Decision for dispute CAC-UDRP-103201

Case number	CAC-UDRP-103201
Time of filing	2020-07-28 09:58:03
Domain names	frboursorama.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	BOURSORAMA SA

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Organization	REGOLO GREECE

OTHER LEGAL PROCEEDINGS

The Panel is unaware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

EU TM No. 1758614 BOURSORAMA registered since 19 October 2001 for various goods and services in NICE classes 9, 16, 35, 36, 38, 41 and 42 including various financial services and online services.

FACTUAL BACKGROUND

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

The Complainant was founded in 1995 in France and since at least 1998 has used the trade mark BOURSORAMA in relation to its finance related online services. It is a subsidiary of Societe Generale group.

Its three core business that it operates under the BOURSORAMA trade mark are online brokerage, financial information on the internet and online banking.

At the time of filing the Complaint the Complainant provided its services to over 2 million customers. Its online portal was located at www.boursorama.com. And its online services received of 30 million monthly visits.

The Complainant asserts it is the owner of several trademarks consisting of BOURSORAMA, including the above mentioned EU trademark which covers the jurisdictions of both France and Italy.

The Complainant further asserts it is the registrant of a number of domain names containing the word BOURSORAMA including <boursorama.com>, which has been registered since 1998.

The disputed domain name was registered on 22 July 2020. As at the time of the Complaint it resolves to a website without any substantial consent except for the Italian words "Sito web in manutenzione", which translate to "website under maintenance". However the MX record for the disputed domain name had been configured, indicating that the Respondent intended to use it for an email service.

In relation to the Registrant details provided for the disputed domain name, the Respondent's address is listed as a location in Italy. Further, the Respondent has provided a phone number with an Italian country code and a contact email address with the Italian <.it> ccTLD.

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

Paragraph (4)(a) of the Policy lists three elements that the Complainant must prove to merit a finding that the disputed domain name registered by the Respondent be transferred to the Complainant:

1) the disputed domain name is identical or confusingly similar to a trademark or service mark ("mark") in which the Complainant has rights; and

2) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

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

The Panel is satisfied that the Complainant has satisfied all three elements for the principal reasons set out below.

RIGHTS IN AN IDENTICAL OR CONFUSINGLY SIMILAR TRADEMARK

As mentioned above the Complainant asserts it has several trademark registrations consisting of the word BOURSORAMA. At least one of these registrations predates the registration date of the disputed domain name approximately 20 years.

To satisfy paragraph 4(a)(i) of the Policy it is enough that the Panel is satisfied that the Complainant has registered rights in a trademark that predates the registration of the disputed domain name in a single jurisdiction (even if that single jurisdiction is not one in which the Respondent resides or operates) (Koninklijke KPN N.V. v. Telepathy, Inc D2001-0217 (WIPO May 7, 2001); see also WIPO Case Nos. D2012-0141 and D2011-1436). The Complainant has clearly satisfied such in relation to the trademark BOURSORAMA. In fact, the EU trademark registration evidenced in the Complaint covers the Respondent's home jurisdiction of Italy.

The next question is whether the dispute domain name is confusingly similar to BOURSORAMA.

The Panel disregards the gTLD suffix ".com" for the purpose of this comparison. However the Panel further notes that if such a suffix were to add anything it would only make the disputed domain name more similar to the Complainant's well used <boursorama.com> domain name, which has the same suffix.

Further the Panel finds that in circumstances where the Complainant is based in France and clearly has a reputation in the BOURSORAMA trademark in that country the inclusion of the prefix "fr" does not diminish the likelihood of confusion as it is likely to be viewed as falsely indicating a connection with the Complainant's business in the France. Given the global nature of the internet and the fact that persons communicating online are unable to verify each others physical locations other than from information they see or hear on their computers or devices it is likely for internet users to see some elements of domain names that allude to locations, countries or jurisdictions (like "FR" or "EU") as indicating geographic origin. This is indeed the purpose of country code top level domains. Likewise the inclusion of a geographic indicator in a domain name prior to the ".com" gTLD suffix, including at the beginning of the domain name, may serve the same purpose and be unlikely to reduce the confusion caused by the additional inclusion of the trademark in the domain name. The Panel refers to the decisions in Disney Enterprises Inc v. Orients Rugs & More /NA, Claim No. FA1404001555495 (FORUM, May 21, 2014) and Donald J. Trump v. Web-adviso, D2010-2220 (WIPO, March 5, 2011).

The disputed domain name is confusingly similar to the BOURSORAMA trademark.

NO RIGHTS OR LEGITIMATE INTERESTS

The Respondent's name bears no resemblance to the disputed domain name. Further, the website to which the disputed domain name resolves has no content which would indicate that the Respondent has any right or legitimate interest in the disputed domain name.

The Respondent has no rights or interests in the disputed domain name.

BAD FAITH

The Complainant asserts that the incorporation of a famous mark into a domain name coupled with holding of an inactive website is evidence of bad faith. The Panel notes that in the present matter the Respondent has only held the domain name for less than two months. It is perfectly foreseeable that a domain name holder may take a reasonable amount of time that is more than two months to actively use a domain name. Hence for the purposes of assessing the issue of bad faith the Panel places no weight on the fact that domain name resolves to an inactive website.

However what is also clear to the Panel is there is no foreseeable reason why the Respondent, residing in a European Union country, would choose a domain name containing this unique French trade mark together with the letters "FR" which indicate the country France (particularly given it is the letters used for French ccTLD's). On its face the composition of this domain name indicates that the Respondent knew of the said trademark before seeking to register the domain name. Further, there is no response from the Respondent to contradict this inference that the Panel draws under Rule 14(b) and (5)(a) of the

UDRP Rules.

The Panel also notes that although normally the configuring of an MX record in absence of any other facts would not indicate bad faith, in the circumstances of the present case mentioned in the preceding paragraph such configuration is concerning. The domain name registrant would only configure the MX record for a domain name if it intended to use that domain name for emailing. That is the sole purpose of such configuration. All indications are that the Respondent intended to send emails in which it pretended to be the Complainant. This is of very serious concern when the Complainant uses its similar trademark in relation to online banking. And it is a relevant consideration for the Panel to observe this fact in relation to use of well-known financial services trademarks.

The apparent high risk of the first steps in attempted online fraud cannot be discounted and the disputed domain name has clearly been registered in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **FRBOURSORAMA.COM**: Transferred

PANELLISTS

Name	**Mr Andrew Norman Sykes**

DATE OF PANEL DECISION 2020-08-25

Publish the Decision