



# WIPO Arbitration and Mediation Center

## ADMINISTRATIVE PANEL DECISION

### Société Nationale des Chemins de Fer Français SNCF v. DomainProfi GmbH

#### Case No. D2014-0781

##### 1. The Parties

Complainant is Société Nationale des Chemins de Fer Français SNCF of St. Denis, France, represented by Cabinet Santarelli, France.

Respondent is DomainProfi GmbH of Osnabrück, Niedersachsen, Germany, self-represented.

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

The disputed domain name <snncf.com> is registered with PSI-USA, Inc. dba Domain Robot (the "Registrar").

##### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on May 12, 2014. On May 12, 2014, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 13, 2014, the Registrar transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing the contact details.

The Center verified that 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(a) and 4(a), the Center formally notified Respondent of the Complaint, and the proceedings commenced on May 19, 2014. In accordance with the Rules, paragraph 5(a), the due date for Response was June 8, 2014. The Response was filed on May 22, 2014.

On May 27, 2014, the Center received by email Supplemental Filings on behalf of Complainant.

The Center appointed Frederick M. Abbott as the sole panelist in this matter on May 27, 2014. 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.

The Panel has reviewed the Supplemental Filings of Complainant transmitted to the Center on May 27, 2014. The Panel does not consider it necessary to consider these Supplemental Filings to reach its decision.

#### 4. Factual Background

Complainant has registered the word and device/design trademark and service mark (hereinafter "trademark") SNCF on register of the French trademark office (INPI), registration number 3344303, registration dated March 2, 2005, in international classes (ICs) 12, 16, 18, 25, 28, 39, 41 and 43; and registration number 3594312, registration dated August 14, 2008, in ICs 9, 16, 18, 24, 35, 36, 38 and 39. Complainant has registered the word and device/design trademark SNCF as an International Mark under the Madrid System, registration number 878372, registration dated August 23, 2005, in ICs 12, 16, 18, 24, 25, 28, 35, 39, 41 and 43, designating the European Union, Switzerland and Morocco, and; registration number 1001673, registration dated September 10, 2008, in ICs 9, 16, 18, 24, 35, 36, 38, 39 and 42, designating the European Union and Switzerland.

Complainant is the operator of the French national railway system. It employs more than 250,000 individuals worldwide, and in 2009 had a turnover of EUR 17.8 billion. Complainant operates a commercial website principally at "[www.voyages-sncf.com](http://www.voyages-sncf.com)". Complainant indicates that its commercial website "ranks first position e-business websites in Europe". Complainant has registered numerous domain names incorporating SNCF standing alone or in combination, and asserts that it registered [sncf.com](http://sncf.com) in October 1996. Complainant registered the domain name [sncf.de](http://sncf.de) in 2011 and has redirected that domain name to its [voyages-sncf.com](http://voyages-sncf.com) address.

According to the Registrar's verification, Respondent is registrant of the disputed domain name. According to that verification, Respondent registered (or acquired registration of) the disputed domain name on January 29, 2014.

As of March 18, 2014, the disputed domain name hosted a webpage that appeared to be a linking parking page, including links to Complainant, but primarily using Chinese characters. A header on that webpage stated "Click here to buy Snncf.com for your website name!". As of April 7, 2014, the disputed domain name hosts a website offering about 20 pages of links to footwear, fashion accessories and clothing items, in the German language. This website offers the disputed domain name for sale (mainly) in German, "[Kaufen Sie die Domain Snncf.com für Ihre Website!](#)".

Complainant transmitted cease-and-desist and transfer demands via email to Respondent on March 5 and March 18, 2014. Respondent did not respond to these demands. Respond asserts that it was not aware of these demands as a consequence of its email filtering, until it received the Complaint and was able to locate them.

The Registration Agreement between Respondent and the Registrar subjects Respondent to dispute settlement under the Policy. The Policy requires that domain name registrants submit to a mandatory administrative proceeding conducted by an approved dispute resolution service provider, one of which is the Center, regarding allegations of abusive domain name registration and use (Policy, paragraph 4(a)).

#### 5. Parties' Contentions

##### A. *Complainant*

Complainant alleges that it has rights in the trademark SNCF in France and the European Union, among other jurisdictions, based on registration and use in commerce. Complainant contends that its SNCF trademark is well-known in Europe and globally.

