Decision for dispute CAC-UDRP-102357

Case number	CAC-UDRP-102357
Time of filing	2019-02-15 09:32:47
Domain names	financo-invest.com

Case administrator

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

Complainant

Organization	FINANCO

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Organization	interfinancemennt

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner, among others, of the French trademark registration No. 3747380 for “FINANCO” (word and device), filed on June 18, 2010, in classes 9, 16, 35, 36, 38 and 42.

The disputed domain name was registered by the Respondent on January 31, 2019.

FACTUAL BACKGROUND

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

The Complainant states that it was founded in 1986 and that it is a financial company specializing in consumer credit.

The Complainant submits that it has 400 employees and that it is a subsidiary of a larger company group, namely Crédit Mutuel Arkéa.

The Complainant points out that it is the owner of several French trademarks containing the word “FINANCO”.

The Complainant adds that it is also the owner of various domain names that contain the distinctive word “FINANCO”, including the domain name <financo.fr>, registered on March 18, 1998, and the domain name <financo.eu>, registered on March 20, 2006.

The Complainant observes that the disputed domain name was registered on January 31, 2019, and redirects to a website in French which offers loans and consumer credits.

The Complainant contends that the disputed domain name is confusingly similar to its trademark “FINANCO” because it includes the Complainant's trademark in its entirety and the addition of the generic term is not sufficient to avoid confusing similarity.

The Complainant argues that the addition of the term “INVEST”, which relates to the same kind of activity carried out by the Complainant, increases the likelihood of confusion with the Complainant's trademark.

The Complainant adds that the addition of the top-level domain suffix “.COM” does not change the overall impression of the designation as being connected with the trademark “FINANCO”.

The Complainant contends that the Respondent does not have any rights or legitimate interest in the disputed domain name.

The Complainant observes that it is required to make out a prima facie case that the Respondent lacks rights or legitimate interest and, once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. The Complainant adds that if the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Complainant argues that the Respondent is not known as “FINANCO-INVEST”, but has a different name.

The Complainant contends that the Respondent is not affiliated with nor authorized by it in any way.

The Complainant states that it does not carry out any activity for, nor has any business with the Respondent.

The Complainant underlines that neither licence nor authorization has been granted to the Respondent to make any use of the Complainant’s trademarks.

The Complainant points out that it has never authorised the Respondent to apply for registration of the disputed domain name on behalf of the Complainant.

The Complainant submits that the word “FINANCO” does not correspond to any word in the dictionary.

The Complainant observes that the website related to the disputed domain name is used for offering financial services which compete with the services provided by the Complainant.

The Complainant notes that the company appearing in the legal notice of the website related to the disputed domain name has the address in France, however it does not correspond to any company registered with the French official Company Register.

The Complainant underlines that the disputed domain name has been registered many years after the registration of the Complainant's trademark “FINANCO”.

The Complainant stressed that the word “FINANCO” has no meaning in any language and that the Respondent uses the disputed domain name for promoting financial services which compete with the services offered by the Complainant.

The Complainant argues that the use of a domain name for offering competing services is often considered as evidence of

bad faith.

The Complainant submits that, given the distinctiveness of the Complainant's trademark, the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark.

The Complainant asserts that the Respondent has intentionally attempted to attract Internet users to the Respondent's website for commercial gain by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of such website. The Complainant observes that these activities amount to bad faith use of the disputed domain name pursuant to paragraph 4(b)(iv) of the Policy.

PARTIES CONTENTIONS

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

In accordance with paragraph 4(a) of the Policy, in order to obtain the transfer of the disputed domain name, the Complainant has to demonstrate that:

(i) The disputed 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 disputed domain name; and

(iii) The disputed domain name has been registered and is being used in bad faith.

DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR

The first requirement that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant’s trademark or service mark rights.

There are two elements of this test: the Complainant must demonstrate that it has rights in a trademark or service mark and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark or service mark.

The Complainant has proven ownership of the registered trademark “FINANCO”, identified in section “Identification of rights” above.

The Panel observes that the registration of the Complainant's trademark predates the registration of the disputed domain name.

On the question of identity or confusing similarity, what is required is simply a comparison and assessment of the disputed domain name itself to the Complainant's trademark.

The disputed domain name differs from the Complainant's trademark "FINANCO" only by the addition of the hyphen, of the letter "INVEST" after the hyphen, and of the top-level domain ".COM".

It is well accepted that the hyphen is not relevant in the confusing similarity test (see, for example, WIPO case No. D2016-0676).

It is a common view that where a trademark is the distinctive part of a domain name, the domain name is considered to be confusingly similar to the trademark (see, for example, WIPO case No. D2017-1266).

In the present case the word "INVEST" after the hyphen has no impact on the distinctive part "FINANCO". Furthermore, the word "INVEST", which constitutes the second part of the disputed domain name, is a generic name in relation with the field of activity of the Complainant, namely the financial field. It is well established that where the relevant trademark is recognizable within the domain name, the addition of other terms would not prevent a finding of confusing similarity.

It is also well established that the top-level domain may generally be disregarded in the confusing similarity test (see, for example, WIPO case No. D2016-2547).

