

## **ADMINISTRATIVE PANEL DECISION**

### **CMA CGM SA v. Lamber Scot and leopold mactir Case No. D2022-0126**

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

The Complainant is CMA CGM SA, France, internally represented.

The Respondents are Lamber Scot and leopold mactir, South Africa.

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

The disputed domain names <cmacgmlogisticservice.com> and <cma-cgm services.com> are registered with NameCheap, Inc. (the "Registrar").

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

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on January 14, 2022, concerning the disputed domain name <cma-cgm services.com>. On January 14, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name <cma-cgm services.com>. On January 14, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name <cma-cgm services.com> which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on January 17, 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 a first amended Complaint on January 21, 2022, adding to the proceedings the disputed domain name <cmacgmlogisticservice.com>. On January 21, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name <cmacgmlogisticservice.com>. On January 21, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name <cmacgmlogisticservice.com> that differed from the named Respondent and contact information in the Complaint.

The Center thereafter sent an email communication to the Complainant on January 24, 2022 providing the additional registrant and contact information disclosed by the Registrar, and requesting the Complainant to amend the Complaint adding the Registrar-disclosed registrants as formal Respondents and provide relevant arguments or evidence demonstrating that all named Respondents are, in fact, the same entity and/or that all

domain names are under common control; and/or file a separate complaint for any domain name(s) for which it is not possible to demonstrate that all named Respondents are in fact the same entity and/or that all domain names are under common control and indicate (by short amendment or reply email) which domain name(s) will no longer be included in the current Complaint.

The Complainant filed a second amended Complaint on January 27, 2022. On February 2, 2022, the Center noted that there appears to be at least *prima facie* grounds sufficient to warrant accepting the Complaint for the Panel's final determination of the consolidation request on appointment.

The Center verified that the Complaint together with the amended Complaints 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 February 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 22, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 23, 2022.

The Center appointed William R. Towns as the sole panelist in this matter on March 2, 2022. The Panel finds 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 operates a container shipping and transport group headquartered in Marseille, France. The Complainant is an established leader in logistics, with over 755 agencies in 160 countries and more than 100,000 employees. The Complainant's shipping and transport group serves over 400 of the world's ports, and has traded under the name CMA CGM for many years.

The Complainant is the holder of International trademark registrations for its CMA mark and CMA CGM mark, including the following:

- CMA International Trademark Reg. No. 502706, applied for and registered April 30, 1986;
- CMA CGM International Trademark Reg. No. 1191384, applied for and registered October 2, 2013; and
- CMA CGM (fig.) International Trademark Reg. No. 1391139, applied for and registered November 16, 2017.

The Complainant also holds the French Trademark CSIS, Reg. No. 4795210, registered August 27, 2021.

The Respondent registered the disputed domain name <cma-cgmservices.com> on December 29, 2021, and registered the disputed domain name <cmacgmlogisticservice.com> on January 15, 2022. The Complainant subsequently discovered the Respondent to be using the disputed domain name <cma-cgmservices.com> to attract customers to a website impersonating the Complainant in a fraudulent scamming and phishing scheme.

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

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

The Complainant submits that the disputed domain names are identical or confusingly similar to the Complainant's CMA and CMA CGM marks, which the Complainant asserts have existed since 1996 and are

widely known. The Complainant explains that it has registered numerous domain names reflecting the Complainant's wholly owned subsidiary CMA CGM Inland Services, which according to the Complainant is well known. The Complainant observes that the term "services" is purely descriptive in relation to the Complainant's transportation services.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Complainant represents that the Respondent has not been authorized or otherwise permitted to register or to use domain names reflecting the Complainant's CMA and CMA CGM marks, and is not making a legitimate noncommercial or other fair use of the disputed domain names.

The Complainant maintains that the Respondent registered and is using the disputed domain names in bad faith. The Complainant reiterates that the Respondent was aware of and had the Complainant's well-known CMA and CMA CGM marks in mind when registering the disputed domain names. The Complainant is insistent that the Respondent registered the disputed domain names in order to direct them to a malicious website, impersonating the Complainant and seeking to obtain personal and confidential information from unsuspecting consumers in a fraudulent phishing scheme.

## **B. Respondent**

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

## **6. Preliminary Issue: Consolidation of Multiple Domain Names and Respondents**

The Complainant has requested that the disputed domain names registered by the named registrants and identified in the amended Complaint be consolidated in a single administrative proceeding. Consolidation of multiple registrants as respondents in a single administrative proceeding is appropriate under the Policy and Rules where the domain names or the websites to which they resolve are subject to common control, and consolidation would be procedurally efficient and fair and equitable to all parties. *Speedo Holdings B.V. v. Programmer, Miss Kathy Beckerson, John Smitt, Matthew Simmons*, WIPO Case No. [D2010-0281](#). See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 4.11.2, and cases cited therein.