Complainant contends that the disputed domain name is confusingly similar to its SNCF trademark, adding only a second "N". Complainant argues that Respondent has engaged in prototypical "typosquatting".

Complainant argues that Respondent lacks rights or legitimate interests in the disputed domain name because: (1) Complainant's trademark is distinctive and well-known, and Respondent must have been aware of its trademark when it registered the disputed domain name; (2) Respondent did not respond to Complainant's cease-and-desist demands and did not provide a justification for its registration of the disputed domain name; (3) Complainant has not licensed or otherwise authorized Respondent to make use of its SNCF trademark in the disputed domain name or otherwise, and; (4) Respondent has done nothing to establish rights or legitimate interests in the disputed domain name.

Complainant contends that Respondent registered and is using the disputed domain name in bad faith because: (1) the disputed domain name was initially directed to a parking page making use of the trademark of Complainant, such that Respondent evidenced awareness of Complainant's trademark; (2) subsequent to receipt of Complainant's cease-and-desist demands, the disputed domain name is now redirected to a German language website providing links to third-party fashion websites; (3) Respondent is engaging in typosquatting deliberately to redirect Internet users to its webpages; (4) Respondent must have been aware of Complainant's well-known trademark when it registered the disputed domain name – including because of Complainant's <snkf.de> domain name redirecting to a German language version of Complainant's main webpage – and sought to take advantage of Internet user confusion; (5) Respondent presumably secures financial gain from click-throughs on sponsored links on its website, and; (6) Respondent has offered the disputed domain name for sale in excess of its out-of-pocket expenses in connection with registration.

Complainant requests the Panel to direct the Registrar to transfer the disputed domain name to Complainant.

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

Respondent contends that because it is in Germany it was unaware of Complainant's SNCF trademark when it registered the disputed domain name. Respondent argues that because Complainant offers its online services through "www.voyages-snkf.com", the disputed domain name would not be confusing to international customers looking for rail journeys. Respondent refers to a UDRP case involving generic terms. Respondent contends that Complainant did not register <snkf.com> even though it registered many other domain names because it did not think the disputed domain name would be confusingly similar to its trademark.

Respondent alleges that it has rights in the disputed domain name because it registered several combinations of letters as it considered a new project, one of which would be named after its CEO, Mr. Steinkamp. However, Respondent ultimately rejected "Steinkamp Nationales Netzwerk für Computer Freaks" as the name for a project and tried to sell the disputed domain name before deleting it.

Respondent does not compete with the business of Complainant, and used the disputed domain name to host German advertising partners to get some benefit.

Respondent states that it did not receive the cease-and-desist and transfer demands from Complainant in March because they were filtered to its junk directory. Respondent asserts it receives thousands of emails each day. It located the emails from Complainant after it received the Complaint. Respondent asserts that Complainant had enough information to contact it in some other way, and that Respondent would have preferred a mutual agreement to resolve this matter.

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

The Policy is addressed to resolving disputes concerning allegations of abusive domain name registration and use. The Panel will confine itself to making determinations necessary to resolve this administrative proceeding.

It is essential to Policy proceedings that fundamental due process requirements be met. Such requirements include that a respondent have notice of proceedings that may substantially affect its rights. The Policy and the Rules establish procedures intended to ensure that respondents are given adequate notice of proceedings commenced against them and a reasonable opportunity to respond (see, e.g., Rules, paragraph 2(a)).

The Center formally notified the Complaint to Respondent at the email and physical addresses provided in its record of registration and in the Complaint. Respondent filed a Response. The Panel is satisfied that Respondent was afforded a reasonable opportunity to respond to the Complaint in this proceeding.

Paragraph 4(a) of the Policy sets forth three elements that must be established by a complainant to merit a finding that a respondent has engaged in abusive domain name registration and use and to obtain relief. These elements are that:

- (i) the domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights; and
- (ii) 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.

Each of the aforesaid three elements must be proved by a complainant to warrant relief.

#### ***A. Identical or Confusingly Similar***

Complainant has provided evidence of registration of the word and device/design trademark SNCF in France and the European Union, among other jurisdictions (see Factual Background, *supra*). The word portion of the trademark is its predominant feature. Respondent has not challenged Complainant's rights in its SNCF trademark. The Panel determines that Complainant has rights in the trademark SNCF.

