by In Concreto, France.

The Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / Dom Link, Bosnia and Herzegovina.

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

The disputed domain name <arkema.me> is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 12, 2022. On May 12, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 12, 2022, 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 May 13, 2022 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 May 17, 2022.

The Center verified that the Complaint together with 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 May 23, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 12, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 13, 2022.

The Center appointed Johan Sjöbeck as the sole panelist in this matter on June 17, 2022. 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 has submitted evidence that it is the owner of a large number of trademark registrations for ARKEMA in numerous countries, including the following:

International trademark ARKEMA with registration number 847865, filed on November 30, 2004, in classes 1, 2, 3, 4, 5, 16, 17, 37, 38, 39, 40, 41, 42 and 45 designating 55 countries including Montenegro.

EUTM trademark ARKEMA with registration number 004181731 filed on December 8, 2004, in classes 1, 2, 3, 4, 5, 7, 9, 11, 12, 16, 17, 19, 20, 22, 25, 27, 35, 36, 37, 38, 40, 41 and 42.

French trademark ARKEMA with registration number 3048573 filed on August 28, 2000, in classes 1, 2, 3, 4, 5, 6, 7, 8, 9, 11, 12, 16, 17, 18, 19, 20, 21, 22, 24, 25, 27, 28, 31, 35, 36, 37, 38, 40, 41, 42, 43, 44 and 45.

International trademark ARKEMA with registration number 1156827 filed on March 1, 2013, in classes 1, 17 and 42 for Australia, Israel, Japan, South Korea, New Zealand, Oman, Singapore, Turkey, China, Morocco, Monaco, Russia and Ukraine.

International trademark ARKEMA with registration number 1157468 filed on March 7, 2013, in classes 1, 17 and 42 for Australia, Israel, Japan, South Korea, New Zealand, Oman, Singapore, Turkey, China, Morocco, Monaco, Russia and Ukraine.

EUTM trademark ARKEMA with registration number 018593819 filed on November 5, 2021, in classes 1, 16, 17, 19 and 42.

EUTM trademark ARKEMA with registration number 018593816 filed on November 5, 2021, in classes 1, 16, 17, 19 and 42.

French trademark ARKEMA with registration number 4814690 filed on November 5, 2021, in classes 1, 16, 17, 19 and 42.

French trademark ARKEMA with registration number 4814594 filed on November 5, 2021, in classes 1, 16, 17, 19 and 42.

The disputed domain name <arkema.me> was registered by the Respondent on June 23, 2021. The Complainant has provided evidence that the disputed domain name has been used by the Respondent to distribute malware to third parties via email.

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

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

The Complainant was incorporated on February 24, 1981, at the Nanterre Trade and Company Register in France under the number 319 632 790. As of 2021, the Complainant was present in more than 55 countries throughout the world with 141 production plants, over 20,200 employees and approximately EUR 9.5 billion in sales. The Complainant is a world leader of science materials offering a wide range of products for various fields such as paints, adhesives, coats, glue, fiber, resins, rough materials and finished materials for both general industry and consumer goods. The Complainant is not only producing, reselling, and distributing such materials but is also a leader in the research and development of such elements.

In addition, through substantial financial, material, and human investments, the Complainant has developed a large clientele relating to the ARKEMA trademark and has acquired, over the years, a good reputation and a certain fame in the chemistry field.

The disputed domain name reproduces the Complainant's ARKEMA trademark in its entirety. Many decisions have recognized that the incorporation of a trademark in its entirety is sufficient to establish that the domain name is identical or similar to the registered mark.

Moreover, panels usually disregard the domain name suffix (or Top-Level Domain "TLD") in evaluating confusing similarity. Therefore, this element is not likely to avoid the risk of confusion that may exist between the signs in question. In contrast, as the Complainant is the single owner of a prior trademark in Montenegro, the public could therefore legitimately believe that the disputed domain name is part of the Complainant's portfolio. Thus, the disputed domain name is identical to the trademarks in which the complainant has rights.

According to the Complainant's research, the Respondent has no rights to the disputed domain name nor legitimate interests. The Complainant has not authorized, licensed, nor permitted the Respondent to use any of its trademarks or to apply for or use any domain name incorporating its trademark.

The Respondent used the disputed domain name as a tool for sending malware to third parties via email. Section 2.13.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") states that "Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent". The Complainant therefore rightly believes and considers that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Complainant sent take down notices to the Respondent's hosting provider and Registrar on April 29, 2022, and consequently the website to which the disputed domain name resolved is now inactive and the DNS setup no longer includes MX servers.

The Complainant's trademark ARKEMA is not a descriptive term, a commonly used expression, nor a word that would be instantly understood in the field of industry. The denomination ARKEMA has therefore a highly distinctive character. It has already been recognized in a previous decision (*Arkema France v. Zheng Chu He*, WIPO Case No. [D2016-2227](#)). It is therefore very unlikely that the Respondent chose the disputed domain name <arkema.me> without any knowledge of the company name, domain names or trademarks of the Complainant.

The Respondent used the disputed domain name to create an email address and sent emails to third parties containing malware. One of the Complainant's clients received emails from <[...]@arkema.me>, labelled 'Invoice for March dated 07.04.2022' and including an attached document labeled 'Invoice 18274764.xlsx' containing malware. The attached documents of those emails have been identified as containing malware by two well-known security companies.

