

ADMINISTRATIVE PANEL DECISION

Alstom v. Zahir Khan, Palki Event Inc.

Case No. D2017-1124

1. The Parties

The Complainant is Alstom of Levallois-Perret, France, represented by Lynde & Associates of Paris, France.

The Respondent is Zahir Khan, Palki Event Inc. of Dhaka, Bangladesh.

2. The Domain Name and Registrar

The disputed domain name <alstom-powers.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 8, 2017. On the same date, the Center transmitted, by email, to the Registrar a request for registrar verification in connection with the disputed domain name. On June 9, 2017, the Registrar transmitted, by email, to the Center its verification response confirming that the Respondent is listed as the registrant and providing the Respondent’s contact details.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy”), 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 that the proceedings commenced on June 15, 2017. In accordance with the Rules, paragraph 5, the Center set the due date for Response to July 5, 2017. The Respondent did not submit any response. Accordingly, on July 6, 2017, the Center notified the Parties of the Respondent’s default.

The Center appointed Peter L. Michaelson as the sole panelist in this matter on July 12, 2017. 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

As reflected in the registration record for the disputed domain name in the public Whois database – a copy of that records appears in Annex 1 to the Complaint – the disputed domain name was registered on May 31, 2016, and will expire on May 31, 2018 (the name was originally registered by the Respondent for one year and then renewed on May 24, 2017, for a second year).

A. The Complainant's ALSTOM marks (collectively the "ALSTOM Marks")

The Complainant owns numerous trademark registrations in various countries worldwide for the term ALSTOM (in block letters and also stylized), which of particular relevance here includes registrations in Bangladesh. The Complainant has provided in Annex 5 to the Complaint a copy of the registration records, from a publicly available database, for some of its Bangladesh registrations, along with copies of registration records for some of its International and European Community ("OHIM") marks. Salient details of some of these registrations are as follows.

1. ALSTOM (stylized)

Bangladesh trademark registration 57,153; filed: September 21, 1998

This mark is registered for use in connection with all products in international class 4.

2. ALSTOM (stylized)

Bangladesh trademark registration 57,154; filed: September 20, 1998

This mark is registered for use in connection with: "Foil of tin, lead, aluminum and their alloys; products for welding; common metals and their alloys; rolled; shaped, worked and semi-worked materials based on tin, lead, aluminum and their alloys, boiler-making and auxiliary products; all semi-worked materials in copper and aluminum and their alloys; drawn and rolled products; nickel silver and alloys of nickel; bronzes; metal building materials; transportable buildings of metal; rails and other materials of metal for railway tracks" in international class 6.

3. ALSTOM (stylized)

Bangladesh trademark registration 57,155; filed: September 10, 1998

This mark is registered for use in connection with: "Rotating and static electric machines; pneumatic, hydraulic, thermal and nuclear machines" in international class 7.

4. ALSTOM (block letters)

International trademark registration: 706292; registered: August 28, 1998

This mark is registered for use with various goods in each of the following international classes: 1, 2, 4, 6, 7, 9, 11, 12, 13, 16, 17, 19, 24, 35, 36, 37, 38, 39, 40, 41 and 42. This registration designates, under collectively the Madrid Agreement and the Madrid Protocol, numerous countries throughout Europe, Asia and Africa, specifically including and notably Austria, Benelux, China, Germany, Egypt, Democratic People's Republic of Korea, Morocco, Portugal, Russian Federation, Viet Nam, United Kingdom and Norway.

B. The Parties and their Interaction

The Complainant is a French company created in 1928. It designs and manufactures equipment for power generation, power transmission and rail infrastructure, and currently employs approximately 32,000 people in over 60 countries.

Bangladesh is one of the countries which the Complainant actively serves and is one of the Complainant's key markets. Illustratively, in 2011, the Complainant was awarded a contract by the International group, Isolux Corsán, to supply gas turbine equipment and associated services for a 180 MW simple cycle gas-fired power plant in the Khulna district of Bangladesh for the North West Power Generation Company Limited. Further, in 2014, the Complainant delivered its highest capacity power transformer at 420 kV to Power Grid Company of Bangladesh Limited. The transformer (520 MVA, 3 phase, 420/235/33 kV) was delivered for the Bibiyana II 420 kV substation in Bangladesh.

