Decision for dispute CAC-UDRP-101501

Case number	CAC-UDRP-101501
Time of filing	2017-04-05 10:00:22
Domain names	BOLLORELOGISTICSUS.NET

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	BOLLORE SA

Complainant representative

Organization	Nameshield (Maxime Benoist)

Respondent

Name	Delonte Wood

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 owner of several trademarks, including the international trademark <BOLLORÉ> with the registration number 704697, which was registered on December 11th, 1998. The expiration date is December 11th, 2018. The Complainant is also owner of the international trademark <BOLLORÉ LOGISTICS> with the registration number 1025892, which was registered on July 31st, 2009. The expiration date is July 31st, 2019. Moreover, the Complainant is owner of the international trademark <BOLLORÉ LOGISTICS> with the registration number 1302823, which was registered on January 27th, 2016. The expiration date is January 27th, 2026. The Complainant is also owner of the European trademark <BOLLORÉ LOGISTICS> with the registration number 007598171, which was registered on October 7th, 2009.

Furthermore, the Complainant is also the holder of a huge number of domain names including its trademarks <BOLLORÉ> and <BOLLORÉ LOGISTICS>, inter alia of the domain name “Bollore.com”, created on July 25th, 1997, the domain name “Bollore.net”, created on May 12th, 1997 and the domain name “Bollore.group”, created on December 2nd, 2016, as well as the domain name “Bollore-Logistics.com”, the domain name “BolloreLogistics.com” and the domain name “BolloreLogistics.net”, all of them registered on January 20th, 2009.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant, the Bolloré Group, a listed company founded in 1822, is one of the 500 largest companies in the world. The three main business areas of the Complainant are transportation and logistics, communication and media, electricity storage and solutions. The Bolloré-Group company Bolloré Logistics is one of the 10 leading worldwide companies in transportation and logistics. The Complainant uses the trademark <BOLLORE LOGISTICS> in relation to its transportation and logistics business.

The disputed domain name <BOLLORELOGISTICSUS.NET> was registered on March 16th, 2017 by Delonte Wood. The disputed domain name <BOLLORELOGISTICSUS.NET> is currently inactive. It displays a non-disclosure notice ("This Account Has Been Suspended").

As far as the Complainant's contentions are concerned, the Complainant claims that the disputed domain name <BOLLORELOGISTICSUS.NET> is confusingly similar to its trademarks <BOLLORE> and <BOLLORE LOGISTICS>. Furthermore, the Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name <BOLLORELOGISTICSUS.NET>. Finally, the Complainant states that the disputed domain name <BOLLORELOGISTICSUS.NET> has been registered and is been using in bad faith.

The Complainant refers to the following cases to support its submissions:
I
- WIPO case no. D2015-1775, Sanofi v. Tulip Trading Company / On behalf of sanofi-us.com OWNER / c/o whoisproxy.com Ltd.: "The Panel also finds that the mere adjunction of the term "us" to the trademark SANOFI is not enough to distinguish the disputed domain name from one that may be legitimately associated with the Complainant's marks and to escape a finding of confusing similarity."

II
- WIPO case no. D2003-0455 Croatia Airlines d.d. v. Modern Empire Internet Ltd., the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests.
- WIPO case No. D2000-1164, Boeing Co. v. Bressi: the Panel stated that the "Respondent has advanced no basis on which he could conclude that it has a right or legitimate interest in the domain names";
- NAF case No. FA109697, LFP, Inc. v. B & J Props.: the Panel stated that "the respondent cannot simply do nothing and effectively "sit on his rights" for an extended period of time when the respondent might be capable of doing otherwise".

III
- NAF Case no. FA 744444, Yahoo! Inc. v. Butler: finding bad faith where the respondent was "well-aware of the complainant's YAHOO! mark at the time of registration.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that the disputed domain name <BOLLORELOGISTICSUS.NET> is confusingly similar to its trademarks <BOLLORE> and <BOLLORELOGISTICS> and its domain names associated, because

- the disputed domain name <BOLLORELOGISTICSUS.NET> contains the Complainant's trademark <BOLLORE LOGISTICS> in its entirety and
- only differs from the Complainant's trademark <BOLLORE LOGISTICS> in the addition of the letters "US" (in reference of the country code of the United States) at the end of the disputed domain name and the gTLD ".NET".

The addition of the letters “US” and the gTLD “.NET” is not sufficient to escape the finding that the disputed domain name <BOLLORELOGISTICSUS.NET> is confusingly similar to the Complainant’s trademarks <BOLLORE> and <BOLLORE LOGISTICS> and does not change the overall impression of the designation as being connected to the Complainant’s trademark <BOLLORE LOGISTICS>.

The Complainant further asserts that the Respondent does not have any rights or legitimate interest in the disputed domain name <BOLLORELOGISTICSUS.NET>, because:

- The disputed domain name <BOLLORELOGISTICSUS.NET> is registered by the Respondent under his name Delonte Wood. The Respondent is not known by the Complainant;
- The Respondent is not affiliated the Complainant in any ;
- The Respondent does not carry out any activity for, nor has any business with the Complainant;
- Neither a license nor an authorization has been granted to the Respondent to make any use of the Complainant’s trademarks <BOLLORE> and <BOLLORE LOGISTICS>, or apply for registration of the disputed domain name <BOLLORELOGISTICSUS.NET> by the Complainant.

