

# **Société Nationale des Chemins de Fer Français v. LCOB, Nif ty Lemo de**

## **Case No. D2009-0161**

### **1. The Parties**

The Complainant is Société Nationale des Chemins de Fer Français of Paris, France, represented by Cabinet Santarelli, France.

The Respondent is LCOB, Nif ty Lemo de of Bellingham, Washington, United States of America, represented internally.

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

The disputed domain name <scnf.com> (the “Domain Name”) is registered with eNom, Inc.

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 5, 2009. On February 6, 2009, the Center transmitted by email to eNom a request for registrar verification in connection with the disputed domain name. On February 6, 2009, eNom transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on February 13, 2009 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 February 13, 2009. 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(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on February 18, 2009. In accordance with the Rules, paragraph 5(a), the due date for Response was March 10, 2009. The Response was filed with the Center on March 10, 2009.

The Center appointed Jacques de Werra as the sole panelist in this matter on March 20, 2009. 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 in this administrative proceeding is the national French railway company which operates all of France’s railway system.

The Complainant is, among others, the owner of the following trademarks (the “Trademarks”):

- The French trademark SNCF device filed under No. 1 314 288, on June 27, 1985 for the classes 6, 7, 12 and 39, duly renewed;
- The French trademark SNCF device filed under No. 93 466 498, on April 30, 1993 for the classes 12, 16, 18, 25, 28, 35, 39, 40, 41, 42, 43, 44 and 45, duly renewed;
- The French trademark SNCF device filed under No. 00 3 066 781, on November 24, 2000 for the classes 9, 35, 38 and 41;
- The International trademark SNCF device registered under No. 878 372, on August 23, 2005 for the classes 12, 16, 18, 24, 25, 28, 35, 39, 41 and 43.

The Trademarks are used in connection with transport and travel agencies services, as well as related goods. The Complainant is also the owner of various domain names including <snf.com>, <snf.fr> and <snf.eu>. The Complainant also provides travel agency services via a 100% controlled subsidiary which operates the website “[www.voyages-sncf.com](http://www.voyages-sncf.com)”.

The webpage to which the Domain Name resolves bears the title “Your Travel Resource” and is used as a page providing links to third party websites some of which are operated by competitors of the Complainant in the travel business. All the key words listed on the page are written in French and the first of these key words is “voyage” (i.e. travel). The webpage also contains a large picture of a diary which contains the word “vacation” which is written across the pages of the diary in broad hand written characters, whereby a user who clicks on this picture is brought to a page containing a list of links pointing to various online travel agency services (which are competing with those provided by the Complainant or by the Complainant’s affiliated companies).

## **5. Parties’ Contentions**

### **A. Complainant**

The Complainant contends that the Domain Name is confusingly similar to the Trademarks that it owns. The Domain Name is indeed a misspelling of the word “snf” which constitutes the verbal element of the Trademarks, whereby the only difference consists of the inversion of two letters (i.e. “c” and “n”) so that this minor inversion of letters is not sufficient to avoid confusion with the Complainant’s Trademarks. Quite to the contrary, because the Respondent’s registration of the Domain Name constitutes typosquatting, the Domain Name is, by definition, confusingly similar to the Complainant’s Trademarks.

The Complainant further argues that the Respondent has not been licensed, or otherwise permitted in any way by the Complainant to use the Trademarks, or any other confusingly similar signs, or to register any domain name incorporating the Trademarks, or any other confusingly similar signs, nor has the Complainant acquiesced in any way to such use or registration of the sign SCNF by the Respondent. The Complainant also claims that the Respondent, at least to the knowledge of the Complainant, has no rights, nor legitimate interests to the Domain Name. In addition, the Complainant points out that use of the Domain Name resolves to the Complainant’s competitors’ websites. Such use which diverts Internet

users who, via typosquatting, are looking for the Complainant's products or services on the Internet to competing websites for commercial gain is not a legitimate, *bona fide* use and does not confer rights or legitimate interests in the Domain Name.

