Decision for dispute CAC-UDRP-102604

Case number	CAC-UDRP-102604
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Domain names	bolloredelivery.icu

Case administrator

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

Complainant

Organization	BOLLORE

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Name	Flor Walden

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other pending or decided legal proceedings relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

According to the Complainant, the BOLLORE group (the Complainant), founded in 1822, is one of the 500 largest companies in the world. "Thanks to a diversification strategy based on innovation and international development, it now holds strong positions in all its activities around three business lines: Transportation and Logistics, Communication and Media, Electricity Storage and solutions."

The Complainant states and provides evidence to support, that it is the owner of international trademark registration n° 704697 BOLLORE® (registered on December 11, 1998) as well as the figurative trademark registration n° 1302823 BOLLORÉ LOGISTICS® (registered on January 27, 2016), both trademarks predating the date of registration of the disputed domain name (July 11, 2019).

The Complainant further states that it also owns and communicates through various domain names, including the same distinctive wording BOLLORE®, such as the domain name <bollore.com> registered on July 24, 1997.

FACTUAL BACKGROUND

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

It is well-established that “a domain name that wholly incorporates a Complainant’s registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP”. Please see WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin.

Please see FORUM Case No. FA 153545, Gardline Surveys Ltd v. Domain Finance Ltd. ("The addition of a top-level domain is irrelevant when establishing whether or not a mark is identical or confusingly similar because top-level domains are a required element of every domain name.").

Please see for instance 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 4(c)(ii) that Respondent is not commonly known by the disputed domain name under Policy 4(c)(ii).”).

Please see for instance:

- FORUM Case No. FA 1363660, Better Existence with HIV v. AAA (“Even though the disputed domain name still resolves to Complainant’s own website, Respondent’s registration of the disputed domain name in its own name fails to create any rights or legitimate interests in Respondent associated with the disputed domain name under Policy 4(a)(ii).”);

- FORUM Case No. FA 1337658, Direct Line Ins. plc v. Low-cost-domain (“The Panel finds that using Complainant’s mark in a domain name over which Complainant has no control, even if the domain name redirects to Complainant’s actual site, is not consistent with the requirements of Policy 4(c)(i) or 4(c)(iii) . . .”).

Past panels have confirmed the notoriety of the trademarks BOLLORE® in the following cases:

- CAC Case No. 101498, BOLLORE SA v. Naquan Riddick (“The Respondent registered the Disputed domain name with full knowledge of the Complainant's well-known trademark.”);

- CAC Case No. 101696, BOLLORE v. Hubert Dadoun (“As the Complainant is also one of the largest 500 companies in the world, the Panel accepts the Complainant's contention that their trademark has a strong reputation and is in fact to be considered well-known.”)"; and

- CAC Case No. 101494, BOLLORE SA v. Dillan Dee Jackson (“the Panel finds that, in light of the distinctiveness of the Complainant’s trademark, with which the Disputed domain name is confusingly similar, and of the prior registration and use of the trademark BOLLORÉ by the Complainant, including in the Respondent’s country, the Respondent was more likely than not aware of the Complainant’s trademark at the time of the registration of the Disputed domain names.”).

Please see FORUM Case No. FA 1382148, Verizon Trademark Servs. LLC v. Boyiko (“The Panel finds that Respondent’s registration and use of the confusingly similar disputed domain name, even where it resolves to Complainant’s own site, is still registration and use in bad faith pursuant to Policy 4(a)(iii).”).

PARTIES’ CONTENTIONS:

COMPLAINANT:

• The disputed domain name is confusingly similar to the protected mark

According to the Complainant, the disputed domain name <bolloredelivery.icu> is confusingly similar to its trademark BOLLORE®. The Complainant contends that the addition of the term “DELIVERY” (which refers to the Complainant

subsidiary, BOLLORE LOGISTICS, specialised in transport and logistics) does not change the overall impression of the designation as being connected to the Complainant's trademark BOLLORE®.

The Complainant further states that the addition of the new gTLD ".ICU" does not change the overall impression of the designation as being connected to the trademark BOLLORE®. It does not prevent the likelihood of confusion between the disputed domain names and the Complainant, its trademark and its domain names associated.

• Respondent does not have any rights or legitimate interest in the disputed domain name

The Complainant states that the Respondent has no rights or legitimate interests in respect of the disputed domain name <bolloredelivery.icu> and it is not affiliated with nor authorized by BOLLORE in any way. The Complainant does not carry out any activity for, nor has any business with the Respondent.

Neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademarks, or apply for registration of the disputed domain name by the Complainant. In addition, according to the Complainant, the disputed domain name redirects to BOLLORE LOGISTICS' official website. The Complainant contends that the Respondent is not making a bona fide offering of goods or services by means of the disputed domain name, or a legitimate non-commercial or fair use of it.

