

## **ADMINISTRATIVE PANEL DECISION**

### **SPIE Operations v. jean michel desmoutier**

### **Case No. D2023-4197**

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

The Complainant is SPIE Operations, France, represented by Ebrand France, France.

The Respondent is jean michel desmoutier, United Kingdom.

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

The disputed domain name <spie-operations.com> (the “Domain Name”) is registered with One.com A/S (the “Registrar”).

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

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 10, 2023. On October 10, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On October 11, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the 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 16, 2023 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 Complainant filed an amendment to the Complaint.

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 20, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 9, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 13, 2023.

The Center appointed Olga Zalomiy as the sole panelist in this matter on November 27, 2023. 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, SPIE Operations, is a French independent provider of multi-technical services in the energy and Communications sectors. SPIE, an acronym for “Société Parisienne pour l’Industrie des Chemins de Fer et des Tramways” was created in 1900 and changed its name to SPIE OPERATIONS on September 17, 2014.

The Complainant owns several trademark registrations for its SPIE trademark, such as:

- The United Kingdom registration No.° UK00901471929, for the SPIE (word and design) mark, registered on July 10, 2001;
- The United Kingdom registration No.° UK00905239348, for the SPIE (word and design) mark, registered on July 18, 2007;

The International registration No.° 535025 for the trademark “SPIE” (stylized word), registered on February 17, 1989.

The Complainant also registered multiple domain names that include its trademark, such as: <spie.com>, registered on February 16, 2002; and <spie.eu>, registered on July 1st, 2006.

The Respondent registered the Domain Name on March 21, 2023. The Domain Name does not direct to an active website. The Respondent used the Domain Name as an email address “[...]@spie-operations.com” to contact a third party posing for the Complainant’s purchasing manager. The email contained the Complainant’s trademark and its company name, which is identical to the second-level domain of the Domain Name, minus the dash symbol.

#### **5. Parties’ Contentions**

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

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Name.

Notably, the Complainant contends that the Domain Name is similar to the Complainant’s trademarks and domain names because it reproduced the Complainant’s trademark SPIE with the addition of the word “operations”. Such addition contributes to the confusing similarity between the Complainant’s mark and the Domain Name because the Domain Name is identical to the Complainant’s company name. The Complainant argues that the Respondent has no rights or legitimate interests in the Domain Name because the Respondent is not commonly known under the name “Spie”, “Spie Operations” or the Domain Name and has not acquired a trademark or service mark under that name. Before any notice to the Respondent of the dispute, there is no evidence of the Respondent’s use of the Domain Name in connection with *bona fide* offering of goods or services because the Domain Name was used as a part of a phishing attack on the Complainant’s suppliers. The Complainant alleges that the Domain Name has been registered and used in bad faith by the Respondent because by using the Domain Name, the Registrant has intentionally attempted to attract, for commercial purposes, Internet users to their website, by creating a likelihood of confusion with the complainant’s trademark. In the phishing attack, the Respondent used the Domain Name to impersonate the Complainant.

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

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

## 6. Discussion and Findings

Pursuant to paragraph 4(a) of the UDRP, to succeed in this proceeding, the Complainant must prove each of the following elements with respect to the Domain Name:

- (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 in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

### 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 Domain Name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 1.7.

Based on the available record, the Panel finds 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 Panel finds the mark is recognizable within the Domain Name. Accordingly, the Domain Name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. The inclusion of the generic Top-Level Domain ("gTLD") ".com" is typically disregarded in the context of the confusing similarity assessment, being a technical requirement of registration. [WIPO Overview 3.0](#), section 1.11.

Although the addition of other terms here, "operations" and the dash symbol, may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the Domain Name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, 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 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 Domain Name such as those enumerated in the Policy or otherwise.

The evidence on record shows that the Respondent is not commonly known by the Domain Name. Nor is the Respondent making a legitimate noncommercial or fair use of the Domain Name, because it attempted to use the Domain Name for fraudulent activity. [WIPO Overview 3.0](#), section 2.13.

Panels have held that the use of a domain name for illegal activity here, claimed impersonation of the Complainant, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Based on the available record, 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 registered the Domain Name that includes both the Complainant's trademark and its company name over 30 years after the Complainant registered its trademark and 9 years after the Complainant changed its company name. The Respondent also used the Domain Name for an email to pose as a Complainant's employee. Therefore, it is likely that the Respondent registered the Domain Name in bad faith.

Panels have held that the use of a domain name for illegal activity. Here, claimed use of the Domain Name for phishing emails sent to the Complainant's suppliers constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy. The fact that the Domain Name does not direct to an active website, does not alter this finding.

Based on the available record, 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, <spie-operations.com>, be transferred to the Complainant.

*/Olga Zalomiy/*

**Olga Zalomiy**

Sole Panelist

Date: December 11, 2023