Finally, the Complainant claims that the Respondent registered and uses the Domain Name in bad faith because the Respondent was aware of the existence of the Complainant's Trademarks because the website to which the Domain Name resolves is written in French and contains links to travel websites and contains words and expressions in French relating to the Complainant's core business activities. The Complainant also claims that the inversion of the letters "n" and "c" indicates that the Respondent intended to take advantage of possible mistakes by Internet users when typing the Complainant's address "[www.sncf.com](http://www.sncf.com)". The miss-spelled version of the Complainant's Trademarks, which is evidence of typosquatting, is sufficient to establish bad faith use and registration of the Domain Name. The Complainant also claims that offering sponsored links to other websites providing services of goods which are similar to those offered by the Complainant's own website is evidence of bad faith.

## **B. Respondent**

The Respondent claims that the Complainant has failed to demonstrate its rights to the term "sncf" within the United States of America which is the country where the Respondent is based (the Respondent claims to be a "concern" residing in the United States). The Respondent also claims that the Complainant has presented no evidence that it has ever asserted trademark rights within the United States of America and has nothing pertinent on file with the United States Patent and Trademark Office or in any jurisdiction under control of the United States. The Complainant also failed to supply any evidence that the Trademarks are known at all, let alone "well known" within the United States.

The Respondent further alleges that the Complainant has failed to establish a clear and convincing case that the term "sncf" is deceptively similar and confusing to the trademarks it may have on the term SNCF. The Respondent also claims that "sncf" and "sncf" should not be compared to mere misspellings of each other or "typos", because they are both unique and commonly used initialisms each with their own clear and distinct usages. It should be further noted that while the Complainant may indeed control numerous domains and websites using SNCF by itself and in combination with other terms its official website as the Complainant itself declares is "[www.voyages-sncf.com](http://www.voyages-sncf.com)". Given that <voyages-sncf.com> would be a "very far cry" from <sncf.com>, it is practically impossible to see how those two domain names could be reasonably confused. The Complainant asserts that the Respondent's website resolves to the Complainant competitors.

The Respondent also claims to have a common law trademark right under United States and Washington State law for the term "SNCF.com" for its use as an Internet search tool. The Respondent alleges that the Complainant has presented no evidence that it has at anytime in the past 9 years, the time the Domain Name has been in existence, attempted to contact the Respondent or that the Respondent was mindful at the time of registration or at any other time of the Complainant's alleged French trademark rights. The Complainant has provided no documents that it has ever attempted to assert its rights within the United States or that anyone within the United States should be on notice of its supposed "rights". Even if the Complainant asserts that the fact that some French language appears from time to time on the Respondent's website is an indicator of bad faith, the Respondent claims that mere linguistic preferences are insufficient to prove bad faith.

The Respondent also alleges that the Respondent's website has operated for almost an entire decade without complaint or assertion of superior rights from anyone. Thus the Respondent reasserts that it does possess valid rights to the Domain Name as it is currently used, that it did not at any time act in bad faith; and that the Complainant's trademark rights, whatever they may be, do not at this or any time prior extend to the United States and that even if they did, the Domain Name is not confusingly similar.

The Respondent finally seeks a determination of reverse domain name hijacking against the Complainant.

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy provides that the complainant must prove each of the following three elements in order to succeed in an administrative proceeding. Thus, for the complainant to succeed, it must prove all of the three elements under the Policy:

- (i) the respondent's 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 respondent's domain name has been registered and is being used in bad faith.

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

The Complainant is the owner of the Trademarks, the key verbal element of which is the term SNCF. The Panel notes that in line with the UDRP precedent, it suffices for the purposes of the first element of the UDRP for the Complainant to demonstrate that it has trademark rights in one jurisdiction. See, [WIPO Overview of WIPO Panel Views on Selected UDRP Questions, section 1.1](#) and the cases cited therein.