The disputed domain name incorporates Complainant's trademark, adding the letter "n" to form <snncf.com>. Complainant's trademark is distinctive. It is a combination of letters without an apparent meaning in the English, French or German languages. The disputed domain name is visually quite similar to Complainant's trademark. An Internet user viewing the disputed domain name is likely to confuse it with Complainant's trademark because of the distinctive character of Complainant's mark and the visual similarity of the disputed domain name. The Panel determines that the disputed domain name is confusingly similar to Complainant's trademark within the meaning of the Policy.<sup>1</sup>

The Panel determines that Complainant has rights in the SNCF trademark and that the disputed domain name is confusingly similar to that trademark.

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

The second element of a claim of abusive domain name registration and use is that Respondent has no rights or legitimate interests in respect of the disputed domain names (Policy, paragraph 4(a)(ii)). The Policy enumerates several ways in which a respondent may demonstrate rights or legitimate interests:

"Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

- (i) before any notice to you of the dispute, your 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) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are 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." (Policy, paragraph 4(c))

Complainant's allegations to support Respondent's lack of rights or legitimate interests in the disputed domain name are outlined above in Section 5A, and the Panel finds that Complainant has made a *prima facie* showing that Respondent lacks rights or legitimate interests in the disputed domain name.

Respondent seeks to establish rights or legitimate interests in the disputed domain name by arguing that it undertook registration of the letter combination "snncf" as abbreviation for "Steinkamp Nationales Netzwerk für Computer Freaks", with "Steinkamp" reflecting the surname of its CEO. Respondent indicates that it subsequently abandoned this particular potential project. Beyond mere assertion, Respondent has presented no concrete evidence of its purported project. Mere assertion, particularly taking into account the inherently implausible character of Respondent's asserted proposal, is insufficient to establish "demonstrable preparations" to use the disputed domain name in connection with a *bona fide* offering of goods or services (see, e.g., *Helen Fielding v. Anthony Corbert aka Anthony Corbett*, [WIPO Case No. D2000-1000](#)).

Respondent's use of the disputed domain name to direct Internet users to a link farm parking page and a set of links to vendors of footwear, fashion accessories and clothing, does not establish rights or legitimate interests in the disputed domain name. Such uses are not non-commercial, and they do not represent fair use of Complainant's trademark. Respondent is using Complainant's trademark to confusingly misdirect Internet users for Respondent's commercial benefit.

Respondent has not rebutted Complainant's *prima facie* showing that it lacks rights or legitimate interests in the disputed domain name.

The Panel determines that Complainant has established that Respondent lacks rights or legitimate interests in the disputed domain name.

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

In order to prevail under the Policy, Complainant must demonstrate that each of the disputed domain names "has been registered and is being used in bad faith" (Policy, paragraph 4(a)(iii)). Paragraph 4(b) of the Policy states that "for the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith." Among those circumstances are: "by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent's] web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] web site or location or of a product or service on [the respondent's] web site or location."

Respondent has registered the disputed domain name employing a letter combination very close to that of Complainant's distinctive trademark. The Panel presumes that Respondent as an enterprise doing business in Germany knew of Complainant's trademark as Complainant's SNCF trains are commonly seen at German

railway stations,<sup>2</sup> and Complainant maintains a substantial presence under the SNFC trademark on the Internet, including with a German country code variant, *i.e.* <sncf.de>, that redirects to Complainant's principal website (German language version). Respondent registered the disputed domain name in the expectation that Internet users would mis-type Complainant's trademark in their browser address lines and be inadvertently redirected to Respondent's website identified by that name (*i.e.* typosquatting). Respondent presumably earns revenue from the promotional links on its website. Respondent registered and is using the disputed domain name for commercial gain to intentionally attracting Internet users to its website by creating confusion regarding Complainant as the source, sponsor, affiliate or endorser of Respondent's website. Such registration and use demonstrates bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

The Panel determines that Respondent registered and is using the disputed domain name 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 <snnfc.com> be transferred to the Complainant.

Frederick M. Abbott

Sole Panelist

Date: May 31, 2014

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<sup>1</sup> In the present context, the addition of the gTLD ".com" in the disputed domain name is not relevant for purposes of assessment of confusing similarity.

<sup>2</sup> The Panel takes administrative notice of this fact of its own knowledge.