Decision for dispute CAC-UDRP-102865

Case number	CAC-UDRP-102865
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Domain names	boursorama-banque.website

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	BOURSORAMA SA

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Organization	Margaret

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

Founded in 1995, BOURSORAMA (the Complainant), is one of the very first online financial platforms in Europe. One of the earliest of the emerging e-commerce providers, it enjoyed substantial growth due to its continuous expansion. It grew into a pioneer and market leader in its three core businesses: online brokerage, financial information on the Internet, and online banking. Today in France, Boursorama is the leading online banking provider.

The Complainant states and provides evidence to support, that it is the owner of several trademarks BOURSORAMA, such as the European trademark n° 1758614 registered since 19 October 2001, predating the date of registration of the disputed domain name <boursorama-banque.website>.

The Complainant also owns several domain names, including the same distinctive wording BOURSORAMA, such as the domain name <boursorama.com>, registered since 1 March 1998 and <boursorama-banque.com> registered since 26 May 2005.

The disputed domain name <boursorama-banque.website> was registered on 14 January 2020.

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 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 970871, Vance Int’l, Inc. v. Abend (concluding that the operation of a pay-per-click website at a confusingly similar domain name does not represent a bona fide offering of goods or services or a legitimate noncommercial or fair use, regardless of whether or not the links resolve to competing or unrelated websites or if the respondent is itself commercially profiting from the click-through fees);

- WIPO Case No. D2007-1695, Mayflower Transit LLC v. Domains by Proxy Inc./Yariv Moshe ("Respondent’s use of a domain name confusingly similar to Complainant’s trademark for the purpose of offering sponsored links does not of itself qualify as a bona fide use.").

Please see:

- CAC Case No. 101131, BOURSORAMA v. PD Host Inc - Ken Thomas (“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 irrealistic to believe that the Respondent did not know the Complainant's trademark when registered the domain name <wwwboursorama.com>.”)

- WIPO Case No. D2017-1463, Boursorama SA v. Estrade Nicolas (“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.”)

Please see for instance:

- WIPO Case No. D2018-0497, StudioCanal v. Registration Private, Domains By Proxy, LLC / Sudjam Admin, Sudjam LLC (“In that circumstance, whether the commercial gain from misled Internet users is gained by the Respondent or by the Registrar (or by another third party), it remains that the Respondent controls and cannot (absent some special circumstance) disclaim responsibility for, the content appearing on the website to which the disputed domain name resolve […] so the Panel presumes that the Respondent has allowed the disputed domain name to be used with the intent to attract Internet users for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, affiliation, or endorsement of the Respondent's website to which the disputed domain name resolves. Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith.”);

- Forum Case No. 1557007, Staples, Inc. and Staples the Office Superstores, LLC v. HANNA EL HIN / DTAPLES.COM (“Therefore, the Panel finds that Respondent registered and is using the <dtaples.com> domain name in bad faith under Policy 4(b)(iv) because the Respondent is using the disputed domain name to host third-party links to Complainant’s competitors from which Respondent is presumed to obtain some commercial benefit.”).

PARTIES’ CONTENTIONS:

COMPLAINANT:

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

According to the Complainant, the disputed domain name <boursorama-banque.website> is confusingly similar to its trademark BOURSORAMA. The Complainant contends that the addition of a hyphen and the generic term “BANQUE” is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trademark BOURSORAMA. It does not change the overall impression of the designation as being connected to the Complainant’s trademark BOURSORAMA. The disputed domain name includes in its entirety the Complainant’s trademark. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademark and the domain names associated.

Moreover, the Complainant contends that the addition of the new gTLD “.WEBSITE” does not change the overall impression of the designation as being connected to the trademark BOURSORAMA of the Complainant. It does not prevent the likelihood of confusion between the disputed domain name 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 Respondent is not known by the Complainant. The Complainant states that the Respondent is not affiliated with nor authorized by the Complainant in any way. The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. 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 trademark BOURSORAMA, or apply for registration of the disputed domain name <boursorama-banque.website>.

• 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 <boursorama-banque.website> is confusingly similar to its well-known trademark BOURSORAMA. The Complainant further states that the disputed domain name redirects to a parking page with commercial links related to the Complainant's activity.

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 European trademark BOURSORAMA. Essentially, the Respondent has appropriated the trademark "BOURSORAMA" by adding a hyphen and the generic term “BANQUE” to lead consumers to believe that it is affiliated with the Complainant. Moreover, the Respondent appropriated the trademark "BOURSORAMA" by adding the new gTLD. “WEBSITE” which, according to the Panel, does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademark and its domain names associated.

The disputed domain name consists of the same term "BOURSORAMA" followed by a generic term "BANQUE". The disputed domain name is confusingly similar to the Complainant's trademark "BOURSORAMA" since it fully incorporates the Complainant’s trademark BOURSORAMA despite the addition of the term "BANGUE" and despite the addition of the new gTLD “.WEBSITE” which the Panel finds does not eliminate any confusing similarity. 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”. See WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin. 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 "BOURSORAMA" 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.

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

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 UDRP (see WIPO Overview 2.0, paragraph 2.1).

The Panel finds that the Respondent does not have a legal right to use the term “BOURSORAMA” 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 its intellectual property rights for its operations. The Respondent is not known by the Complainant. 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 trademark BOURSORAMA.

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 <boursorama-banque.website> is confusingly similar to the Complainant's well-known trademark BOURSORAMA. It is reasonable to infer that the Respondent has registered the domain name with full knowledge of the Complainant's trademark. The Complainant's use and registration of the trademark BOURSORAMA largely precede the registration date of the disputed domain name. The fact that the Respondent has registered a domain name that includes the term "BOURSORAMA", with the addition of a hyphen and of a generic term, clearly indicates that the Respondent had knowledge of the Complainant's trademark at the time of registration of the disputed domain name. It is reasonable to conclude that this is evidence of registration of the domain name in bad faith.

The disputed domain name redirects to a parking page with commercial links related to the Complainant's activity (passive holding). The Respondent is not using the disputed domain name. According to the Panel, a passive holding of the disputed domain name may amount to bad faith when it is difficult to imagine any plausible future active use of the disputed domain name by the Respondent that would be legitimate and not infringing the Complainant's well-known mark or unfair competition and consumer protection legislation (See Inter-IKEA v Polanski, WIPO Case No. D2000 1614; Inter-IKEA Systems B.V. v. Hoon Huh, WIPO Case No. D2000 0438; Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003). Countless UDRP decisions also confirmed that the passive holding of a domain name with the knowledge that the domain name infringes another party's trademark rights is evidence of bad faith registration and use (see, in this regard, Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003).

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).

In the present case, the Panel is of the opinion that the Complainant's BOURSORAMA® trademark is distinctive and well-known, 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. **BOURSORAMA-BANQUE.WEBSITE**: Transferred

PANELLISTS

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

DATE OF PANEL DECISION 2020-02-27