Paragraph 10(e) of the Rules states that a "[p]anel shall decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules". Paragraph 10(c) of the Rules provides, in relevant part, that "the [p]anel shall ensure that the administrative proceeding takes place with due expedition."

The facts in the instant record strongly suggest that the disputed domain names have been subject to common control. The disputed domain names were registered on Dec. 29, 2021 and Jan. 15, 2022, respectively, using the same Registrar. The Respondent when registering the disputed domain names submitted identical (and likely fictitious) contact and registration information, and by all accounts has directed the disputed domain names to identical websites. The record is convincing that the Complainant has been the target of common conduct by the Respondent directly affecting the Complainant's rights – namely, the Respondent's attempt to falsely suggest an affiliation or connection with the Complainant and the Complainant's CMA and CMA CGM marks.

The Panel, taking into account the Respondent's use of the disputed domain names in a manner directly affecting the Complainant's rights, and further finding that common questions of law and fact are predominant, concludes that consolidation would be procedurally efficient, and fair and equitable to all Parties. Accordingly, the Panel will proceed to a decision on the merits of these domain name disputes.

## 7. Discussion and Findings

### A. Scope of the Policy

The Policy is addressed to resolving disputes concerning allegations of abusive domain name registration and use. *Milwaukee Electric Tool Corporation v. Bay Verte Machinery, Inc. d/b/a The Power Tool Store*, WIPO Case No. [D2002-0774](#). Accordingly, the jurisdiction of this Panel is limited to providing a remedy in cases of “the abusive registration of domain names”, also known as “cybersquatting”. *Weber-Stephen Products Co. v. Armitage Hardware*, WIPO Case No. [D2000-0187](#). See Final Report of the First WIPO Internet Domain Name Process, April 30, 1999, paragraphs 169-177. The term “cybersquatting” is most frequently used to describe the deliberate, bad faith abusive registration of a domain name in violation of rights in trademarks or service marks. *Id.* at paragraph 170. Paragraph 15(a) of the Rules provides that the panel shall decide a complaint on the basis of statements and documents submitted and in accordance with the Policy, the Rules and any other rules or principles of law that the panel deems applicable.

Paragraph 4(a) of the Policy requires that the complainant prove each of the following three elements to obtain a decision that a domain name should be either cancelled or transferred:

- (i) the 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 with respect to the domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

Cancellation or transfer of the domain name is the sole remedy provided to the complainant under the Policy, as set forth in paragraph 4(i).

Paragraph 4(b) of the Policy sets forth four situations under which the registration and use of a domain name is deemed to be in bad faith, but does not limit a finding of bad faith to only these situations.

Paragraph 4(c) of the Policy in turn identifies three means through which a respondent may establish rights or legitimate interests in a domain name. Although the complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, UDRP panels have recognized that this could result in the often impossible task of proving a negative, requiring information that is primarily, if not exclusively, within the knowledge of the respondent. Thus, the view is that the burden of production shifts to the respondent to come forward with evidence of a right or legitimate interest in the domain name, once the complainant has made a *prima facie* showing. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 2.1. See, e.g., *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#).

### C. Identical or Confusingly Similar

The Panel finds the disputed domain names <cmacgmlogisticservice.com> and <cma-cgmservices.com> are confusingly similar to the Complainant’s CMA and CMA CGM marks, in which the Complainant has established rights through registration and extensive use. In considering identity and confusing similarity, the first element of the Policy serves essentially as a standing requirement.<sup>1</sup> The threshold inquiry under the first element of the Policy involves a relatively straightforward comparison between the complainant’s trademark and the disputed domain name.

In this instance, the Complainant’s CMA and CMA CGM marks are recognizable in each of the disputed domain names.<sup>2</sup> The Complainant’s CMA and CMA CGM marks are clearly recognizable in the disputed

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<sup>1</sup> See WIPO Overview 3.0, section 1.7.