The Complainant also registered and owns various domain names which include its mark ALSTOM, including <alstom-power.com>, <alstom-power.net> and <alstom-power.org>, all of which re-direct Internet users to the Complainant's main website at "www.alstom.com". Copies of the Whois records for these names appear in Annex 6 to the Complaint.

On May 31, 2016, the Complainant was advised that the Respondent registered the disputed domain name. At the time, the name resolved to a parking page which indicated that the corresponding website was under development (a copy of that page appears in Annex 7 to the Complaint). Currently, the disputed domain name still resolves to a parking page though the page states the website "@LsTOM is in progress" (a copy of the current page appears on page 9 of the Complaint) and displays a disclaimer reading:

"This is a not-for-profit, non revenue generating, non-trading website. The contents of this website are for educational and recreational purposes only and any names, characters, ideas, stories are completely fictional and created for aforesaid purposes and protected by the Copyrights Act, 2000 of Bangladesh, WIPO Lex No. BD016 and WIPO registered Copyright Rules 2006. However, these contents can be reproduced and circulated without owner's consent for educational purposes only."

On February 6, 2017, the Complainant's counsel sent a cease-and-desist letter to the Respondent asserting the Complainant's rights to the ALSTOM Marks and requesting that the Respondent transfer the disputed domain name for free to the Complainant.

On February 20, 2017, the Respondent's counsel replied that the name had been registered on a behalf of an "anonymous customer claimed to be the owner of ALSTOM POWERS" and for whom the Respondent would have built a corresponding website, but the anonymous customer later cancelled its request. Consequently, as the Respondent's counsel stated, the Respondent's website "remains blank". The Respondent, through its counsel, also stated that to avoid "any detriment suffered by ALSTOM", the Respondent agreed to transfer the disputed domain name "by way of sale". The Respondent's counsel also requested the Complainant's counsel participate in a mediation to amicably settle the dispute. On March 9, 2017, the attorneys for the Parties conducted their mediation but the mediation failed as the Respondent's counsel then requested the Complainant to pay USD 10,000 to transfer the name to the Complainant, an offer which the Complainant's counsel refused.

On April 6, 2017, the Complainant's counsel received an email from the Respondent's counsel indicating that the disputed domain name was supposed to expire on April 31, 2017, and that if the Complainant was "not willing to settle the ownership issue by way of buying the domain from our client [the Respondent], then they will be required to buy the domain in an open auction (as per terms and conditions of <godaddy.com>) as our client [the Respondent] is not inclined to renew his ownership of the said domain".

On April 9, 2017, and also April 13, 2017, the Complainant's counsel reiterated his refusal by email, and in those messages indicated that the Respondent's requests clearly reflected bad faith and once again required that the disputed domain name be transferred to the Complainant for free.

In response, on April 20, 2017, the Respondent's counsel informed the Complainant's counsel by email that the Respondent agreed to transfer the name for free to the Complainant and requested "suitable transfer instruments".

Though the Complainant's counsel provided the requested materials to the Respondent's counsel via an email dated May 3, 2017, the former received an email on April 30, 2017 from the latter through which the Respondent revoked and rescinded its offer of transfer claiming that the Complainant's counsel failed to respond to that offer.

No further communications occurred between the Parties. Hard copies of the above correspondence appear in Annex 3 to the Complaint.

The Respondent then renewed its registration of the disputed domain name on May 24, 2017, for an additional year.

5. Parties' Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant contends that the disputed domain name is confusingly similar to its mark ALSTOM.

Specifically, the disputed domain name contains the mark ALSTOM to which the word "powers" has been appended, with that word being incapable of adding sufficient distinctiveness whatsoever to the name to mitigate any resulting user confusion between the disputed domain name and the Complainant's mark. Furthermore, as the Complainant is well known in the electrical infrastructure and power generation industry, the inclusion of the word "powers" heightens a potential for confusion to occur among Internet users between the mark and the name.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

(ii) Rights or Legitimate Interests

The Complainant contends that, for any of several reasons, the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraphs 4(a)(ii) and 4(c) of the Policy.

The Complainant is neither affiliated in any way with the Respondent nor has the Complainant authorized, licensed or permitted the Respondent to register a domain name that incorporates any of the ALSTOM Marks.