In this case, the Domain Name differs from the Complainant's Trademarks only by the inversion of the second and the third letters of the word. This inversion cannot prevent a finding of confusing similarity between the Trademarks and the Domain Name. See by analogy *Hertz System Inc. v. Domain Administrator*, [WIPO Case No. D2008-1460](#) (about the domain name <hertz.com>). In this respect, the argument raised by the Respondent which claims that there is no confusing similarity between <voyages-scnf.com> and the Domain Name is of no relevance given that the assessment must be made between the Trademarks and the Domain Name which are clearly confusingly similar.

The confusing similarity between SNCF (i.e. the Trademarks) and "scnf" (i.e. the Domain Name) is further confirmed by the fact that the Respondent (or the Respondent's counsel) in its Response claimed "a common-law trademark right under United States and Washington State law for the term 'SNCF.com' for its use as an Internet search tool", while it could only refer to the Domain Name, i.e. to <SCNF.com>, and not to <SNCF.com> which is the key official domain name of Complainant. The Respondent itself has thus made a confusion between the Domain Name and the domain name of Complainant. This risk of confusion existing between the Domain Name and the official domain name of the Complainant at <scnf.com><sup>1</sup> has also been confirmed by an independent Internet search which was conducted by the Panel<sup>2</sup>.

In the light of the above, the Panel finds that the Domain Name is confusingly similar to the Complainant's Trademarks. Therefore, the Complainant has established that the condition of paragraph 4(a)(i) of the Policy is met.

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

According to paragraph 4(c) of the Policy, the following circumstances can demonstrate rights or legitimate interests of a respondent in a domain name:

(i) before any notice was given to the respondent of the dispute, the respondent used, or demonstrably made 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 (as an individual, business, or other organization) has been commonly known by the domain name, even though it has not acquired any trademark or service mark rights; or

(iii) the respondent is making a legitimate noncommercial or fair use of the domain name.

The Complainant asserts that the Respondent has no rights or legitimate interests in the Domain Name. It also argues that the Respondent has not been licensed, or otherwise permitted in any way by the Complainant to use the Trademarks, or any other confusingly similar signs, or to register any domain name incorporating the Trademarks, or any other confusingly similar signs, nor has the Complainant acquiesced in any way to such use or registration of the sign "scnf" by the Respondent. The Complainant also claims that the Respondent has no rights on the Domain Name, nor legitimate interests to the Domain Name. In addition, the Complainant points out that the Domain Name resolves to the Complainant's competitors' websites. Such use which diverts Internet users who, via typosquatting, are looking for the Complainant's products / services on the Internet to competing websites for commercial gain is not a legitimate, *bona fide* use and does not confer legitimate interests in the Domain Name.

Although a complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, previous panels have consistently ruled that paragraph 4(c) of the Policy shifts the burden to the respondent to come forward with evidence of a right or legitimate interest in the domain name, once the complainant has made a *prima facie* showing. See *Document Technologies, Inc. v. International Electronic Communications Inc.*, [WIPO Case No. D2000-0270](#).

In this case, the Panel is satisfied that the Complainant has made the required *prima facie* showing so that the burden has shifted to the Respondent.

In this respect, the Panel notes that the Respondent has not brought any evidence or indication showing the Respondent's use, or demonstrable preparations to use, the Domain Name in connection with a *bona fide* offering of goods or services. The webpage entitled "Your Travel Resource" to which the Domain Name resolves which points to third party commercial websites classified by categories starting by a category "travel" (voyage written in French) which are related and competing to the Complainant's business activities does not qualify as a *bona fide* offering of goods or services.