• The disputed domain name has been registered and is being used in bad faith

According to the Complainant, the Respondent has registered the disputed domain name and is using it in bad faith. The Complainant contends that the disputed domain name <bolloredelivery.icu> is confusingly similar to its trademark BOLLORE® which is well-known and distinctive. Past panels have confirmed the notoriety of the trademark BOLLORE® in the cases listed above.

The Complainant states that the disputed domain name redirects to BOLLORE LOGISTICS' official website. Thus, it is inconceivable that the Respondent could have registered the disputed domain name without actual knowledge of Complainant's rights in the trademark. The Complainant asserts that this use is by itself an evidence of bad faith registration and use. The Complainant concludes that the disputed domain name has been registered by the Respondent in an effort to take advantage of the good reputation Complainant had built up in its trademarks, with the sole aim to create a likelihood of confusion with the Complainant's trademark.

PARTIES CONTENTIONS

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 UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (UDRP) of the Internet Corporation for Assigned Names and Numbers (ICANN) (the “Policy”) provides that complainant must prove each of the following to obtain transfer or cancellation of the domain name:

1. that respondent’s domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights; and

2. that respondent has no rights or legitimate interests in respect of the domain name; and

3. the domain name has been registered and is being used in bad faith.

1) The disputed domain name is confusingly similar to a trademark in which the Complainant has rights

The Complainant has provided evidence and proved to be the owner of international trademark BOLLORE®. Essentially, the Respondent has appropriated the trademark BOLLORE® by adding the term “DELIVERY” to lead consumers to believe that it is affiliated with the Complainant. According to the Panel, the disputed domain name is confusingly similar to the Complainant's trademark BOLLORE® since it fully incorporates the Complainant’s trademark BOLLORE® despite the addition of the term "DELIVERY" which the Panel finds does not eliminate any confusing similarity. This is especially true where, as here, the trademark is “the dominant portion of the domain name,” LEGO Juris A/S v. Domain Tech Enterprises, WIPO Case No. D2011-2286, or where the trademark in the domain name represents “the most prominent part of the disputed domain name[] which will attract consumers’ attention.” Kabushiki Kaisha Toshiba dba Toshiba Corporation v. WUFACAI, WIPO Case No. D2006-0768., and since the term "BOLLORE" is fully distinguishable with respect to the additional component of the domain name, either because it is placed at the beginning of the domain name, which is where consumers mainly focus their attention, or because the additional element of the domain name is deprived of a distinctive character, as in this case.

In addition, it is well-established that “a domain name that wholly incorporates a Complainant’s registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP”. Please see WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin.

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

2) The Respondent lacks rights or legitimate interests in the disputed domain name

Under the Policy, a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy (see WIPO Overview 2.0, paragraph 2.1).

The Panel finds that the Respondent does not have a legal right to use the term “BOLLORE” as part of its domain name. The Respondent is not in any way connected with the Complainant nor is it authorized to register the disputed domain name or use the Complainant's trademarks.

In a present case, the Respondent failed to file a Response in which it could have provided evidence in support of its rights or legitimate interests. Therefore, all these circumstances are sufficient to establish a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name.

The Panel thus takes the view that the Respondent lacks rights or legitimate interests in the disputed domain name.

3) The disputed domain name has been registered and is being used in bad faith

The Panel finds that the disputed domain name <bolloredelivery.icu> is confusingly similar to the Complainant's distinctive trademark BOLLORE® which is well-established. Given the distinctiveness of the Complainant's trademark and reputation, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark. The fact that a complainant's trademark has a strong reputation and is widely used and the absence of evidence whatsoever of any actual or contemplated good faith use are further circumstances that may evidence bad faith registration and use in the event of passive use of domain names (see section 3.3, WIPO Overview 3.0).

Moreover, the disputed domain name redirects to BOLLORE LOGISTICS' official website which by itself provides evidence of bad faith registration and use. Thus, it is inconceivable that the Respondent could have registered the disputed domain name <bolloredelivery.icu> without actual knowledge of Complainant's rights in the trademark. The Panel finds that such actions constitute bad faith pursuant to paragraph 4(b)(iv) of the Policy, which provides: "by using the domain name, respondent has intentionally attempted to attract, for commercial gain, Internet users to 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 respondent's web site or location or of a product or service on respondent's web site or location."

In the present case, the Panel is of the opinion that the Complainant's BOLLORE® trademark is distinctive and widely used, which makes it difficult to conceive any plausible legitimate future use of the disputed domain name by the Respondent.

For all reasons stated above, the Panel is satisfied that the Complainant has proven the third element of the Policy that is that the Respondent's registration and use of the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOLLOREDELIVERY.ICU**: Transferred

PANELLISTS

Name	**Mgr. Barbora Donathová, LL.M.**

DATE OF PANEL DECISION 2019-09-05

Publish the Decision