Further, the Respondent is not known and has never been commonly known by any name or trade name that incorporates the mark ALSTOM.

Lastly, the Respondent has not made any demonstrable preparations to use the disputed domain name with a *bona fide* offering of goods or services as the Respondent's website resolvable through that name has been and remains under construction ever since the name was registered (on May 31, 2016).

(iii) Registered and Used in Bad Faith

The Complainant also contends that the Respondent has registered and is using the disputed domain name in bad faith in violation of paragraph 4(a)(iii) of the Policy.

Specifically, the name completely incorporates the Complainant's mark ALSTOM and was acquired well after that mark became sufficiently well-known and ultimately acquired fame. Further, in view of the fame of the mark including in Bangladesh, particularly given the scope of the Complainant's business there, it is virtually inconceivable that the Respondent, a Bangladeshi company, was unaware of the Complainant's activities

and its mark at the time the Respondent registered the name. Consequently, the Respondent's intentional registration of the name, knowing that the name incorporated the mark ALSTOM, reflects bad faith.

Moreover, the Respondent registered the disputed domain name with the intent of selling it and commercially benefitting from its sale. To that end, he requested the Complainant to pay USD 10,000 for the name – an amount well exceeding the Respondent's out-of-pocket costs of registration. After the Complainant refused, the Respondent, in an attempt to force the Complainant to purchase the name, threatened to allow the disputed domain name to be sold, upon the expiration of its original registration, at an open auction at which the Complainant would have no choice but to purchase it (as indicated in the April 6, 2017 message from the Respondent's counsel to the Complainant's counsel). This, too, reflects bad faith.

B. Respondent

In view of the lack of any Response, this administrative proceeding continued by way of default. Hence, under paragraphs 5(f), 14(a) and 15(a) of the Rules, the Panel decided this proceeding on the basis of the Complainant's undisputed factual allegations which the Panel finds are not inherently implausible.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to the Complainant's mark ALSTOM.

From a simple comparison of the name to the Complainant's mark ALSTOM, no doubt exists that the disputed domain name is confusingly similar to the mark. The disputed domain name <alstom-powers.com> consists of the term ALSTOM followed by a generic word "powers" along with an intervening hyphen. This word is clearly and commonly associated with large-scale electric infrastructure, an industry in which the Complainant operates and has acquired significant market reputation. The name also contains the generic Top-Level Domain ("gTLD") ".com". The addition of the gTLD is generally irrelevant in assessing confusing similarity or identity under paragraph 4(a)(i) of the Policy and thus ignored.

It has also become very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that a minor variation to a mark is usually insufficient in and of itself, when used in forming a domain name, particularly a Second-Level Domain ("SLD"), to confer requisite and sufficient distinctiveness to the resulting domain name to avoid a finding of confusing similarity. Here, the Respondent's addition of the word "powers" coupled with a preceding hyphen to form the SLD clearly constitutes such a minor variation. See, e.g., *SAP SE v. Lakshmi Reddy Bhumireddy and P. Hareesh*, WIPO Case No. D2017-0396; *Compagnie Générale des Etablissements Michelin v. Cameron Jackson*, WIPO Case No. D2016-2392; *Kumfs Brand Limited v. George*, WIPO Case No. D2016-1272; *Dubizzle Limited BVI v. Rana Anabtawi*, WIPO Case No. D2016-0843; *Chicago Mercantile Exchange Inc. and CME Group Inc. v. Domains By Proxy, LLC / Phupinder Gill*, WIPO Case No. D2015-1842; *Cummins Inc. v. Jamie Lent*, WIPO Case No. D2015-0188; *Staatliche Porzellan-Manufaktur Meissen GmbH v. Buy Meissen*, WIPO Case No. D2013-1687; *Forideas Pty Limited v. Movember Organization*, WIPO Case No. D2013-1385; *AlgaeCal Inc. v. AlgaeCal Fraud*, WIPO Case No. D2013-1248; *General Motors LLC v. Carol Schadt*, WIPO Case No. D2012-2106; *National Westminster Bank plc v. Steve Mart*, WIPO Case No. D2012-1711; *Tommy Bahama Group, Inc. v. Berno Group International*, WIPO Case No. D2012-0531; *National Association of Realtors v. Hammerberg & Associates, Inc.*, WIPO Case No. D2012-0075; *Space Needle LLC v. Erik Olson*, WIPO Case No. D2011-0931; and *Oakley, Inc. v. Kate Elsberry, Elsberry Castro*, WIPO Case No. D2009-1286; *Clearwire Legacy, LLC v. Leon Ganesh*, WIPO Case No. D2010-0148.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's mark ALSTOM. Hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists which would appear to legitimize a claim of rights or legitimate interests by the Respondent to the disputed domain name under paragraph 4(c) of the Policy.