<sup>2</sup> See WIPO Overview 3.0, section 1.8 and cases cited therein.

domain names. The inclusion of a hyphen (-) in the disputed domain name <cma-cgm services.com> does not dispel the confusing similarity of the disputed domain name to the Complainant's CMA and CGM marks. See, e.g. *Instagram, LLC v. Temp name Temp Last Name, Temp Organization*, WIPO Case No. [D2019-0109](#). See also *Instagram, LLC v. A S*, WIPO Case No. [D2020-1327](#). When the relevant trademark is recognizable in the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not preclude a finding of confusing similarity under paragraph 4(a)(i) of the Policy.<sup>3</sup> Top-Level Domains ("TLD"), in this instance ".com", generally are disregarded when evaluating the identity or confusing similarity of the Complainant's mark to the disputed domain names under paragraph 4(a)(i) of the Policy, irrespective of any ordinary meaning that might be ascribed to the TLD.<sup>4</sup>

Accordingly, the Panel finds the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

#### **D. Rights or Legitimate Interests**

As noted above, once the complainant makes a *prima facie* showing under paragraph 4(a)(ii) of the Policy, paragraph 4(c) shifts the burden of production to the respondent to come forward with evidence of rights or legitimate interests in a domain name. The Panel is persuaded from the record of this case that a *prima facie* showing under paragraph 4(a)(ii) of the Policy has been made. It is undisputed that the Respondent has not been authorized to use the Complainant's CMA and CMA CGM marks. The Respondent nonetheless has registered multiple domain names misappropriating the Complainant's well-known CMA and CMA CGM marks, which have been used by the Respondent in an attempt to impersonate the Complainant in furtherance of a fraudulent scamming and phishing scheme.

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights or legitimate interests in a domain name by demonstrating any of the following:

- (i) before any notice to it of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondent has not submitted a formal response to the Complaint, in the absence of which the Panel may accept all reasonable inferences and allegations in the Complaint as true. See *Talk City, Inc. v. Michael Robertson*, WIPO Case No. [D2000-0009](#). The Panel has carefully reviewed the record in this case, and finds nothing therein that would bring the Respondent's registration and use of the disputed domain names within any of the "safe harbors" of paragraph 4(c) of the Policy.

The disputed domain names were used to direct to Internet pages where the Complainant's trademark was displayed. The Panel concludes from the record that the Respondent was aware of and had the Complainant's distinctive CMA and CMA CGM marks firmly in mind when registering the disputed domain names. There is no indication that the Respondent has been known by any of the disputed domain names, nor any evidence that the Respondent is making a legitimate noncommercial or fair use of the disputed domain names. Moreover, the Respondent has brought forward no credible evidence of use or demonstrable preparations to use the disputed domain names in connection with any *bona fide* offering of goods or services.

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<sup>3</sup> *Id.*

<sup>4</sup> See WIPO Overview 3.0, section 1.11.

In view of the foregoing, the Panel concludes that the Respondent has neither used nor demonstrated preparations to use the disputed domain names in connection with a *bona fide* offering of goods or services, and is not making a legitimate noncommercial or fair use of the disputed domain names. Moreover, there is no indication that the Respondent has been commonly known at any time by the disputed domain names within the meaning of paragraph 4(c)(ii) of the Policy.

Accordingly, the Panel finds the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

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

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration and use of a domain name in bad faith:

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

The examples of bad faith registration and use set forth in paragraph 4(b) of the Policy are not meant to be exhaustive of all circumstances from which such bad faith may be found. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). The overriding objective of the Policy is to curb the abusive registration of domain names in circumstances where the registrant seeks to profit from and exploit the trademark of another. See *Match.com, LP v. Bill Zag and NWLAWS.ORG*, WIPO Case No. [D2004-0230](#).

For the reasons discussed under this and the preceding heading, the Panel concludes that the Respondent's conduct in this case constitutes bad faith registration and use of the disputed domain names within the meaning of paragraph 4(a)(iii) of the Policy. The Panel finds that the Respondent clearly was aware of the Complainant and had the Complainant's well-known marks in mind when registering the disputed domain names. It is clear beyond cavil that the Respondent registered the disputed domain names seeking to exploit or profit from the Complainant's trademark rights.

What now appears to be the Respondent's passive holding of the disputed domain names does not preclude a finding of bad faith in the attendant circumstances of this case. As set forth in *Telstra Corporation Limited v. Nuclear Marshmallows*, *supra*, "the relevant issue is not whether the Respondent is taking a positive action in bad faith in relation to the domain name, but instead whether, in all the circumstances of the case, it can be said that the Respondent is acting in bad faith. [...] [I]t is possible, in certain circumstances, for inactivity by the Respondent to amount to the domain name being used in bad faith". See also *Red Bull GmbH v. Kevin Franke*, WIPO Case No. [D2012-1531](#). The Panel finds such circumstances to be present in this case.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(iii) 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 names <cmacgmlogisticservice.com> and <cma-cgmservices.com> be transferred to the Complainant.

*/William R. Towns/*

**William R. Towns**

Sole Panelist

Date: March 16, 2022