Therefore, the Panel considers that the disputed domain name is confusingly similar to the Complainant's trademark.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

RIGHTS OR LEGITIMATE INTERESTS

The second requirement that the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in the disputed domain name:

(i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] 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 [disputed] domain name, even if [the Respondent] [has] acquired no trademark or service mark rights; or

(iii) [the Respondent] [is] making a legitimate non-commercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

This is a non-exhaustive list of circumstances in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement falls on the Complainant. UDRP panels have recognized that proving that a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative".

Accordingly, it is usually sufficient for a complainant to raise a prima facie case against the respondent and the burden of proof on this requirement shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in a domain name.

The Panel finds that the Complainant has made out a prima facie case that the Respondent does not have rights or legitimate interests in the disputed domain name.

In particular, the Complainant states that:

- it does not carry out any activity for the Respondent;

- the Respondent is not affiliated to the Complainant;

- the Respondent does not have any business with the Complainant;

- the Respondent has not been authorized to by the Complainant in any way;

- the Respondent has no license or authorization to make any use of the Complainant's trademark;

- the Respondent has not been authorized by the Complainant to apply for registration of the disputed domain name;

- the Respondent is not commonly known by the disputed domain name;

- the word “FINANCO” has no dictionary meaning.

In the absence of a Response, there is no indication in the present case that the Respondent is commonly known by the disputed domain name.

Furthermore, the Respondent has failed to demonstrate any of the other non-exclusive circumstances evidencing rights or legitimate interests under paragraph 4(c) of the Policy or other evidence of rights or legitimate interests in the disputed domain name.

The Respondent does not appear to make any legitimate non-commercial or fair use of the disputed domain name, nor any use in connection with a bona fide offering of goods or services. Indeed, the website in relation with the disputed domain name offers financial services which compete with the services provided by the Complainant.

As regards the Complainant's statement about the absence of dictionary meaning of the word “FINANCO”, the Panel does not agree because this word has a specific meaning in Italian. Indeed, it is an archaic word having the same meaning of the English adverb “EVEN”, and it is rarely used in the current language, in particular for imparting an old-fashioned flavour to literary works.

Past panels considered that that merely registering a domain name comprised of a dictionary word does not by itself automatically confer rights or legitimate interests on the respondent. Indeed, it is a common view that mere arguments that a domain name corresponds to a dictionary term will not necessarily suffice. In order to find rights or legitimate interests in a domain name based on its dictionary meaning, the domain name should be genuinely used, or at least demonstrably intended for such use, in connection with the relied-upon dictionary meaning and not to trade off third-party trademark rights (see, for example WIPO Case No. D2002-1058).

Whilst the Complainant's trademark “FINANCO” corresponds to a word in Italian, the Respondent knew of the reputation and goodwill that the Complainant had established in this name and registered the disputed domain name with knowledge of the Complainant's rights and reputation. Indeed, it is not conceivable that the Respondent had any archaic Italian word in mind, instead of the Complainant's trademark “FINANCO”, when registering and using the disputed domain name. Under these

circumstances, it cannot be concluded that the Respondent is making a "fair" use of the disputed domain name when the financial services that the Respondent offers using the disputed domain name are in direct competition with those of the Complainant.

Taking into account that the Respondent is not commonly known as the disputed domain name, that the Respondent has no connection or business relationship with the Complainant, that the Complainant has not authorized the Respondent to apply for registration of the disputed domain name or to use the Complainant's trademark, that the disputed domain name is used by a website offering services which compete with the services provided by the Complainant and not for any other legitimate purpose, the Panel cannot imagine any possible legitimate justification for this use, and the Respondent has not come forward with any explanation that demonstrates any rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

BAD FAITH

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, including:

(i) circumstances indicating that [the Respondent] [has] registered or [has] acquired the [disputed] domain name primarily for the purpose of selling, renting, or otherwise transferring the [disputed] domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of [the Respondent's] documented out-of-pocket costs directly related to the [disputed] domain name; or

(ii) [the Respondent] [has] registered the [disputed] 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; or

(iii) [the Respondent] [has] registered the [disputed] domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the [disputed] 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.

The Panel, on the basis of the evidence presented, agrees with the Complainant's contentions that the disputed domain name was registered in bad faith and that it has been used in bad faith.

Other panels considered that the Respondent's awareness of Complainant's trademark rights at the time of registration suggests bad faith (see, for example, WIPO Case No. D2017-0100).

In addition, the fact of hosting a website which offers online services in direct competition with Complainant's own offerings has been considered by other panels as an activity disrupting Complainant's business (see WIPO Case No. D2017-0382).

The Panel takes the view that the use of the disputed domain name in a website which offers financial services in competition with the Complainant's services has the effect of disrupting the Complainant's business, therefore constitutes evidence of bad faith.

The Panel observes that if the Respondent had legitimate purposes in registering and using the disputed domain name it

would have filed a Response in this proceeding.

Given the evidence of the Complainant's prior rights on the word "FINANCO" and the timing of the registration of the disputed domain name, with apparent full knowledge of the Complainant's trademark, for promotion of competitive services, the Panel finds that the Complainant has satisfied the third requirement that the Respondent has registered and is using the disputed domain name in bad faith, under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **FINANCO-INVEST.COM**: Transferred

PANELLISTS

Name	**Michele Antonini**

DATE OF PANEL DECISION 2019-03-25

Publish the Decision