

ADMINISTRATIVE PANEL DECISION

Premier Farnell Ltd v. Elena Esteve

Case No. D2022-2482

1. The Parties

The Complainant is Premier Farnell Ltd, United Kingdom, represented by Walker Morris LLP, United Kingdom.

The Respondent is Elena Esteve, Spain.

2. The Domain Name and Registrar

The disputed domain name <proelec.cat> is registered with Dinahosting S.L. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on July 7, 2022. On the following day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 12, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name that differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on July 12, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. On the same day, the Center also transmitted an email communication to the Parties in English and Spanish regarding the language of the proceeding. The Complainant filed an amended Complaint in English on July 14, 2022 in which it confirmed its request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 in English and Spanish, and the proceedings commenced on July 15, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 4, 2022. Delivery of the written notice was not accepted at the Respondent’s contact street address. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 9, 2022.

The Center appointed Matthew Kennedy as the sole panelist in this matter on August 22, 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 is a distributor of products for electronics systems design, maintenance and repair. It was formed by a company merger in 1996 and now distributes to Europe, North America, and Asia-Pacific. It owns the following trademark registrations for PRO ELEC:

- United Kingdom trademark registration number 00003396416, filed on May 2, 2019 and registered on November 8, 2019, specifying goods in classes 6, 7, 9, 11, 16, and 20, including electrical apparatus and equipment;
- United Kingdom trademark registration number 00918131132, filed on October 1, 2019 and registered on June 3, 2020, specifying goods in classes 6, 7, 9, 11, 16, and 20; and
- European Union trademark registration number 018131132, filed on October 1, 2019 and registered on January 17, 2022, specifying goods in classes 6, 7, 9, 11, 16, and 20.

The above trademark registrations remain current.

The Respondent is an individual resident in Algemésí, Valencian Community, Spain.

The disputed domain name was created on November 30, 2021. It formerly resolved to a website in Catalan and English for Proelec SL, described as a Valencian group supplying services in the energy sector, including electrical installation services. The Complainant sent letters of demand dated January 17, 2022 to a third party that it believed to be known to the Respondent, and to the Registrar. At the time of this Decision, the disputed domain name resolves to a landing page hosted by the Registrar.

5. Parties' Contentions

A. Complainant

The disputed domain name is identical or highly similar to the Complainant's PRO ELEC mark.

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

The disputed domain name was registered and is being used in bad faith. The Respondent appears to have been holding itself out as a provider of electrical installation services to attract commercial gain in bad faith. The disputed domain name could not be used without infringing the trademark rights of the Complainant.

B. Respondent

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

6. Discussion and Findings

6.1 Language of the Proceeding

Paragraph 11(a) of the Rules provides that "unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the

Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding”. The Registrar confirmed that the Registration Agreement for the disputed domain name is in Spanish.

The Complainant requests that the language of the proceeding be English. Its main arguments are that the Respondent suspended active use of the disputed domain name following receipt of the letter of demand in English, which demonstrates that the Respondent understands English, and that the Complainant and its authorized representatives are based in England.

Paragraph 10(b) and (c) of the Rules require the Panel to ensure that the Parties are treated with equality, that each Party is given a fair opportunity to present its case and that the administrative proceeding take place with due expedition. Prior UDRP panels have decided that the choice of language of the proceeding should not create an undue burden for the parties. See, for example, *Solvay S.A. v. Hyun-Jun Shin*, WIPO Case No. [D2006-0593](#); *Whirlpool Corporation, Whirlpool Properties, Inc. v. Hui'erpu (HK) electrical appliance co. Ltd.*, WIPO Case No. [D2008-0293](#).

The Panel observes that the Complaint and amended Complaint in this proceeding were filed in English. The website formerly associated with the disputed domain name has an English version, from which it is reasonable to infer that the Respondent understands that language. Moreover, despite the Center having sent an email regarding the language of the proceeding, and the Written Notice, in both Spanish and English, the Respondent did not comment on the language of the proceeding, did not accept delivery of the Written Notice, and did not express any interest in otherwise participating in this proceeding. Therefore, the Panel considers that requiring the Complainant to translate the Complaint into Spanish would create an undue burden and delay whereas accepting the Complaint in English does not cause prejudice to either Party.

Having considered all the circumstances above, the Panel determines under paragraph 11(a) of the Rules that the language of this proceeding is English. The Panel would have accepted a Response in Spanish, but none was filed.