The Complainant has never authorized the Respondent to utilize any of the Complainant's ALSTOM Marks and does not have any relationship, affiliation or connection whatsoever with the Respondent.

Further, the Respondent never did and does not now use nor has it ever made any demonstrable preparations to use the disputed domain name to resolve to an operational website through which it presently does or will make *bona fide* offerings of any goods or services. In that regard, from the date the disputed domain name was originally registered (May 31, 2016) to the present, the disputed domain name merely resolved and continues to resolve to a parking page which indicates that the Respondent's website remains under development.

Moreover, the evidence of record clearly reflects that the Respondent is not commonly known by the disputed domain name or the Complainant's mark ALSTOM. Given the Complainant's exclusive rights in its mark ALSTOM which in Bangladesh significantly predates, by at least some 18 years, the date, May 31, 2016, on which the Respondent originally registered the disputed domain name, the Respondent could not legitimately acquire such a public association or even an association with any mark similar to that of the Complainant – at least for the goods and services provided by the Complainant under its mark – without interfering with the exclusive trademark rights of the Complainant. See, e.g., *Compagnie Générale des Etablissements Michelin, supra*; *Philip Morris USA Inc. v. Daniele Kanai, iKiss LLC*, WIPO Case No. D2015-1527; *Valero Energy Corporation and Valero Marketing and Supply Company v. Lisa Katz, Domain Protection LLC / Domain Hostmaster, Customer ID: 62520014085963*, WIPO Case No. D2015-0787; and *Chicago Mercantile Exchange Inc., Cummins Inc., and Staatliche Porzellan-Manufaktur Meissen GmbH*, all *supra*.

Consequently, the Respondent does not satisfy any of paragraphs 4(c)(i)-(iii) of the Policy and thus has no rights or legitimate interests in the disputed domain name under paragraphs 4(a)(ii) and 4(c) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the Respondent's actions, with respect to the disputed domain name, constitutes bad faith registration and use.

The Panel infers, particularly from the lack of any substantive response and the Respondent's very choice of domain name, that the Respondent was well aware of the Complainant and its mark ALSTOM, the substantial reputation, goodwill and fame which that mark acquired and the exclusive rights which the Complainant held in that mark when the Respondent registered the disputed domain name. Yet, the Panel infers, in spite of that knowledge and in the absence of any authority to do so from the Complainant, the Respondent intentionally registered the name for its potential to opportunistically exploit that reputation and goodwill for the Respondent's own commercial benefit. While the Respondent claimed it registered the name on behalf of an "anonymous customer claimed to be the owner of ALSTOM POWERS", there is no evidence of record that it actually did so, thus leaving the Panel to infer that the true purpose of the Respondent's actions was to so exploit the name, in some fashion, at ultimately the Complainant's expense as no other party could legitimately use the name without potentially violating the Complainant's exclusive trademark rights in its mark ALSTOM. This purpose became patently evident to the Panel and any other finding is highly improbable when, during the course of interacting with the Complainant (through its counsel) in an attempt to settle this dispute prior to the filing of the Complaint, the Respondent offered to sell the name for USD 10,000 to the Complainant – a price far in excess of the Respondent's out-of-pocket costs of registration. Consequently, when viewed in its entirety, the Respondent's conduct directly violates paragraph 4(b)(i) of the Policy and thus clearly constitutes bad faith registration and use.

Thus, the Panel concludes that the Complainant has provided sufficient evidence of its allegations, with respect to the disputed domain name to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

7. Decision

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel grants the relief sought by the Complainant.

The disputed domain name <alstom-powers.com> is to be transferred to the Complainant.

Peter L. Michaelson

Sole Panelist

Date: July 17, 2017