The Respondent has not brought any evidence which would support the view that it is or has been commonly known by the Domain Name. The Respondent has merely alleged that it would be a “concern” based in the United States and that it would have a common law trademark right on the term “SCNF.com” in the United States and in the State of Washington. However, the Respondent has not brought any evidence in support of such allegations. On this basis, the Panel cannot accept that the Respondent would have been commonly known by the Domain Name. Quite to the contrary, the use made of the Domain Name as resulting from the title of the page (i.e. “Your Travel Resource”) and from the categories of links found on the page (i.e. “voyage” for travel) as well as the French language used for these categories of links clearly lead the Panel to consider that the Domain Name is used and was registered for the purpose of trading off on the Complainant’s name and on the Complainant’s Trademarks.

The Panel also notes that there is no noncommercial or fair use of the Domain Name given that the website contains sponsored links to third parties’ commercial websites offering services which compete with those of the Complainant.

Finally, the Respondent has not been licensed, or permitted by the Complainant to use the Trademarks or any variations therefore including in the Domain Name.

Therefore, the Panel is satisfied that the Respondent lacks rights or legitimate interests in the Domain Name under the Policy. The Panel thus concludes that the condition of paragraph 4(a)(ii) of the Policy has been established by the Complainant.

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

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration or use of a domain name in bad faith:

- (i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant (the owner of the trademark or service mark) or to a competitor of that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name;
- (ii) circumstances indicating that the respondent registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct;
- (iii) circumstances indicating that the respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the respondent intentionally is using the domain name in an attempt to attract, for commercial gain, Internet users to its website 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 website or location or of a product or service on its website or location.

The Respondent pleads in this case that the fact that the Complainant delayed for almost 10 years following registration of the Domain Name to bring this action against the Respondent act as a bar to a finding in favor of the Complainant. However, as noted by other panels, the lapsing of time does not as such constitute a bar to a successful action under the Policy. In *Tom Cruise v. Network Operations Center / Alberta Hot Rods*, [WIPO Case No. D2006-0560](#), the panel indeed held that it “does not accept that there is meaningful precedent under the Policy for refusing to enforce trademark rights on the basis of a delay in bringing a claim following use of a disputed domain name”.

Similarly to the argument raised in the case cited above, the Respondent here has given no argument whatsoever that it has or would suffer injury because of the Complainant’s delay in initiating this proceeding. In addition, the Respondent has not shown in any manner that there was any indication, express or tacit, that the Complainant had consented to the Respondent’s use of confusing similar misspelling of the Trademarks in the Domain Name. See *2001 White Castle Way, Inc. v. Glyn O. Jacobs*, [WIPO Case No. D2004-0001](#). As a result, without any evidence indicating that the Complainant would have approved of the Respondent’s use of a confusing similar misspelling of the Trademarks in the Domain Name, the Panel is not prepared to admit that the delay in initiating this action constitutes a bar against the Complainant.

The Panel further notes that the Respondent activated “robots.txt”, which prevents the public (and the Panel in this dispute) from viewing how the Domain Name has been used over time in the past. This has been held in and of itself to be a factor suggesting the bad faith behaviour of the holder of the domain name. See *Bacchus Gate Corporation d/b/a International Wine Accessories v. CKV and Port Media, Inc.*, [WIPO Case No. D2008-0321](#) and *The iFranchise Group v. Jay Bean/MDNH, Inc./Moniker Privacy Services [23658]*., [WIPO Case No. D2007-1438](#).

The record of the case strongly suggests that the Respondent intentionally attempted to attract Internet users to its website through the fame and goodwill of the Trademarks by registering and using the Domain Name in order to take advantage of typographical errors made by Internet users seeking the Complainant’s commercial websites. See *Société Nationale des Chemins de Fer Français v. Miguel Casajuana*, [WIPO Case No. D2008-1593](#) and *Société Nationale des Chemins de Fer Français (SNCF) c. Paco Elmudo*, [WIPO Case No. D2002-1079](#).

