

Decision for dispute CAC-UDRP-104534

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| Case number | CAC-UDRP-104534 |
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| Time of filing | 2022-05-04 09:30:18 |
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| Domain names | boursorama.one |
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Case administrator

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| Organization | Denisa Bilík (CAC) (Case admin) |
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Complainant

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| Organization | BOURSORAMA SA |
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Complainant representative

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| Organization | NAMESHIELD S.A.S. |
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Respondent

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| Organization | 1337 Services LLC |
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OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the registered owner of European Union Trade Mark BOURSORAMA, registration number 001758614, registered on October 19, 2001 for goods and services in international 9, 16, 35, 36, 38, 41 and 42.

FACTUAL BACKGROUND

The Complainant provides financial services in Europe, including online brokerage, financial information on the Internet and online banking which it provides under the BOURSAMA trademark and service mark for which it owns the following European Union Trademark registration:

- European Union Trade Mark BOURSORAMA, registration number 001758614, registered on October 19, 2001-for goods and services in international 9, 16, 35, 36, 38, 41 and 42.

The Complainant has an established Internet presence and uses its domain name <boursorama.com> which was created on February 2, 1998 as the address of its principal website.

The disputed domain name <boursorama.one> was registered on April 10, 2022 and is inactive.

There is no information available about the Respondent, except for that provided in the Complaint, the Registrar's Whois and the information provided by the Registrar, confirming that the Respondent is the registrant of the disputed domain name in response to the request by the Centre for details of the disputed domain name.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant claims rights in the BOURSORAMA registered trademark and service mark established by its ownership of European Trade Mark described below and alleges that the disputed domain name <boursorama.one> is identical to its said registered mark.

The Complainant contends that the BOURSORAMA mark is included in its entirety, without any addition or deletion and adds that the addition of the suffix ".ONE" does not change the overall impression of the designation as being connected to the Complainant's trademark and does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademark and its domain names associated. See WIPO Case No. D2006-0451, F. Hoffmann-La Roche AG v. Macalve e-dominios S.A. ("It is also well established that the specific top level of a domain name such as ".com", ".org" or ".net" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar."); Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com> ("Here, the WHOIS information of record identifies Respondent as "Chad Moston / Elite Media Group." The Panel therefore finds under Policy paragraph 4(c)(ii) that Respondent is not commonly known by the disputed domain name under Policy paragraph 4(c)(ii).").

The Complainant next alleges that the Respondent has no rights or legitimate interest in the disputed domain name domain name, arguing that the Respondent is not identified in the Whois database as the disputed domain name. Past panels have held that a Respondent was not commonly known by a disputed domain name if the Whois information was not similar to the disputed domain name. Thus, the Respondent is not known as the disputed domain name. See Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com> ("Here, the WHOIS information of record identifies Respondent as "Chad Moston / Elite Media Group." The Panel therefore finds under Policy paragraph 4(c)(ii) that Respondent is not commonly known by the disputed domain name under Policy paragraph 4(c)(ii).").

The Complainant adds that the Respondent is not known to the Complainant and is not affiliated with nor authorized by the Complainant in any way, nor does the Complainant carry out any activity for, nor has any business with the Respondent.

The Complainant further asserts that it has granted neither license nor authorization to the Respondent to make any use of the Complainant's registered trademark BOURSORAMA, or to apply for registration of the disputed domain name.

The Complainant contends that the Respondent has not made any use of disputed domain name since its registration, and argues that therefore the Respondent has no demonstrable plan to use the disputed domain name. In support of this assertion the Complainant refers to a screen capture of the website to which the disputed domain name resolves annexed as an exhibit to the Complaint, the Complainant submits that it shows that the disputed domain name links to a message which states that the website is inaccessible. The Complainant submits that it follows that the disputed domain name is inactive.

The Complainant next argues that the disputed domain name which is identical to its BOURSAMA name and mark was registered and is being used in bad faith, arguing that since it was established in 1995, the Complainant has become well known for online banking in France with over 3,3 million customers. The portal www.boursorama.com is the first national financial and economic information site and first French online banking platform.

