

Decision for dispute CAC-UDRP-103551

Case number	CAC-UDRP-103551
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Time of filing	2021-02-03 09:31:13
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Domain names	macifassurance.info
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Case administrator

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

Organization	MACIF (Mutuelle Assurance des Commerçants et Industriels de France et des cadres et des salariés de l'Industrie et du Commerce)
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Complainant representative

Organization	IP TWINS
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Respondent

Name	Kevin Mickael
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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 Mutuelle Assurance des Commerçants et Industriels de France et des cadres et salariés de l'industrie et du commerce (MACIF) as a mutual insurance company was founded in Niort, France, in 1960.

The Complainant owns several dozen trademark rights in the term MACIF and in particular the following trademarks, registered well before the registration of the disputed domain name:

- International trademark MACIF N° 529935 registered on 24 November 1988, duly renewed and designating services in international class 36; and

- International trademark MACIF N° 529934 registered on 24 November 1988, duly renewed and designating services in international class 36.

The Complainant is the owner of <macif.com> registered on 5 March 1997. Its main domain name <macif.fr> registered on 23

April 1997.

The disputed domain name <macifassurance.info> was registered on 26 November 2020 (16:06:20) and is actively used in connection with external email servers.

FACTUAL BACKGROUND

The Complainant is Mutuelle Assurance des Commerçants et Industriels de France et des cadres et salariés de l'industrie et du commerce (MACIF). The Complainant is a French mutual insurance company founded in Niort, France, in 1960 counted 5.4 million client members and subscribers to at least one insurance service, 10 360 employees and more than 500 agencies in France as of 2018. With a turnover of more than 6.2 billion euros in 2018, the Complainant is the French leader in car insurance with more than 6 million insurance contracts.

The earlier trademarks MACIF enjoy a wide-spread continuous reputation, particularly on the French market. This is evidenced by the large number of client members and subscribers of the Complainant. In 2018, the website of the Complainant was visited more than 25 million times. In addition, the Complainant's Facebook page L'Essentiel Par Macif is followed by more than 26 000 users.

The Complainant spends large amounts in external communication and advertisement to maintain and increase its notoriety to the French public. In July 2020, the Complainant was awarded an "Argus" award for the best external communication campaign in the insurance category. All these establish the Complainant's trademarks reputation in France, where the Complainant is located.

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

The Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed allegations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules because of the Respondent's failure to submit a response.

Therefore, in the absence of a response, it is appropriate to accept as true all allegations of the Complainant.

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 15(a) of the Rules for the UDRP ('the Policy') instructs this Panel to "decide a complaint on the basis of the

statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

(1) the domain name registered by respondent is identical or confusingly similar to a trademark or service mark in which complainant has rights; and

(2) 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.

Paragraph 4(b) of the Policy identifies, in particular but without limitation, four circumstances which shall be evidence of the registration and use of a domain name in bad faith.

Paragraph 4(b)(iv) of the Policy reads: "by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location."

The Complainant is the owner of several dozen trademark rights in the term "MACIF". The Complainant also owns numerous domain names containing the trademark MACIF, specifically the main domain name <macif.fr> was registered on 23 April 1997 and is actively used in connection with the Complainant's official website.

The disputed domain name <macif.info> was registered in 2019.

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

The Complainant has proved that it is the owner of several dozen trademark rights in the term "MACIF". The term "MACIF" is an acronym which has not in itself a specific meaning in French or in English. The Panel concludes that rights of the Complainant in the term "MACIF" were established.

The Panel finds that the first-level portion of the disputed domain name is confusingly similar to the earlier well-known trademarks MACIF of the Complainant while the trademark is reproduced identically, together with the generic term "assurance". The term "assurance" is the French word for "insurance" in English. Nevertheless, the addition of the generic term "assurance" to the Complainant's trademark in the disputed domain name does nothing to diminish the likelihood of confusion and reinforces only the likelihood of confusion in the mind of the general public of average attention. This descriptive component adds to the confusion by leading users to believe that Complainant operates the website associated to the disputed domain name (See for instance WIPO Case D2003-0888 Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin).

The Panel comes to the conclusion that the use of lower-case letter format on the one hand and the addition of the top-level domain ".info" on the other hand, are not significant in determining whether the domain name is identical or confusingly similar to the rights of the Complainant. The generic Top-Level Domain ".info" in the second-level portion of the disputed domain name is a standard registration requirement and should be disregarded when assessing whether a disputed domain name is confusingly similar to the trademark in which the Complainant has rights (see for instance CAC Case No. 102345, Arcelormittal S.A v. James, supra and Credit Mutuel Arkea v. Domain Administration).

Thus, the Complainant has, to the satisfaction of the Panel, shown the disputed domain name is 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).