As a consequence, the registration of the disputed domain name <arkema.me> and the creation of the email address <[...]@arkema.me> are highly detrimental to the Complainant, as the Respondent of this deceptive and misleading domain name is using the company name and trademarks of the Complainant, in a bad faith manner and is targeting companies by sending them malware. It can therefore deeply impact the image of the Complainant if the victims are confused regarding the source of these emails. It is also particularly prejudicing the users of the Internet as they can easily be deceived when receiving an invoice through a domain name reproducing the trademark of a product and service provider, *i.e.*, a professional. They can indeed be less suspicious, thinking the emails originate from a legitimate source, and as a consequence, open the documents containing the malware.

Section 3.4 of the [WIPO Overview 3.0](#) states that “Panels have held that the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include sending email, phishing, identity theft, or malware distribution”. Even though it is not clear that the Respondent created malware for commercial gain or that it is a competitor of the Complainant, it is obvious that the motive was malicious. All the aforementioned elements constitute proof and evidence that the disputed domain name has been registered and is used in bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

According to paragraph 4(a) of the Policy, the Complainant must prove each of the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in 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 is, according to the submitted evidence, the owner of a large number of registered ARKEMA trademarks. The disputed domain name <arkema.me> incorporates the ARKEMA trademark in its entirety. It is standard practice to disregard the TLD under the confusingly similar test, see section 1.11, [WIPO Overview 3.0](#).

Having the above in mind, the Panel finds that the disputed domain name is identical to the Complainant’s trademark and that the Complainant has proved the requirements under paragraph 4(a)(i) of the Policy.

### **B. Rights or Legitimate Interests**

The Complainant must show that the Respondent has no rights or legitimate interests with respect to the disputed domain name. The Respondent may establish rights or legitimate interests in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- (i) the Respondent uses or has made preparations to use the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services prior to the dispute; or
- (ii) the Respondent is commonly known by the disputed domain name, even if the Respondent has not acquired any trademark rights; or
- (iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark.

The Complainant’s trademark registrations for ARKEMA predate the Respondent’s registration of the disputed domain name by nearly 18 years. The Complainant has not licensed, approved or in any way consented to the Respondent’s registration and use of the trademark in the disputed domain name.

There is no evidence in the case file indicating that the Respondent has used or made any preparations to

use the disputed domain name in connection with a *bona fide* offering of goods or services prior to the dispute. On the contrary, the Complainant has submitted evidence demonstrating that the Respondent is using the disputed domain name to send emails to third parties containing malware. Such use does not constitute a legitimate fair use and does not establish rights or legitimate interests in the disputed domain name.

Although given the opportunity, the Respondent has not rebutted the Complainant's *prima facie* case. It has not submitted any evidence indicating that the Respondent is the owner of any trademark or that the Respondent is commonly known by the disputed domain name. Furthermore, there is no evidence indicating that the Respondent intends to make a legitimate, noncommercial or fair use of the disputed domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark.

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

Under paragraph 4(b) of the Policy, evidence of bad faith registration and use include without limitation:

- (i) circumstances indicating the disputed domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the owner of a trademark or to a competitor of the trademark owner, for valuable consideration in excess of the documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) circumstances indicating that the disputed domain name was registered in order to prevent the owner of a trademark from reflecting the mark in a corresponding disputed domain name, provided there is a pattern of such conduct; or
- (iii) circumstances indicating that the disputed domain name was registered primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the disputed domain name has intentionally been used in an attempted to attract, for commercial gain, Internet users to the Respondent's website or other online location, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on that website or location.

As mentioned above, the Complainant's trademark registrations for ARKEMA predate the registration of the disputed domain name by nearly 18 years. In this regard, the Panel notes that the Complainant's ARKEMA trademark is registered in Montenegro, the country of the ccTLD of the disputed domain name. Given the Complainant's widespread use of the ARKEMA trademark on an international level, the Respondent had or should have had knowledge of the reputation and goodwill of the Complainant's trademark when registering the disputed domain name. In the absence of any evidence to the contrary, the Panel agrees with the Complainant that the disputed domain name was registered by the Respondent with the Complainant's trademark in mind.

In addition, the Complainant has submitted evidence demonstrating that the Respondent has been using the disputed domain name to send emails containing malware to third parties, including a client of the Complainant. From the evidence in the file, it is clear that, after being contacted by the Complainant, the registrar and hosting provider suspended the hosting and DNS services after confirming that the Respondent's use of the disputed domain name was abusive. As mentioned by the Complainant, section 3.4 of the [WIPO Overview 3.0](#) states that using a domain name for purposes such as sending emails, phishing, identity theft or malware distribution may constitute bad faith.

The Respondent's use of the disputed domain name described above may be damaging to the goodwill and reputation associated with the Complainant's trademark if Internet users falsely believe that the emails containing malware are sent by, associated with or in some way endorsed by the Complainant. The fact that the disputed domain name currently does not resolve to an active website does not prevent a finding of bad faith from the Respondent.

There is no evidence in the case file that refutes the Complainant's submissions.

The Panel concludes that the Complainant has proved the requirements under paragraph 4(b) of the Policy and that the disputed domain name has been registered and 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 <arkema.me> shall be transferred to the Complainant.

*/John Sjöbeck/*

**Johan Sjöbeck**

Sole Panelist

Date: June 29, 2022