6.2 Analysis and Findings

Paragraph 4(a) of the Policy provides that the Complainant must prove each of the following elements:

- (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 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

Based on the evidence presented, the Panel finds that the Complainant has rights in the PRO ELEC mark.

The disputed domain name incorporates the PRO ELEC mark, omitting the space for technical reasons. Its only additional element is the Top-Level Domain (“TLD”) extension “.cat” (intended by the registry to be used to indicate Catalan language and culture) but, as a standard requirement of domain name registration, the Panel will disregard this element in the comparison with the PRO ELEC mark.

Therefore, the Panel finds that the disputed domain name is identical to a trademark in which the Complainant has rights. The Complainant has satisfied the first element in paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out the following circumstances which, without limitation, if found by the panel, shall demonstrate that the respondent has rights to, or legitimate interests in, a disputed domain name, for the purposes of paragraph 4(a)(ii) of the Policy:

- (i) before any notice to [the respondent] of the dispute, [the respondent's] use of, or demonstrable 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; or
- (ii) [the respondent] (as an individual, business, or other organization) [has] been commonly known by the [disputed] domain name, even if [the respondent has] acquired no trademark or service mark 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 or service mark at issue.

As regards the first circumstance set out above, the disputed domain name formerly resolved to a website offering electrical installation services. This use appeared to be for commercial gain. Although the disputed domain name incorporates the Complainant's PRO ELEC mark with no additional element besides a TLD extension, it is clear from the Complaint that the Respondent is actually unrelated to the Complainant. The disputed domain name now resolves to a landing page hosted by the Registrar. These facts are sufficient to make a *prima facie* case that the Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services.

As regards the second circumstance set out above, the Respondent is identified in the Registrar's Whois database as "Elena Esteve", not the disputed domain name. Although the website presented a company named "Proelec SL", there is no evidence that the Respondent actually traded under such name.

As regards the third circumstance set out above, the Complainant alleges that the website associated with the disputed domain name indicated that it was created by students of an educational institution for a company of electrical installations in Algemesis. On its face, this does not indicate that the disputed domain name was being used for a purely educational purpose but rather for a commercial purpose. Accordingly, nothing in the evidence indicates that the Respondent is making a legitimate noncommercial or fair use of the disputed domain name.

In summary, the Panel considers that the Complainant has made a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent failed to rebut that *prima facie* case because she did not respond to the Complaint.

Therefore, based on the record of this proceeding, the Panel finds that the Complainant has satisfied the second element in paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that certain circumstances, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. The fourth circumstance is as follows:

- (iv) by using the [disputed] domain name, [the respondent has] intentionally 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 mark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] website or location or of a product or service on [the respondent's] website or location.

As regards registration, the disputed domain name was registered in 2021, after the registration of the Complainant's PRO ELEC mark in the United Kingdom. The disputed domain name incorporates the PRO ELEC mark, omitting only the space, and adding only a TLD extension, which is a technical requirement of domain name registration. The Complainant has promoted its PRO ELEC mark online. The Respondent's former website offered services in the energy sector that are related to the electrical apparatus and equipment and other goods that the Complainant offers under its PRO ELEC mark, which increases the likelihood that the Respondent was aware of the Complainant and its mark. Although there exists the possibility that the disputed domain name was independently devised from a combination of truncated versions of the descriptive words "professional" and "electrical" or "elèctrica" in English or Catalan, the Respondent has not offered any such explanation and delivery of the written notice of the Complaint was not accepted at her contact street address. Accordingly, based on the record of this proceeding, the Panel finds it more likely than not that the Respondent was aware of the Complainant when she registered the disputed domain name.

As regards use, the disputed domain name formerly resolved to a website offering electrical installation services. This use appeared to be for the commercial gain of an electrical installation company in Algemesí. In the circumstances, the Panel considers that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to her website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of his website within the terms of paragraph 4(b)(iv) of the Policy. The change in use of the disputed domain name, which now resolves to a landing page, does not alter that conclusion.

Therefore, the Panel finds that the disputed domain name has been registered and is being used in bad faith. The Complainant has satisfied the third element in paragraph 4(a) 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 <proelec.cat> be transferred to the Complainant.

/Matthew Kennedy/

Matthew Kennedy

Sole Panelist

Date: September 5, 2022