(ii) The Respondent has no rights or legitimate interests in respect of the disputed domain name

The 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 Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Complainant contends that the Respondent is not known by the disputed domain name and that there is no evidence that the Respondent has been commonly known by the disputed domain name as an individual, business, or other organization and that the present Complaint was submitted very shortly after the registration of the disputed domain name, intending to not allow the Respondent to be commonly known by it and that the Respondent has acquired no trademark in the name "MACIF" and the Respondent reproduces the Complainant's earlier registered trademarks MACIF in the disputed domain name without any license or authorization from the Complainant, which is a strong evidence of the lack of legitimate interest.

The Complainant states that it has not authorized the use of the term "MACIF" or terms similar thereto in the disputed domain name in any manner or form. Further, the Complainant puts forth that the Respondent has not, before the original filing of the Complaint, used or made preparations to use the disputed domain name in relation to a bona fide offering of goods or services and on the contrary, the disputed domain name is actively used in connection with external email servers so that the Respondent should be able to send out massive e-mail campaigns through the disputed domain name, defrauding customers and potentially obtaining personal or banking information unduly. The burden is on the Respondent to establish the Respondent's rights or legitimate interests the Respondent may have or have had in the domain name since the adoption and extensive use by the Complainant of the trademarks MACIF predate by far the first entry of the domain name. None of the circumstances, which set out how the Respondent can prove rights or legitimate interests in the disputed domain name, are present in this case.

Under all these circumstances the Panel concludes that the registered owner of the disputed domain name and the Respondent is Contact Privacy Inc. Customer 1248765629 without any right or legitimate interest in respect of the disputed domain name.

Thus, 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).

iii) The disputed domain name was registered and is being used in bad faith

1) Registration of the disputed domain name in bad faith

The Complainant contends that its trademarks as well as itself enjoy a long-standing reputation in France so much so that it is inconceivable that the Respondent ignored the Complainant or its earlier rights on the term MACIF and that the Respondent obviously had the Complainant's name and trademark in mind when registering the disputed domain name. The Respondent's choice of domain name cannot have been accidental and must have been influenced by the fame of the Complainant and its earlier trademarks. This is, also in view of the Panel, evidenced by the addition of the generic term "assurance" to the trademark in the disputed domain name because the research on an online search engine yields shows search results for "macif". This research related only to the Complainant so that the Respondent knew or should have known that, when acquiring and using the disputed domain name, it would do so in violation of the Complainant's earlier rights.

The Complainant submits that it is highly likely that the Respondent chose the disputed domain name because of its similarity to a trademark in which the Complainant has rights and legitimate interest. This was most likely done in the hope and expectation that Internet users receiving e-mails from the disputed domain names believe that it originates from the Complainant, in turn potentially luring users into providing personal or banking details in confidence.

The previous panels have established the notoriety of the MACIF trademark in France in the past. See for example WIPO Case

No. D2003-0083, Mutuelle Assurance des Commerçants et Industriels de France et des Cadres et Salaries de L'industrie et du Commerce (MACIF) v. Mr. Pierre Gricourt against the domain name macif.info, where the Panel stated : « The Macif company and its trademarks are well-known in France ».

WIPO Overview 3.0 para. 3.1.4 states that “Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith.”

The Panel concludes that the Respondent acquired and is using the disputed domain name to attract Internet users by creating a likelihood of confusion with the Complainant’s earlier marks, and to intentionally deceive Internet users and such use of disputed domain name amounts to a bad faith registration of the disputed domain name under the Policy.

2) Use of the disputed domain name in bad faith

The disputed domain name incorporates in its entirety the Complainant’s well-known trademark MACIF. The inclusion of the MACIF trade mark with the term “assurance” is closely connected to the Complainant’s business. The inclusion of the Complainant’s trademark in the disputed domain name is a direct reference to the Complainant, their business and trademarks. By registering the disputed domain name which is very similar in its structure to the Complainant’s main domain name the Respondent’s obviously intends to mirror this Complainant’s domain name <macif.com> and its main domain name <macif.fr> both registered in 1997.

The relevant issue is not limited to whether the Registrant / Respondent is undertaking a positive action in bad faith in relation to the disputed domain name, but instead whether, in all the circumstances of the case, the Panel concurs with the Complainant that it can be said that the Registrant / Respondent is acting in bad faith. The distinction between undertaking a positive action in bad faith and acting in bad faith may seem a rather fine distinction, but it is an important one. The significance of the distinction is that the concept of a domain name “being used in bad faith” is not limited to positive action; inaction is within this concept.

Thus, 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).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **MACIFASSURANCE.INFO**: Transferred

PANELLISTS

Name	JUDr. Vojtěch Trapl
DATE OF PANEL DECISION	2021-02-25
Publish the Decision	