The website in relation with the disputed domain name <BOLLORELOGISTICSUS.NET> is inactive since its registration on March 16th, 2017 and not operated by the Respondent. The Complainant contends that this demonstrates a lack of legitimate interests in respect of the disputed domain name.

The Complainant also states that the disputed domain name <BOLLORELOGISTICSUS.NET> was registered and is being used in bad faith, because:

- The Complainant and its trademarks <BOLLORE> and <BOLLORE LOGISTICS> are distinctive and also well-known worldwide, as shown by Google searches for “BOLLORE” and “BOLLORE LOGISTICS”, which show several results, all of them being related to the Complainant and its trademarks .

Prior Panels have confirmed the distinctiveness of the Complainant’s trademark <BOLLORE>. See for instance.
• WIPO case No. D2016-2489, BOLLORE v. Assiom SITTI-Newtek, <bollore.top>,
• WIPO case No. D2016-1979, BOLLORE v. Bollore, <bolloore.com>,
• WIPO case No. D2015-2113, BOLLORE v. Pastel Nathaniel Karl-Ioic, <bollore-credits.com>,
• CAC case No. 101390, BOLLORE v. Roy, <boll0re.com>,
• CAC case No. 101128, BOLLORE v. Mbah Sylvester, Mr IT, <bolloreholdings.com>,
• NAF case No. 1706884, BOLLORE v. Cameron Jackson, <bollore.us>

Moreover, the Complainant has branches all over the world, in the United States for example in Washington, Miami, Chicago or Los Angeles.

The Complainant argues that:

- Given the distinctiveness and reputation of the Complainant's trademarks <BOLLORE> and <BOLLORE LOGISTICS>, it has to be assumed that the Respondent has registered the disputed domain name <BOLLORELOGISTICSUS.NET> with full and actual knowledge of the Complainant's trademarks and rights in the trademarks;
- The sole aim of Respondent’s registration of the disputed domain name <BOLLORELOGISTICSUS.NET> is to create a likelihood of confusion with the Complainant’s trademarks and domain names associated;
- The website in relation with the disputed domain name <BOLLORELOGISTICSUS.NET>is not being used since its registration; rather the disputed domain name is inactive (passive holding). Also, the Respondent has made no evidence for any actual or contemplated legitimate or fair use of the disputed domain name <BOLLORELOGISTICSUS.NET>.

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

According to paragraph 4(a) of the Policy the Complainant must prove for the requested transfer of the disputed domain <BOLLORELOGISTICSUS.NET> that

(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 to the domain name; and
(iii) the domain names has been registered and is being used in bad faith.

Without a doubt the Complaint complies with all these requirements:

(i) The disputed domain name <BOLLORELOGISTICSUS.NET> is confusingly similar to the Complainant's trademark <BOLLORE LOGISTICS> for it wholly comprises this trademark, with the mere adding of the generic term “US”, which stands for the country code of the United States. The mere adding of such a generic abbreviation is insufficient to prevent confusing similarity. Accordingly, the Panel finds that the disputed domain name <BOLLORELOGISTICSUS.NET>is confusingly similar to the Complainant’s trademarks <BOLLORE> and <BOLLORE LOGISTICS>.

(ii) Furthermore, the Respondent has no rights or legitimate interests in the disputed domain name <BOLLORELOGISTICSUS.NET>. The Complainant stated that the Respondent is not affiliated with or authorized by the Complainant in any way. There is no evidence of the fact that the Respondent is been commonly known by the disputed domain name <BOLLORELOGISTICSUS.NET> or by a name corresponding to the disputed domain name. The Panel also finds that the Complainant successfully submitted prima facie evidence that the Respondent has made no use of, or demonstrable preparations to use the disputed domain name. This prima facie evidence was not challenged by the Respondent. The Panel further finds that the Complainant successfully asserted that the Respondent has registered the disputed domain name <BOLLORELOGISTICSUS.NET> only in order to create a likelihood of confusion with the Complainant’s trademarks <BOLLORE> and <BOLLORE LOGISTICS>. Given the worldwide notoriety of the Complainant and the Complainants’ trademarks <BOLLORE> and <BOLLORE LOGISTICS> as well as its reputation it is highly unlikely that the Respondent would have been unaware of this facts at the time of registration; in fact it must be assumed that the Respondent has registered the disputed domain name <BOLLORELOGISTICSUS.NET> in full knowledge of the Complainants’ trademarks. Therefore, and in the absence of a response, the Panel finds that the Complainant has made a prima facie case that the Respondent has no rights or legitimate interest in the disputed domain name.

(iii) As to the bad faith at the time of the registration, the Panel, considering the distinctiveness and reputation of the

Complainant and the Complainants' trademarks, with which the disputed domain name is confusingly similar, infers that the Respondent had the Complainant and its trademarks <BOLLORE> and <BOLLORE LOGISTICS> in mind when registering the disputed domain name <BOLLORELOGISTICSUS.NET>. Moreover, the disputed domain name <BOLLORELOGISTICSUS.NET> has not been used in connection with an active website since the registration, in fact the disputed domain name has been passively held. As established, the concept of "bad faith use" includes not only positive action but also passive holding, especially in cases of domain name registrations corresponding to distinctive and well-known trademarks. Therefore the disputed domain name <BOLLORELOGISTICSUS.NET> was registered and used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOLLORELOGISTICSUS.NET**: Transferred

PANELLISTS

Name	**Prof. Dr. Lambert Grosskopf, LL.M.Eur.**

DATE OF PANEL DECISION 2017-05-02

Publish the Decision