It is contended that therefore, it is reasonable to infer that the Respondent has registered the disputed domain name in bad faith

with full knowledge of the Complainant's trademark. See *BOURSORAMA v. PD Host Inc - Ken Thomas CAC Case No. 101131*, ("In the case at hand, the Respondent acted in bad faith especially because the Respondent, who has no connection with the well-known "BOURSORAMA" trademark, registered a domain name, which incorporates the well-known "BOURSORAMA" trademark and it is totally unrealistic to believe that the Respondent did not know the Complainant's trademark when registered the domain name <wwwboursorama.com>."); *Boursorama SA v. Estrade Nicolas WIPO Case No. D2017-1463*, ("Given the circumstances of the case including the evidence on record of the longstanding of use of the Complainant's trademark, and the distinctive nature of the mark BOURSORAMA, it is inconceivable to the Panel in the current circumstances that the Respondent registered the disputed domain name without prior knowledge of the Complainant and the Complainant's mark.")

Addressing the allegation that the disputed domain name was registered in bad faith, the Complainant contends that the Respondent has not demonstrated any activity in respect of the disputed domain name, and is inactive as shown in the screen capture of the website annexed to the Complaint. The Complainant argues that it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law.

As prior WIPO UDRP panels have held, the incorporation of a famous mark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use. See - *Telstra Corporation Limited v. Nuclear Marshmallows WIPO Case No. D2000-0003*.

RESPONDENT:

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

The Complainant has provided convincing uncontested evidence that rights in the BOURSAMA mark, established by its ownership of the European Union Trade Mark registration described above.

The disputed domain name <boursorama.one> consists of the Complainant's BOURSAMA mark in its entirety, in combination with the generic Top-Level Domain "(gTLD)" extension <.one>.

The Complainant's BOURSAMA mark is the dominant and only element in the disputed domain name.

The gTLD extension <.one> add any distinguishing character and in the context of this Complaint, it would be considered by Internet users to be a necessary technical requirement for a domain name.

This Panel finds therefore that the disputed domain name <boursorama.one> is confusingly similar to the BOURSAMA mark in which the Complainant has rights and the Complainant has therefore succeeded in the first element of the test in Policy paragraph 4(a)(i).

The Complainant has made out a prima facie case that Respondent has no rights legitimate interests in the disputed domain name arguing that

- the Respondent is not identified in the Whois database as the disputed domain name and thus the Respondent is not known as the disputed domain name;
- the Respondent is not known to the Complainant and is not affiliated with nor authorized by the Complainant in any way, nor does the Complainant carry out any activity for, nor has any business with the Respondent;
- the Complainant has not granted any license nor authorization to the Respondent to make any use of the Complainant's registered trademark BOURSORAMA, or to apply for registration of the disputed domain name;
- the Respondent has not made any use of disputed domain name since its registration as evidenced by the screen capture of the website to which the disputed domain name resolves annexed as an exhibit to the Complaint, which shows that the disputed domain name links to a message which states that the website is inaccessible;
- the disputed domain name is inactive; and
- the Respondent has no demonstrable plan to use the disputed domain name.

It is well established that once a complainant makes out a prima facie case that a respondent has no rights or legitimate interests in the domain name at issue, the burden of production shifts to the respondent to prove its rights or legitimate interests.

Respondent has failed to discharge that burden and therefore this Panel must find that Respondent has no rights or legitimate interests in the disputed domain name.

Complainant has therefore succeeded in the second element of the test in Policy paragraph 4(a)(ii).

The uncontested evidence shows that the Complainant has built a substantial reputation in the BOURSAMA mark since it was established in 1995 and maintains an established Internet presence on its website at <www.boursorama.com>.

The uncontested evidence adduced by the Respondent in its company information annexed to the Complaint, claims that it has 3.3 million banking clients, over 600 stock market brokerage clients and its website at <www.boursorama.com> attracts close to 47 million Internet visits per month.

On the balance of probabilities therefore, this Panel finds that the disputed domain name was registered in bad faith with full knowledge that it is identical to the Complainant's BOURSAMA name and mark in which the Complainant has rights. There is no plausible reason as to why the registrant chose the disputed domain name other than to take predatory advantage of the Complainant's rights.

The uncontested evidence is that the disputed domain name is being passively held by the Respondent and is inactive and when searched for, generates a message that states that the website cannot be found.

This Panel finds therefore that such passive holding allows this Panel to make a finding that on the balance of probabilities the disputed domain name is being used in bad faith for the purposes of the Policy.

This finding is supported by the fact that Respondent availed of a privacy service to conceal his identity on the published Whois, has not responded to the Complaint.

As this Panel has found that the disputed domain name was registered and is being used in bad faith, Complainant has succeeded in the third element of the test in Policy paragraph 4(a)(iii).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **BOURSORAMA.ONE**: Transferred

PANELLISTS

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|------|-------------------------|
| Name | Mr James Jude Bridgeman |
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| DATE OF PANEL DECISION | 2022-05-25 |
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Publish the Decision