

## **ADMINISTRATIVE PANEL DECISION**

FB Solution v. Brenda Mark

Case No. D2022-4075

### **1. The Parties**

The Complainant is FB Solution, France, represented by Scan Avocats AARPI, France.

The Respondent is Brenda Mark, United States of America.

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

The disputed domain names <fbsolution-cn.com> and <fbsolution-hk.com> (the “Disputed Domain Names”) are registered with NameSilo, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 31, 2022. On October 31, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On November 1, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on November 2, 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 November 3, 2022.

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 November 7, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 27, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 28, 2022.

The Center appointed Nick J. Gardner as the sole panelist in this matter on December 1, 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 French company. It was founded in 2004 and its business is the baking and delivery of breads, pastries, and cakes delivered 24 hours a day, 365 days a year to professionals such as the airline and railway catering industry, hotels, and restaurants. It does so under the trademark FB SOLUTION. The Complainant has more than 120 employees and its turnover is more than 16 million euros. The Complainant carries out business in various countries including China – it commenced business in Hong Kong in 2008.

The Complainant owns various trademarks for the term FB SOLUTION or which include the term FB SOLUTION - see for example European Union word trademark FB SOLUTION No. 004310678 registered on February 21, 2006. These trademarks are referred to as the “FB SOLUTION trademark” in this decision.

Each of the Disputed Domain Names was registered on September 22, 2022. They each resolve to a single index page which does not appear to have any substantive content.

#### **5. Parties’ Contentions**

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

The Complainant’s contentions can be summarized as follows.

Each Disputed Domain Name is confusingly similar to the FB SOLUTION Trademark – each simply adds a country code identifier to the trademark.

The Respondent has no rights or legitimate interests in the term “fb solution”.

In consequence, the Complainant alleges that the Disputed Domain Names were registered and are being used in bad faith. The Complainant refers to previous UDRP decisions dealing with the passive holdings of domain names which are confusingly similar to a well-known trademark.

##### **B. Respondent**

No Response has been filed.

#### **6. Discussion and Findings**

##### **Preliminary Matters**

The Panel notes that no communication has been received from the Respondent. However, given the Complaint and Written Notice were sent to the relevant addresses disclosed by the Registrar, then the Panel considers that this satisfies the requirement in paragraph 2(a) of the UDRP Rules to “employ reasonably available means calculated to achieve actual notice”. Accordingly, the Panel considers it is able to proceed to determine this Complaint and to draw inferences from the Respondent’s failure to file any Response. While the Respondent’s failure to file a Response does not automatically result in a decision in favour of the Complainant, the Panel may draw appropriate inferences from the Respondent’s default (see, e.g., *Verner Panton Design v. Fontana di Luce Corp*, WIPO Case No. [D2012-1909](#)).

## Substantive Matters

To succeed, in accordance with paragraph 4(a) of the Policy, the Complainant must satisfy the Panel that:

- (i) the Disputed Domain Name is identical with 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;
- (iii) the Disputed Domain Name has been registered and is being used in bad faith.

### A. Identical or Confusingly Similar

The Complainant has rights in the FB SOLUTION trademark. The Panel finds each Disputed Domain Name is confusingly similar to this trademark. Each Disputed Domain Name simply omits the space between “FB” and “Solution” and adds a standard geographic identifier. Previous UDRP panels have consistently held that domain names are identical or confusingly similar to a trademark for purposes of the Policy “when the domain name includes the trademark, or a confusingly similar approximation, regardless of the other terms in the domain name” (*Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. [D2000-0662](#)). It is established that, where a mark is the distinctive part of a disputed domain name, the disputed domain name is considered to be confusingly similar to the registered mark (*DHL Operations B.V. v. DHL Packers*, WIPO Case No. [D2008-1694](#)).

The Panel also agrees with the approach set out in WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) at section 1.8 as follows.

“1.8 Is a domain name consisting of a trademark and a descriptive or geographical term confusingly similar to a complainant’s trademark?”

Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements.”

It is also well established that the generic Top-Level Domain (“gTLD”), in this case “.com”, does not affect the Disputed Domain Name for the purpose of determining whether it is identical or confusingly similar. See, for example, *Rollerblade, Inc. v. Chris McCrady*, WIPO Case No. [D2000-0429](#).

Accordingly the Panel finds that the Disputed Domain Names are each confusingly similar to the Complainant’s trademark and hence the first condition of paragraph 4(a) of the Policy has been fulfilled.

### B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances any of which is sufficient to demonstrate that a respondent has rights or legitimate interests in a domain name:

- (i) before any notice to the respondent of the dispute, use of, or demonstrable preparations to use, the domain name or a name corresponding to the 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 the respondent 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.

None of these apply in the present circumstances. The Complainant has not authorised, licensed, or permitted the Respondent to register or use the Disputed Domain Name or to use the FB SOLUTION trademark. The Complainant has prior rights in the FB SOLUTION trademark which precede the Respondent's acquisition of the Disputed Domain Names. The Complainant has therefore established a *prima facie* case that the Respondent does not have any rights or legitimate interests in the Disputed Domain Names and thereby the burden of production shifts to the Respondent to produce evidence demonstrating rights or legitimate interests in respect of the Disputed Domain Names (see, for example, *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#); *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

The Panel finds that the Respondent has failed to produce any evidence to establish her rights or legitimate interests in the Disputed Domain Names. Accordingly, the Panel finds the Respondent has no rights or any legitimate interests in the Disputed Domain Names and the second condition of paragraph 4(a) of the Policy has been fulfilled.

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

On the evidence that the Respondent has made no substantive use of the Disputed Domain Names in the time she has owned them. In the circumstances of this case, the Panel adopts the approach set out in the [WIPO Overview 3.0](#) at section 3.3 as follows:

“Can the ‘passive holding’ or non-use of a domain name support a finding of bad faith?”

From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or ‘coming soon’ page) would not prevent a finding of bad faith under the doctrine of passive holding.

While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put”.

In the present case the Panel adopts this approach and notes in particular the Respondent's failure to provide any evidence of actual or contemplated good-faith use.

Overall, it does not generally matter that the Respondent has not as yet used the Disputed Domain Name. “Passive holding” can itself amount to bad faith registration and use where the holding involves a domain name deliberately chosen because of its association with the Complainant. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); *Jupiters Limited v. Aaron Hall*, WIPO Case No. [D2000-0574](#); *Ladbroke Group Plc v. Sonoma International LDC*, WIPO Case No. [D2002-0131](#); *Westdev Limited v. Private Data*, WIPO Case No. [D2007-1903](#); *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#); *Intel Corporation v. The Pentium Group*, WIPO Case No. [D2009-0273](#); *Advance Magazine Publishers Inc. and Les Publications Conde Nast S.A. v. ChinaVogue.com*, WIPO Case No. [D2005-0615](#).

Further, the Panel notes the Respondent has not provided any credible explanation for any case of good faith she may have and the Panel infers none exists. Moreover, it would seem the Respondent may have furnished false or incomplete contact details when registering the disputed domain name, seeing as the courier was unable to deliver the Center's written communication to the Respondent's contact details as disclosed by the Registrar.

Accordingly, and applying the principles in the above noted UDRP decisions the Panel finds that the Disputed Domain Names have each been registered and are being used in bad faith. Accordingly, the third condition of paragraph 4(a) of the Policy has been fulfilled.

## 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 <fbsolution-cn.com> and <fbsolution-hk.com> be transferred to the Complainant.

*/Nick J. Gardner/*

**Nick J. Gardner**

Sole Panelist

Date: December 15, 2022