The Panel is thus convinced that the Respondent was aware of the Complainant and its Trademarks when it registered the Domain Name even if such registration occurred several years ago. It has indeed been acknowledged by other panels that the Trademarks have been well known in France and abroad. See *Société Nationale des Chemins de Fer Français v. Miguel Casajuana*, [WIPO Case No. D2008-1593](#) and *Société Nationale des Chemins de Fer Français (SNCF) c. Paco Elmudo*, [WIPO Case No. D2002-1079](#). The Respondent itself does not claim that it did not know the Complainant’s company and the Complainant’s name at the time of registration of the Domain Name, but essentially alleges that the Trademarks were not protected in the United States of America where it is based.

The Panel is thus convinced that the Trademarks are largely known as designating the Complainant and that the choice of the Domain Name was made in view of the Complainant and of the Trademarks and for no other reason.

In this respect, the Respondent has not brought any evidence demonstrating the meaning of the acronym (“SCNF”) contained in the Domain Name or showing that it would effectively use such term in connection with any good faith business operation. The Respondent has indeed only alleged without bringing any evidence that it would be a “concern” based in the United States.

In view of the circumstances, the Panel is led to consider that when Respondent chose to register the Domain Name consisting of a misspelled variation of the Trademarks, it knew and planned that its website would receive Internet traffic due to the use of a misspelled variation of the Trademarks. Its registration thus knowingly traded off the likelihood that consumers will mistakenly infer an affiliation between the Respondent’s official websites and the Complainant, diverting customers away from the Complainant’s own websites. The Respondent’s actions have the potential to disrupt the Complainant’s business in a manner that the Respondent could clearly anticipate. This is particularly evidenced by the fact that the webpage to which the Domain Name resolves bears the title “Your Travel Resource” and by the fact that, as emphasised by the Complainant and in spite of the Respondent’s unsupported refutation, the key words listed in the page are written in French thus targeting a French speaking audience (who know the Trademarks and the Complainant) and that the first key word is “voyage” (i.e. travel).

The Respondent’s bad faith is further illustrated by the domain name’s resolution to a page containing links to websites selling products some of which are competing with those offered by the Complainant (or by the Complainant’s affiliate company active in the travel business). It is now well-established that such use is evidence of bad faith. See, e.g., *Bayerische Motoren Werke AG v. bmwriders llc*, [WIPO Case No. D2008-0610](#); *Roust Trading Limited v. AMG LLC*, [WIPO Case No. D2007-1857](#); *Express Scripts Inc. v. Windgather Investments Limited/Mr. Cartwright*, [WIPO Case No. D2007-0267](#); *Sports Saddle, Inc. v. Johnson Enterprises*, [WIPO Case No. D2006-0705](#). Not only does the Respondent’s registration divert Internet users to its website based on the goodwill of the Trademarks, but it also threatens to divert actual clients away from the Complainant.

Based on the foregoing, the Panel finds that the Respondent has registered the Domain Name and is using it in bad faith so that the requirements of paragraph 4(a)(iii) of the Policy are met.

#### **D. Reverse Domain Name Hijacking**

The Respondent alleges that the Complaint filed by the Complainant constitutes a case of reverse domain name hijacking.

Paragraph 1 of the Rules defines reverse domain name hijacking as “using the Policy in bad faith to attempt to deprive a registered domain name holder of a domain name”. To prevail on such a claim, a respondent must show that the complainant knew of the respondent’s unassailable rights or legitimate interests in the disputed domain name or the clear lack of bad faith registration and use, and nevertheless brought the complaint in bad faith. See *Sydney Opera House Trust v. Trilynx Pty. Limited*, [WIPO Case No. D2000-1224](#) and *Goldline International, Inc. v. Gold Line*, [WIPO Case No. D2000-1151](#).

It follows from the Panel’s findings above that the Complaint is justified and well founded, and consequently that there is no basis for a finding of Reverse Domain Name Hijacking.



## **7. Decision**

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name <scnf.com> be transferred to the Complainant.

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Jacques de Werra  
Sole Panelist

Dated: April 2, 2009